

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

No. 18563

JOINT APPENDIX TO BRIEFS

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

HAZELTINE RESEARCH, INC. and ROBERT REGIS
Appellants,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS
Appellee.

Appeal from the United States District Court
for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

FILED MAY 28 1964

Nathan J. Paulson
CLERK

793

INDEX

	Page
COMPLAINT.....	1A
ANSWER OF THE DEFENDANT.....	5A
PLAINTIFFS' EXHIBITS	
No. 1 Certified copy of the file wrapper and con- tents of the application of Robert Regis Serial No. 704,770.....	7A
No. 2 Copy of the unrecorded assignment of the invention of Robert Regis.....	47A
No. 3 Certification of the Secretary of State of the State of Illinois.....	49A
DEFENDANT'S EXHIBIT	
No. 1A C. P. Carlson U.S. Patent No. 2,491,644..	50A
No. 1B B. E. Wallace U.S. Patent No. 2,822,526..	54A
No. 1C Print of sheet of drawing from applica- tion of Robert Regis.....	60A
No. 1D Examiner's Answer.....	61A
No. 1E Decision of Patent Office Board of Ap- peals.....	65A
OPINION OF THE UNITED STATES DISTRICT JUDGE.....	69A
JUDGMENT OF THE UNITED STATES DISTRICT JUDGE.....	75A
NOTICE OF APPEAL.....	76A
STATEMENT OF POINTS UNDER RULE 15.....	78A
STIPULATION AS TO CONTENTS OF JOINT AP- PENDIX.....	79A

1 A

(Filed May 25, 1962)

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1688-62

HAZELTINE RESEARCH, INC., 5445 West Diversey Avenue
Chicago 39, Illinois,

and

ROBERT REGIS, 193-15B, 69th Avenue Fresh Meadows,
New York

Plaintiffs,

v.

DAVID L. LADD, Commissioner of Patents,
Washington 25, D. C.

Defendant.

COMPLAINT TO OBTAIN LETTERS PATENT
TO THE HONORABLE JUDGES OF THE UNITED
STATES DISTRICT COURT FOR THE DISTRICT OF
COLUMBIA

The plaintiffs herein for their complaint state:

JURISDICTION

1. This action is brought under the provisions of the Patent Act of July 19, 1952 (Public Law 593, 82nd Congress, 2d sess., ch. 950; 66 Stat. 792); and, more particularly, Section 145 of said Act (Title 35 U.S. Code, Section 145), and under the provisions of the Administrative Procedure Act as enacted June 11, 1949, as amended, and more particularly Section 9 of said Act (Title 5 U.S. Code, Section 1009).

PARTIES

2. The plaintiff Hazeltine Research, Inc. is a corporation duly organized under the laws of the State of Illinois and has a principal place of business in Chicago, Illinois.

3. Plaintiff Robert Regis is a resident of the City of New York, County of Queens, and State of New York, is the applicant in patent application, Serial No. 704,770, filed in the United States Patent Office on December 23, 1957 and entitled "Microwave Switch", and is the original and first inventor of the invention disclosed and claimed in said application.

4. The defendant, David L. Ladd, is Commissioner of Patents of the United States, has his official residence in the District of Columbia, and this action is brought against him in his official capacity as Commissioner of Patents of the United States.

GROUNDS OF COMPLAINT

5. Prior to December 23, 1957, plaintiff Robert Regis, invented new and useful improvements in microwave switches and on or about December 20, 1957, Robert Regis, the plaintiff herein, executed an application for letters patent for the said inventions made by him and entitled "Microwave Switch".

6. On or about December 20, 1957, plaintiff Robert Regis assigned, by instrument in writing, all right, title and interest in and to his said inventions and his said application for letters patent therefor executed on or about December 20, 1957, to the plaintiff, Hazeltine Research, Inc., which assignment has not been recorded in the assignment records of the United States Patent Office. The plaintiffs herein, hereby make profert of the original copy of said assignment.

3 A

7. On or about December 23, 1957, plaintiff, Robert Regis, duly made application in writing in the United States Patent Office for the grant of letters patent to him on his invention, which application was given Serial No. 704,770. Said application Serial No. 704,770 was thereafter duly prosecuted in accordance with the requirements of law and the rules of practice of the United States Patent Office.

8. Said application Serial No. 704,770 contains the claims to which plaintiffs believe themselves entitled, such claims being numbered 1, 2 and 3.

9. Said application Serial No. 704,770 was examined by the Primary Examiner in charge thereof and he on June 24, 1959 finally rejected claims 1, 2 and 3. On September 22, 1959, plaintiffs appealed to the Board of Appeals from the Primary Examiner's final rejection of claims 1, 2 and 3. On March 28, 1962, the Board of Appeals rendered a decision which affirmed the Primary Examiner's final rejection of claims 1, 2 and 3.

10. Plaintiffs allege that the decision of the Board of Appeals adjudging them not entitled to letters patent for the invention recited in claims 1, 2 and 3 was erroneous and contrary to law and the plaintiffs are dissatisfied with the aforesaid decision of the Patent Office Board of Appeals.

11. Plaintiffs further allege that no appeal has been taken by them to the United States Court of Customs and Patent Appeals from the refusal of the Commissioner of Patents to issue Letters Patent to plaintiffs.

12. Plaintiffs make profert of a certified copy of application for Letters Patent, Serial No. 704,770, and all proceedings and papers in the file thereof, together with certified copies of the patents forming the basis for the decision of the Board of Appeals refusing to allow said claims 1, 2 and 3 and issue Letters Patent on the in-

vention in such claims, said certified copies to be produced as and when this Honorable Court shall direct.

WHEREFORE, plaintiffs pray this Honorable Court:

1. To adjudge or decree that plaintiffs are entitled to receive Letters Patent on the invention claimed in claims 1, 2 and 3 of said application Serial No. 704,770, in due form of law as prescribed by the patent statutes.

2. For a judgment pursuant to Title 35, U.S. Code Section 145 (66 Stat. 792), authorizing the Commissioner of Patents to issue Letters Patent to plaintiffs on the invention claimed in claims 1, 2 and 3 of said application Serial No. 704,770, in due form of law and as prescribed by the statutes.

3. That plaintiffs have such other and further relief as the nature of this case may admit or require and as may be just and equitable.

Respectfully,

ROBERT REGIS

/s/ Edward B. Beale
By: EDWARD B. BEALE
BEALE AND JONES
425 Thirteenth Street, N.W.
Washington 4, D. C.
Telephone NAtional 8-4304

Of Counsel:

EDWARD A. RUESTOW
59-25 Little Neck Parkway
Little Neck 62, New York

GEORGE R. JONES
425 Thirteenth Street, N.W.
Washington 4, D. C.

(Filed June 15, 1962)

* * * *

ANSWER TO COMPLAINT

To the Honorable the Judges of the United States District
Court for the District of Columbia

1. The defendant admits that this action is brought under the provisions of the Patent Act of July 19, 1952, (Public Law 593, 82nd Congress, 2d sess., ch. 950; 66 Stat. 792); and, more particularly, Section 145 of said Act (Title 35 U.S. Code, Section 145). Otherwise, however, the defendant denies the allegations of paragraph 1 of the complaint.

2. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 2 of the complaint.

3. The defendant admits that the plaintiff, Robert Regis, is a resident of the City of New York, County of Queens, and State of New York, and is the applicant in patent application, Serial No. 704,770, filed in the United States Patent Office on December 23, 1957, and entitled "Microwave Switch". Otherwise, however, the defendant denies the allegations of paragraph 3 of the complaint.

4. The defendant admits the allegations of paragraph 4 of the complaint.

5. The defendant admits that on December 20, 1957, Robert Regis, the plaintiff herein, executed an application for Letters Patent entitled "Microwave Switch". The defendant asserts that, otherwise, he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 5 of the complaint.

6. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 6 of the complaint.

7. The defendant admits the allegations of paragraph 7 of the complaint.

8. The defendant admits that application, Serial No. 704,770, contains claims numbered 1, 2, and 3. Otherwise, however, the defendant denies the allegations of paragraph 8 of the complaint.

9. The defendant admits the allegations of paragraph 9 of the complaint.

10. The defendant denies the allegations of paragraph 10 of the complaint.

11, 12. The defendant admits the allegations of paragraph 11 and 12 of the complaint.

FURTHER ANSWERING, the defendant asserts that the plaintiffs are not entitled to a patent containing any of claims 1, 2, and 3 of the application involved in this civil action, for the reasons given and in view of the references cited in the Examiner's answer and the decision of the Board of Appeals in that application. Proffert hereby is made of copies of the said answer, decision and references.

Respectfully submitted,

/s/ C. W. Moore
Solicitor, U. S. Patent Office
Attorney for Defendant

June 14, 1962

I hereby certify that two copies of the foregoing ANSWER TO COMPLAINT were mailed today to Edward B. Beale, 425 Thirteenth St., N.W., Washington, D. C., attorney for the plaintiffs.

/s/ C. W. Moore
Solicitor

7 A

Plaintiff's Exhibit 1

* * * *

This is to certify that annexed hereto is a true copy from the records of the United States Patent Office of File Wrapper and Contents of the file identified above.

By authority of the
COMMISSIONER OF PATENTS

/s/ L. G. Lanham, Jr.
Certifying Officer

Date May 15, 1963

Serial No. (Series of 1948)—704770

Assistant examiner—Roe

Class—333

Subclass—81

Division No.—65

Filed complete (Date)—Dec. 23, 1957

Serial No. 704 770

Applicant(s)—Regis, Robert of Fresh Meadows, N.Y.

Title of invention—Microwave Switch

Principal attorney(s)—Laurence B. Dodds

Associate attorney(s)—Edward A. Ruestow, Andrew L.
Ney

8 A

HAZELTINE RESEARCH CORPORATION

59-25 Little Neck Parkway

Little Neck 62, N.Y.

December 20, 1957

Re: Docket 2533

Honorable Commissioner of Patents,
Washington 25, D. C.

Sir:

I enclose, for filing, an application of ROBERT REGIS for improvements in MICROWAVE SWITCH. The application papers comprise a specification, claims, Oath, Power of Attorney, and Petition, and one (1) sheet of drawing, and were executed December 20, 1957.

Enclosed also is check No. 1601, for Thirty Dollars (\$30.00), to cover the filing fee.

Respectfully,

/s/ L. B. Dodds
Attorney for Applicant.

sk
Encs.

* * * *

SPECIFICATION

TO ALL WHOM IT MAY CONCERN:

BE IT KNOWN that I, ROBERT REGIS, a citizen of the United States, residing at Fresh Meadows, in the county of Queens, State of New York, have invented certain new and useful improvements in

MICROWAVE SWITCH

of which the following is a specification:

This invention relates to microwave switches and, more particularly, to such switches of the type which selectively isolates a microwave source from its load.

For some applications, it is desired to isolate a microwave transmitter from its antenna load while maintaining an impedance match to the transmitter. Thus, the transmitter may be maintained continuously operative and may instantaneously radiate energy by actuating the switch without a delay due to a warm-up period.

It is an object of the invention to provide a microwave switch of the type described of simplified construction and suitable selectively to isolate a microwave transmitter from its load antenna while maintaining an approximate impedance match to the transmitter.

In accordance with a particular form of the invention, a microwave switch for selectively isolating a microwave source from its load comprises a microwave signal guide for connection to a microwave source at one end and to a load at the other end. The switch includes an attenuator vane of resistive material having a tapered end extending toward the source and having a high conductance strip at the other end thereof and displaceable in and out of

the guide for selectively isolating the source from its load when in the guide while maintaining an approximate impedance match to the source.

For a better understanding of the present invention, together with other and further objects thereof, reference is had to the following description taken in connection with the accompanying drawing, and its scope will be pointed out in the appended claims.

Referring to the drawing:

Fig. 1 represents one view of a microwave switch constructed in accordance with the invention, and

Fig. 2 represents another view of a switch constructed in accordance with the invention.

Referring now more particularly to Fig. 1 of the drawing, a microwave transmitter 10 of conventional construction is coupled to a microwave signal guide 11 of conventional construction having a microwave antenna 12 also of conventional construction at the other end thereof. An attenuator vane 13 of resistive material and disposed in a slot in the guide will be described with reference to Fig. 2. The vane has a tapered end 14 extending toward the transmitter 10 and has a highly conductive or shorting strip 15 of suitable material at the other end thereof. The vane is displaceable in and out of the guide 11 in the plane of maximum electric field intensity for providing an effective short circuit across the guide by means of strip 15 for selectively isolating the transmitter from its load antenna when in the guide while maintaining an approximate impedance match to the transmitter.

A suitable control device 16 may be employed to displace the vane 13 in and out of the guide 11 or, for some applications, the vane may be manually displaceable.

When the vane is out of the guide, the transmitter is coupled to the load antenna in a conventional manner.

When the vane is in the guide, as represented in Fig. 2, the resistive material of the vane absorbs energy from the transmitter while its tapered configuration causes a gradual change of impedance along the guide and thus maintains an approximate impedance match to the transmitter to minimize reflections back to the transmitter which would disrupt its operation. Thus, energy at an attenuated level reaches the shorting strip 15 where it is reflected toward the transmitter and is still further attenuated while passing the vane.

It has been found that an over-all attenuation in the order of 30 to 80 decibels may be provided by means of a vane $4\frac{1}{2}$ inches long at a broad band of frequencies of the order of 8,200 to 9,600 megacycles. In providing the effective short circuit across the guide, the shorting strip 15 may or may not touch the walls of the wave guide as desired.

From the foregoing description it will be seen that a microwave switch constructed in accordance with the invention has the advantages of being of simple construction and being capable of isolating the transmitter from its load antenna while maintaining an approximate impedance match to the transmitter.

While there has been described what is at present considered to be the preferred embodiment of this invention, it will be obvious to those skilled in the art that various changes and modifications may be made therein without departing from the invention, and it is, therefore, aimed to cover all such changes and modifications as fall within the true spirit and scope of the invention.

WHAT IS CLAIMED IS:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of

resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

2. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a shorting strip at the other end thereof and displaceable in and out of said guide in the plane of maximum electric field intensity for providing an effective short circuit across said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

3. A microwave switch for selectively isolating a microwave transmitter from its antenna load comprising: a microwave signal guide for connection to a microwave transmitter at one end and to an antenna load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said transmitter and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said transmitter from its load when in said guide while maintaining an approximate impedance match to said transmitter.

4. A microwave switch of the type specified and substantially as illustrated in the drawing and described in the specification with reference thereto.

Oath, Power of Attorney, and Petition

Being duly sworn, I, ROBERT REGIS depose and say that I am a citizen of the United States residing at Fresh Meadows, New York; that I have read the foregoing specification and claims and I verily believe I am the original, first, and sole inventor of the invention or discovery in MICROWAVE SWITCH described and claimed therein, that I do not know and do not believe that this invention was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that this invention or discovery has not been patented in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months before this application; and that no application for patent on this invention or discovery has been filed by me or my representatives or assigns in any country foreign to the United States, except as follows: No exceptions.

And I hereby appoint LAURENCE B. DODDS (Registration No. 12,982), whose address is 59-25 Little Neck Parkway, Little Neck 62, N.Y., my principal attorney with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith.

It is requested that all communications from the Patent Office in connection with the above-entitled application be addressed to LAURENCE B. DODDS at 59-25 Little Neck Parkway, Little Neck 62, N. Y.

Wherefore I pray that Letters Patent be granted to me for the invention or discovery described and claimed in the foregoing specification and claims, and I hereby subscribe my name to the foregoing specification and claims, oath, power of attorney, and this petition, this 20th day of December, 1957.

Inventor: /s/ Robert Regis

Post Office Address: 193-15B 69th Avenue
Fresh Meadows 62, New York

State of New York)
County of Queens) SS.

Before me personally appeared ROBERT REGIS to me known to be the person described in the above application for patent, who signed the foregoing instrument in my presence, and made oath before me to the allegations set forth therein as being under oath, on the day and year aforesaid.

/s/ Caroline B. Scott
CAROLINE B. SCOTT
Notary Public

SEAL

Notary Public State of New York
No. 30-8887200
Qualified in Nassau County
Cert. Filed with Queens County Clerk
Commission Expires March 30, 1968

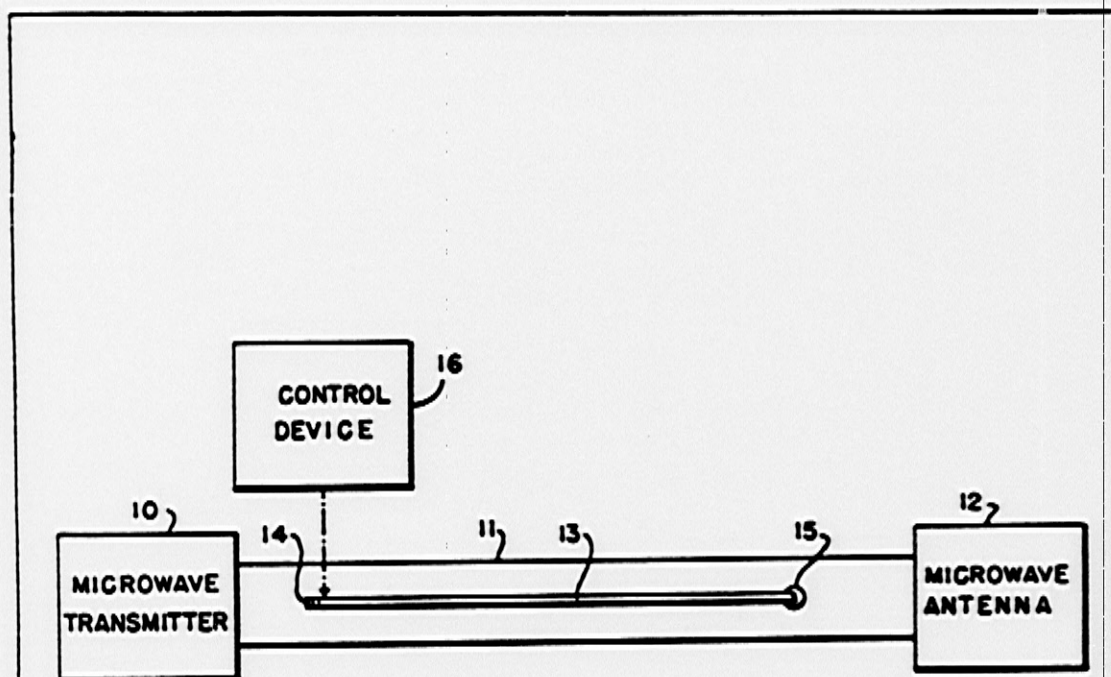


FIG. 1

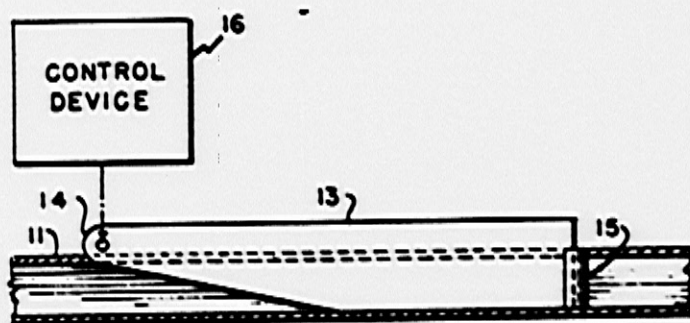


FIG. 2

16 A

IN THE UNITED STATES PATENT OFFICE

Division 69

In re application of

ROBERT REGIS

Serial No. 704,770

Filed December 23, 1957

For: MICROWAVE SWITCH

ASSOCIATE POWER OF ATTORNEY

Honorable Commissioner of Patents
Washington 25, D. C.

Sir:

The undersigned attorney of record in the above-entitled application hereby appoints

EDWARD A. RUESTOW

(Registration No. 15,014), whose address is 59-25 Little Neck Parkway, Little Neck 62, New York, his associate attorney, with full power to prosecute said application, to make alterations and amendments in said application, to receive the patent, and to transact all business in the Patent Office connected therewith.

It is requested that all communications from the Patent Office in connection with the above-entitled application be addressed to LAURENCE B. DODDS at 59-25 Little Neck Parkway, Little Neck 62, New York.

Respectfully,

/s/ L. B. Dodds

Attorney for Applicant

Little Neck, New York

Dated: January 15, 1958

17 A

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
Washington

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, N.Y.

Paper No. 4
Applicant: Robert Regis
Ser. No. 704,770
Filed December 23, 1957
For MICROWAVE SWITCH
Mailed July 7, 1958—Pat. Div. 69

*Please find below a communication from the EXAM-
INER in charge of this application.*

/s/ Robert C. Watson
Commissioner of Patents.

This application has been examined.

References applied:

Carlson 2,491,644 Dec. 20, 1949 333-81B

Bollinger, abstract of application Serial number 694,044
published November 21, 1950 640 O.G. 1032. 333-98S

Claims 1-3 are rejected as being unpatentable over
Carlson in view of Bollinger. No invention is seen in
using the switch of Bollinger in the attenuator of Carlson
since no new or unobvious result is produced thereby.

Claim 4 is rejected as being obviously nonstatutory.

/s/ J. E. Sax
Examiner

HSH
HSHertz:ap

18 A

IN THE UNITED STATES PATENT OFFICE

Division 69

In re application of
ROBERT REGIS
Serial No. 704,770
Filed December 23, 1957
For: MICROWAVE SWITCH

Honorable Commissioner of Patents
Washington 25, D. C.

Sir:

In response to the Office Action dated July 7, 1958,
please amend the above-identified application as follows:
Cancel claim 4.

REMARKS

Reconsideration and allowance of claims 1-3, inclusive,
rejected as being unpatentable over patent 2,491,644—
Carlson in view of abstract of application Serial No.
694,044—Bollinger, are respectfully requested.

Bollinger discloses a device comprising a series-resonant circuit which is effectively connected in shunt with the wave propagation system. Applicant believes this inherently causes his device to be a narrow band shunt. Applicant in his invention makes use of a shorting strip of suitable material which is highly conductive. This strip acts as a broad band shunt.

It is submitted that each of the claims under consideration does define invention over the cited references which lack one or more of the essential features of applicant's invention. Considering claim 1 as typical, that claim distinguishes from the references in that the references taken alone or in combination do not show:

"* * * and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximately impedance match to said source."

Carlson, taken alone, cannot achieve the degree of attenuation that applicant's invention is capable of achieving because the reference lacks the shorting strip. Combining Bollinger with Carlson, the degree of attenuation would be increased but only over a narrow band since Bollinger discloses a series-resonant circuit. Neither of the references discloses a highly conductive shorting strip.

This amendment is believed to place the application in condition for allowance, which action is respectfully solicited.

Respectfully submitted,

/s/ L. B. Dodds
Attorney for Applicant

Little Neck, New York -

Dated: October 29, 1958

20 A

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
Washington

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, N.Y.

Paper No. 6
Applicant: Robert Regis
Ser. No. 704,770
Filed December 23, 1957
For MICROWAVE SWITCH
Mailed Jan. 20, 1959—Pat. Div. 69

*Please find below a communication from the EXAM-
INER in charge of this application.*

/s/ Robert C. Watson
Commissioner of Patents.

Responsive to amendment filed October 30, 1958.
Reference applied:

Wallace 2,822,526 Feb. 4, 1958 333-81B
(Filed Mar. 24, 1954)

Claims 1-3 are rejected as being unpatentable over
Wallace cited in view of Carlson. No invention is seen
in designing the switch of Wallace in shape of a vane
as suggested by Carlson of record since no new or un-
obvious result would be produced thereby.

/s/ J. E. Sax
Examiner

HSH
HSHertz:ap

21 A

IN THE UNITED STATES PATENT OFFICE

Division 69

In re application of
ROBERT REGIS
Serial No. 704,770
Filed December 23, 1957
For: MICROWAVE SWITCH

Honorable Commissioner of Patents
Washington 25, D. C.

Sir:

This is in response to the Office Action dated January 20, 1959.

REMARKS

Reconsideration and allowance of claims 1-3, inclusive, rejected as being unpatentable over Wallace, et al., patent No. 2,822, 526, in view of Carlson, patent No. 2,491,644, are respectfully requested.

The Carlson reference discloses an attenuator vane which, while attenuating the signal, also presents a match to the source. Basically, the Carlson disclosure is not a switch but rather an attenuator. Since the attenuator lacks a shorting stub, a portion of the signal will still pass the attenuator even when the vane is inserted into the guide for minimum attenuation.

Wallace et al disclose two embodiments of a wave guide shutter. The first embodiment is subject to the same shortcoming as is the Carlson disclosure. More particularly, when the semicylindrical member 14 of Fig. 1 is inserted into the guide, a portion of the signal will still pass the shutter. In addition, the member 14 presents a mismatch while being inserted into the guide. In the second embodiment, the operation of which is sim-

ilar to the first, there is shown in Figs. 3 and 4 a metallic member which may inherently act as a shorting stub. However, the reference makes no mention of this as the function of the metallic member. The reference only refers to the energy-absorbing material 19 of Figs. 3 and 4 as that member which functions to attenuate the signal. The only reference made to the metallic member 26 is in explaining it to serve to close the opening in the wall of the wave guide when the shutter is in the open position. No reference is made to this metallic member with respect to attenuating the signal. It is, therefore, not known whether such a member will function to provide such results. Applicant, therefore, submits that the Wallace et al reference should not be considered as anticipating applicant's invention.

Applicant further submits that the Wallace et al reference is an improper reference in that it was a co-pending application. The issue date of February 4, 1958 is after applicant's filing date of December 23, 1957. Consequently, Wallace et al are not part of the prior art and can only be considered under Section 102 (e) from the standpoint of whether it alone "describes" applicant's invention. Section 102 (e) enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 290, to the same effect. Wallace et al are not part of the prior art because it was secret in the Patent Office when applicant filed as 35 U.S.C. 122 provides.

This application is now believed to be in condition for allowance, which action is respectfully requested.

Respectfully submitted,

/s/ E. A. Ruestow
Attorney for Applicant

Little Neck, New York

Dated: June 2, 1959

23 A

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
Washington

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, N.Y.

Paper No. 8
Applicant: Robert Regis
Ser. No. 704,770
Filed December 23, 1957
For MICROWAVE SWITCH
Mailed Jun. 24, 1959—Pat. Div. 65

*Please find below a communication from the EXAM-
INER in charge of this application.*

/s/ Robert C. Watson
Commissioner of Patent.

Responsive to letter filed June 4, 1959.

Claims 1-3 are again rejected as being unpatentable over Wallace in view of Carlson. No invention is seen in designing the switch of Wallace in the shape of a vane as suggested by Carlson since no new or unobvious result is produced thereby.

Applicant's argument on page 2, lines 15-20 of paper No. 7 is untenable. When the member 26 of Wallace is in the position shown in Fig. 4, it necessarily functions as a short circuit across the wave guide 22. There is no showing in the case to the contrary.

Applicant's argument on the bottom of page 2 and page 3 of paper No. 7 (filed June 4, 1959) that Wallace is an improper reference is also untenable. See *In re Gregg* 1957 C.D. 284.

24 A

This action has been taken up out of its regular turn under the authority of Commissioner's Order No. 3084, October 29, 1928 (708.01 M.P.E.P.).

Since an issue has clearly been reached, this action is made *FINAL*.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE SEPTEMBER 25, 1959.

/s/ J. E. Sax
Examiner

HSH
HSHertz:ap

25 A

IN THE UNITED STATES PATENT OFFICE

Division 65

In re application of
ROBERT REGIS
Serial No. 704,770
Filed December 23, 1957
For: MICROWAVE SWITCH

APPEAL TO THE BOARD OF APPEALS

Honorable Commissioner of Patents
Washington 25, D. C.

Sir:

Appeal is hereby taken to the Board of Appeals from the decision of the Primary Examiner finally rejecting claims 1-3, inclusive, of the subject application.

Check in the amount of Twenty-five Dollars (\$25.00) covering the appeal fee is enclosed herewith.

Respectfully submitted,

/s/ E. A. Ruestow
Attorney for Applicant

Little Neck, New York

Dated: September 21, 1959

Enclosure

• • • •

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

In re application of
ROBERT REGIS
Serial No. 704,770
Filed December 23, 1957
For: MICROWAVE SWITCH

BRIEF ON APPEAL

This is an Appeal from the Final Rejection of claims 1-3, inclusive, rejected as being unpatentable over Wallace et al—Patent No. 2,822,526 in view of Carlson—Patent No. 2,491,644. Oral hearing is requested. Accordingly, this Brief is submitted in triplicate (Rule 192). A copy of the claims in issue is appended to the Brief.

THE INVENTION

This invention relates to microwave switches and, more particularly, to the type which selectively isolate a microwave source from its load.

Referring to Fig. 1, a microwave source such as the microwave transmitter 10 is coupled to a microwave antenna 12 through a wave guide 11. An attenuator vane 13 of resistive material is disposed in a slot in the guide. As shown in Fig. 2, the vane has a tapered end extending toward the transmitter and has a highly conductive or shorting strip 15 of suitable material at the other end thereof. While the vane is in the slot an effective short circuit exists across the guide. When the vane is removed from the slot the transmitter is coupled to the antenna in a conventional manner.

27 A

When the vane is in the guide the resistive material absorbs the energy from the transmitter. Because of the configuration of the vane the signal reaching the shorting strip is attenuated. After reflection at the shorting strip the signal is further attenuated, thereby causing no disruption of the operation of the transmitter.

THE REJECTION

The Examiner contends that claims 1-3, inclusive, are unpatentable over Wallace et al in view of Carlson.

There is no need to discuss the actual disclosures of Wallace et al and Carlson in view of the arguments which follow. Suffice it to say that Examiner asserts that it is possible to combine them as an engineering matter to arrive at applicant's invention. We shall accept the assertion as valid for purposes of argument.

COPENING REFERENCES

Applicant contends that the Wallace et al reference cannot be combined with any other reference because it was copending with applicant's application. The issue date of February 4, 1958, is after applicant's filing date of December 23, 1957. Applicant insists that any copending reference, such as Wallace et al, is not part of the prior art and must stand alone against the present application on the limited question of whether it actually describes applicant's invention. Admittedly, the case law is in conflict. But, the Patent Act of 1952 turns the balance.

The status of all patents relied on by the Examiner is determined solely by 35 USC 102 and 35 USC 103.

Section 102 begins with the statement:

"A person shall be entitled to a patent unless * * * clearly indicating that the immediately following list (a), (b), (c), (d), (e), (f) and (g) of such grounds for invalidation is exclusive of all others not stated there or in Section 103. Grounds (b), (c), (d) and (f) are obviously inapplicable to the present issue. The others read in pertinent part:

"(a) *the invention* was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(e) *the invention* was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

"(g) before the applicant's invention thereof *the invention* was made in this country by another who had not abandoned, suppressed, or concealed it. * * *

The wording of the list, particularly in view of the under-scored* portions which find their counterpart in some of the grounds not quoted, clearly indicates that for any one of the grounds of invalidation to be applicable, *the invention* must be found in one reference as an integrated whole—all in one place, so to speak—not synthesized from separate references. If emphasis of this point were needed, it would be found in the first three lines of Section 103 which states in pertinent part:

"A patent may not be obtained though the invention is not *identically* disclosed or described as *set forth* in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

*—Italicized Herein

and also in the following reference to Section 103 in the Report of the Committee on the Judiciary:

"* * * An invention which has been made, and which is new in the sense that the *same thing* has not been made before, may still not be patentable * * *." (82nd Congress, House Report, No. 1923, May 12, 1952).

This can only mean that Section 102 was intended to refer to *a disclosure of the complete invention in one reference* and that Section 103 was intended to supply the only exception.

Particularly as to Section 102(a), the fact that the case law on prior knowledge and use requires a complete integrated disclosure, shows that this is what the Act also contemplates.

Section 103 adds a more general ground of invalidation since it is the only provision permitting one to synthesize an anticipation from scattered elements of the prior art.

The very existence of Section 102(e) makes it obvious that copending patents are recognized as a special situation. In this situation, by standard canons of interpretation, the juxtaposition of Sections 102 and 103 leads to the conclusion that only Section 102(e) is applicable to a copending patent reference, such as *Wallace et al*, which was filed before the immediate application but issued thereafter.

It has always been held that specific terms of a statute prevail over general terms. Thus in *Fourco v. Transmirra* (1957), 353 U.S. 222; 113 USPQ 234, the Supreme Court held that the general corporation venue statute 28 USC 1391(c) was inapplicable in patent infringement actions by virtue of the special venue statute 28 USC

1400(b) which prescribes venue in patent actions. The Court said:

"We think it is clear that Section 1391(c) is a general corporation venue statute, whereas Section 1400(b) is a special venue statute applicable, specifically, to *all** defendants in a particular type of actions, i.e., patent infringement actions. In these circumstances the law is settled that '*However inclusive may be the general language of a statute, it "will not be held to apply to a matter specifically dealt with in another part of the same enactment. . . . Specific terms prevail over the general in the same or another statute which otherwise might be controlling."*' Ginsberg & Sons v. Popkin, 285 U.S. 204, 208; MacEvoy Co. v. United States, 322 U.S. 102, 107." (*Emphasis Court's)

By its very terms Section 102(e) is specific to the situation of a copending patent. Moreover, it is specific for the further reason of its very history. This paragraph (e), as the Reviser's notes (House Report 1923; 35 U.S.C.A. 102) state, enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390. In that case the Court ruled that a copending United States patent, which gives "*a complete and adequate description of the thing*" (p. 399, again on p. 400), claimed in a later filed patent, dates from the date of filing of the copending application for the purpose of showing that the later applicant could not be the first inventor even though the copending patent issued after the later inventor filed.

Moreover, if Section 103 were applicable to copending patents, Section 102(e) would be rendered meaningless; if a copending patent is prior art under Section 103, there is no need for Section 102(e). An interpretation which renders any provision meaningless has always been held to be improper:

"* * * We are not at liberty to construe any statute so as to deny effect to any part of its lan-

guage. It is a cardinal rule of statutory construction that significance and effect shall, if possible, be accorded to every word. (p. 115)

"* * * Another rule equally recognized is, that every part of a statute must be construed in connection with the whole, so as to make all the parts harmonize, if possible, and give meaning to each." (p. 116) *Washington Market Co. v. James A. Hoffman*, 101 U.S. 112, (followed in *Ex parte Public National Bank of New York*, 278 U.S. 101, 104.)

It is clear then that Section 102(e) is to stand alone. And if it is to stand alone, we ought to examine its precise words. It says: "the invention was described". This language stands out. It has a peremptory command in it; *the invention* must be pointed out. That is the ordinary meaning of the word "describe". The language does not say that it will suffice if one can look at the copending patent and synthesize the missing parts from true prior art.

The conclusion that Section 103 is inapplicable to copending patents is reinforced by Section 122 and by numerous prior decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available knowledge until the patent issues. Copending patent applications have always been kept in secrecy in the Patent Office and Section 122 now specifically so provides. Section 122 reads:

"Section 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out

32 A

the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." 35 USC 122

Respectfully submitted,

/s/ E. A. Ruestow
Attorney for Applicant

Little Neck, New York
Dated: October 29, 1959

APPENDIX

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

2. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a shorting strip at the other end thereof and displaceable in and out of said guide in the plane of maximum electric field intensity for providing an effective short circuit across said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

3. A microwave switch for selectively isolating a microwave transmitter from its antenna load comprising: a microwave signal guide for connection to a microwave transmitter at one end and to an antenna load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said transmitter and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said transmitter from its load when in said guide while maintaining an approximate impedance match to said transmitter.

34 A

U. S. DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
Washington

Appeal No. 29098

Before the Board of Appeals

Paper No. 11
In re application of
Robert Regis
Ser. No. 704,770
Filed December 23, 1957
For MICROWAVE SWITCH
Mailed Nov. 10, 1959—Pat. Div. 65

Mr. Laurence B. Dodds for Appellant

Examiner's Answer

This is an appeal from the final rejection of claims 1-3.
No claims are allowed.

A correct copy of the appealed claims appears on page
1a of the applicant's brief.

The references of record relied on are:

Carlson 2,491,644 Dec. 20, 1949
Wallace et al. 2,822,526 Feb. 4, 1958
 (Filed Mar. 24, 1954)

A description of the claimed switch, of the devices
shown in the references and the application of the ref-
erences to the claims are not believed to be necessary for
the following reason. The instant appeal raises only a
question of law, namely whether or not the two refer-
ences, one of which was copending with the instant ap-
plication, may be combined in the holding that claims
1-3 are unpatentable. The rejection was on one patent
issued on an application filed prior to the filing date of
the instant application, but issued subsequent to such

date, in view of a second patent issued prior to the filing date of the instant application. Appellant concedes that if these two patents are available for use as references that can be combined, their combination negatives patentability on the claim. This concession is expressed in the brief in the sentences on page 2, lines 14-19, as follows:

"There is no need to discuss the actual disclosures of Wallace et al. and Carlson in view of the arguments which follows. Suffice it to say that Examiner asserts that it is possible to combine them as an engineering matter to arrive at applicant's invention. We shall accept the assertion as valid for purposes of argument."

The facts to this issue are as follows:

(1) The Carlson patent was issued prior to the filing date (December 23, 1957) of the present application, while the Wallace et al. patent issued after the filing date of the present application, but was filed (March 24, 1954) earlier than the present application.

(2) The two patents are to inventors different from the one in the present application and no common assignment is apparent.

(3) Applicant has not sworn back of either reference under the provision of Rule 131.

(4) In utilizing the Carlson and Wallace et al. patents as references the Examiner followed the instruction set forth in the third paragraph of Section 706.02 of the Manual of Patent Examining Procedure, as supported by the decisions cited therein and also the decision of *In re Gregg*, 1957 C.D. 284.

Applicant's arguments have been considered, but are not seen as being persuasive as to the alleged intent of the Patent Act of 1952. It appears to have been well settled law prior to the 1952 Patent Act that co-pending

patents having valid effective dates takes singly or in combination, were available as references and that nothing in the Patent Act of 1952 effected a change in this procedure. For authority as to this conclusion, the Examiner cites the following Board of Appeals decisions:

Ex parte Teague and De Padova 108 U.S.P.Q. 380.

Ex parte Machlarski 111 U.S.P.Q. 459.

Ex parte Kuznitz 113 U.S.P.Q. 255.

In each of the above cases, substantially the same arguments as advanced in applicant's brief were raised, and in each case, it was held that the Patent Act of 1952 did not change the established policy of utilizing co-pending patents having valid effective dates as references.

In addition the following statement by the Court of Customs and Patent Appeals (In re Gregg 1957 C.D. 284) appears to be directly in point and is quoted in its entirety.

"We are unable to agree with appellant that the prior art referred to in section 103 of the 1952 Act is limited to art which was available to the public prior to the date of the applicant's invention. The section clearly does not make any express statement to that effect, and no reason appears for reading such a limitation into it. It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. In re Seid, 34 C.C.P.A. (Patents) 1039, 161 F. 2d 229, 73 USPQ 431, and cases there cited. There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952."

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37 A

For the above reasons, the Carlson and Wallace et al. patents are believed to be properly combined. Therefore, since applicant does not otherwise contend that these references are not applicable to claims 1-3, the rejection of these claims is considered proper and should be affirmed.

Respectfully submitted,

/s/ J. E. Sax
Examiner, Div. 65

HSH
HSHertziap

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, N.Y.

38 A

U. S. DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
Washington

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, New York

Paper No. 12
Appeal No.: 290-98
Appellant: REGIS, ROBERT
Serial No.: 704,770

Hearing

Date: May 31, 1962
Time: 9:30 A.M.

NOTICE OF HEARING

The appeal in the above identified case will be heard by the Board of Appeals on the date indicated.

The hearings will commence at the time set and as soon as the argument in one case is concluded, the succeeding case will be taken up.

The time allowed for argument is thirty minutes unless additional time is requested and permitted before the argument is commenced.

By Order of the Board of Appeals.

/s/ Nicholas Hahn
Administrative Officer

39 A

IN THE UNITED STATES PATENT OFFICE

Division 65

Appeal No. 290-98

In re application of
ROBERT REGIS
Serial No. 704,770
Filed December 23, 1957
For: MICROWAVE SWITCH

ASSOCIATE POWER OF ATTORNEY

Honorable Commissioner of Patents
Washington 25, D. C.

Sir:

The undersigned attorney of record in the above-entitled application hereby appoints

ANDREW L. NEY

(Registration No. 20,300), whose address is 59-25 Little Neck Parkway, Little Neck 62, New York, his associate agent, with full power to prosecute said application, to make alterations and amendments in said application, to receive the patent, and to transact all business in the Patent Office connected therewith.

It is requested that all communications from the Patent Office in connection with the above-entitled application be addressed to LAURENCE B. DODDS at 59-25 Little Neck Parkway, Little Neck 62, New York.

Respectfully,

/s/ L. B. Dodds
Attorney for Applicant

Little Neck, New York
Dated: September 27, 1961

40 A

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
Washington 25, D.C.

January 11, 1962

Paper No. 14
Appeal No.: 290-98
Appellant: Regis, Robert
Serial No.: 704,770

Hearing

Date: March 20, 1962
Time: 9:30 A.M.

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, N.Y.

NOTICE OF HEARING

The appeal in the above identified case will be heard by the Board of Appeals on the date indicated.

The hearings will commence at the time set and as soon as the argument in one case is concluded, the succeeding case will be taken up.

The time allowed for argument is thirty minutes unless additional time is requested and permitted before the argument is commenced.

By Order of the Board of Appeals.

/s/ Nicholas Hahn
Administrative Officer

Hearing in this case re-set in view of the increase in personnel permitting the Board to advance hearing dates of some cases.

41 A

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

In re application of
ROBERT REGIS
Serial No. 704,770
Filed December 23, 1957
For: MICROWAVE SWITCH

APPEAL TO THE BOARD OF APPEALS

On review, the request for oral hearing is withdrawn for the reason that it is believed that the brief filed on this appeal adequately clarifies the issues.

Accordingly, it is requested that the hearing set for March 20, 1962 be cancelled.

Respectfully submitted,

/s/ Andrew L. Ney
Associate Agent for Applicant

Little Neck, New York

Dated: January 30, 1962

42 A

Paper No. 16

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

BEFORE THE BOARD OF APPEALS

Mailed Mar. 28, 1962

U.S. Patent Office, Board of Appeals

Ex parte Robert Regis

Application for Patent filed December 23, 1957, Serial No. 704,770. Microwave Switch.

Messrs. Laurence B. Dodds, Edward A. Ruestow, and Andrew L. Ney for appellant.

Before McCann, Kreek and Keely, Examiners-in-Chief.
Keely, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1, 2 and 3, all the claims now in the case.

Claim 1 is representative and reads as follows:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

The references relied upon are:

Carlson 2,491,644 Dec. 20, 1949
Wallace et al. 2,822,526 Feb. 4, 1958

The rejected claims relate to a microwave switch which is adequately described in appellant's brief to which reference is made.

The claims stand rejected as being unpatentable over Wallace et al. in view of Carlson.

It is asserted by the Examiner that appellant has conceded that if the patent to Wallace et al. is available as a reference then it may be combined with Carlson and that the combination negatives invention in the instant case.

It is the position of the Examiner that prior to the 1953 (sic) Patent Act copending patents either singularly or in combination were valid references. He contends that said Act has not changed this situation and he cites our decisions *Ex parte* Teague et al., 108 USPQ 380; *Ex parte* Machlanski, 111 USPQ 459; and *Ex parte* Kuzmitz, 113 USPQ 255 as well as the Court of Customs and Patent Appeals decision in *In re Gregg*, 44 CCPA 904, 1957 C.D. 284, 720 O.G. 227, 244 F.(2d) 316, 113 USPQ 526 as supporting his position.

Appellant challenged the rejection contending that Wallace et al. is not prior art and for this reason cannot be combined with Carlson.

It is urged by appellant that 35 U.S.C. 102 requires that an appellant must be granted a patent unless one of the prohibitions of the seven sub-paragraphs of this section applies. He considers sub-paragraphs (a), (e) as being the only ones applicable. Pointing to the term "the invention" of these paragraphs he argues that the quoted term requires that his complete device must be found in a single reference before Section 102 is applicable.

He submits that his arguments are fortified by the terms of 35 U.S.C. 103, which uses the following language in referring to 35 U.S.C. 102,

"... not identically disclosed or described as set forth in section 102 . . ."

He concludes that Section 102 restricts the prior art to a single reference, and that Section 103 was intended to supply the only exception.

Turning next to Section 103, he urges that if this Section relates to copending patents then it would be in conflict with Section 102(e) and the latter would be unnecessary. He contends that such an interpretation of the statutes is improper and that Section 102(e) is to stand alone in relation to copending patents.

He considers that his reasoning that Section 103 is inapplicable to copending patents is reinforced by Section 122 which requires that patent applications be kept in secrecy, as well as by numerous decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available until the patent issues.

We have reviewed the pertinent sections of the statutes and case law in the light of the Examiner's and appellant's remarks and as a result of our review are in full accord with the position of the Examiner.

It appears to us that the issues raised by appellant have been decided by the Court of Customs and Patent Appeals in *In re Gregg* as well as by us in our previous decisions cited above.

The arguments in appellant's brief appear to be pointless. On page 6, appellant admits that 35 U.S.C. 102(e) enacts the rule of *Milburn Co. v. Davis Bournonville Co.*, 1926 C.D. 303, 344 O.G. 817, 270 U.S. 390, which held that a patent was a reference for what it disclosed as of its filing date.

It is obvious that Wallace et al., as of his filing date, had the structure necessary for modifications in the light of Carlson to achieve the disputed claimed structure. Appellant has admitted that the modification is ob-

vious. Under these circumstances the claimed structure was obviously within the grasp of Wallace et al. about three years and nine months prior to appellant's entry into the field.

Section 103, as we view it, concerns itself only with the circumstances under which a reference that is not anticipatory of the claimed device or method may be used. This section complements sub-paragraphs (a), (b), (e) and (g) of 102 without indicating the type of evidence which will be used to establish obviousness, the qualification of the evidence being found in other sections of the statute and pertinent case law, as for example the cases cited above.

Accordingly, we will sustain the rejection of the claims.

We have carefully considered the contentions and arguments presented in appellant's brief but we are of the opinion that the Examiner's rejection was proper and it will be sustained.

The decision of the Examiner is affirmed.

AFFIRMED

/s/ L. P. McCann
Examiner-in-Chief

/s/ Louis F. Kreek
Examiner-in-Chief

/s/ J. E. Keely
Examiner-in-Chief
Board of Appeals

Laurence B. Dodds
59-25 Little Neck Parkway
Little Neck 62, New York

46 A

U. S. DEPARTMENT OF COMMERCE

PATENT OFFICE

Washington

Re: Application of
Robert Regis
Serial No. 704,770
Filed December 23, 1957
For: Microwave Switch

NOTICE OF CIVIL ACTION UNDER 35 U. S. C. 145

A civil action No. 1688-62, under 35 U.S.C. 145, entitled Hazeltine Research, Inc. and Robert Regis v. David L. Ladd, Commissioner of Patents, involving this application, was filed in the United States District Court for the District of Columbia, on May 25, 1962.

/s/ C. W. Moore
Solicitor

* * * *

Plaintiff's Exhibit 2

ASSIGNMENT

In consideration of One Dollar and other good and valuable consideration, the receipt of which is hereby acknowledged, I, ROBERT REGIS, of Fresh Meadows, New York, sell and assign to HAZELTINE RESEARCH, INC., a corporation of Illinois, of 5445 West Diversey Avenue, Chicago 39, Illinois, its successors, assigns and nominees, the invention relating to improvements in

MICROWAVE SWITCH

invented by me, and the application for United States Patent therefor executed concurrently herewith, and all divisions and continuations thereof, and all Patents which may be granted therefor and all reissues and extensions thereof, and authorize and request the Commissioner of Patents to issue all Patents on said invention or resulting therefrom to said Company as assignee of the entire interest, and covenant that I have full right so to do, and agree that I will communicate to said Company or its representatives any facts known to me respecting said invention and testify in any legal proceeding, execute all divisional, continuing and reissue applications and all assignments of said invention and of the right to apply for Letters Patent therefor in all countries, make all rightful oaths, sign all other lawful papers, and generally do everything reasonably possible to aid said Company, its successors, assigns and nominees, to obtain and enforce proper patent protection for said invention in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 20th day of December, 1957.

/s/ Robert Regis

L. S.

48 A

State of New York
County of Queens ss.:

On this 20th day of December, 1957, before me, a Notary Public in and for the State and County aforesaid, personally appeared ROBERT REGIS, to me known and known to me to be the person of such name, who signed and sealed the foregoing instrument, and who acknowledged the same to be his free act and deed.

/s/ Caroline B. Scott
CAROLINE B. SCOTT

Notary Public, State of New York
No. 30-8887200
Quailified in Nassau County
Cert. filed with Queens County Clerk
Commission Expires March 30, 1968

Notarial Seal

49 A

Plaintiff's Exhibit 3

STATE OF ILLINOIS

OFFICE OF THE SECRETARY OF STATE

To all to whom these Presents Shall Come, Greeting:

I, CHARLES F. CARPENTIER, Secretary of State of the State of Illinois do hereby certify that HAZELTINE RE-SEARCH, INC., a domestic corporation, incorporated under the laws of this State March 28, 1946, appears to have complied with all the provisions of the Business Corporation Act of this State, relating to the filing of annual reports and payment of franchise taxes, and as of this date, is in Good Standing as a domestic corporation of the State of Illinois.

In Testimony Whereof. I hereto set my hand and cause to be affixed the Great Seal of the State of Illinois, Done at the City of Springfield this 27th day of March A.D. 1963.

[SEAL]

/s/ Charles F. Carpentier
Secretary of State

* * * *

50 A
Defendant's Exhibit 1A

Dec. 20, 1949

C. P. CARLSON
ATTENUATOR

2,491,644

Filed Aug. 24, 1945

2 Sheets-Sheet 2

FIG. 5

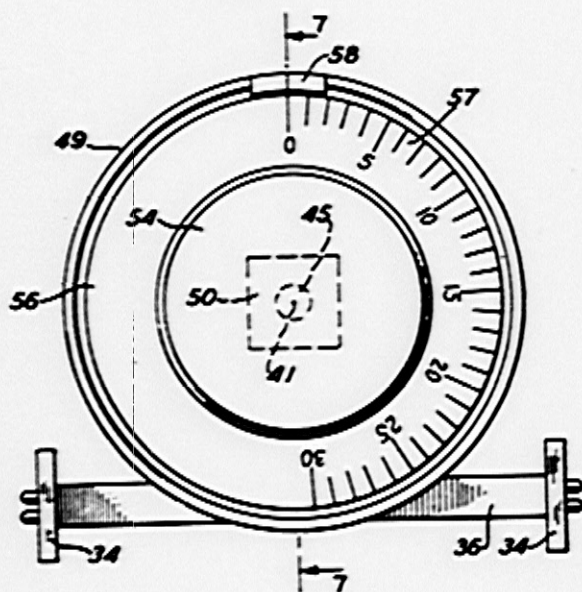


FIG. 6

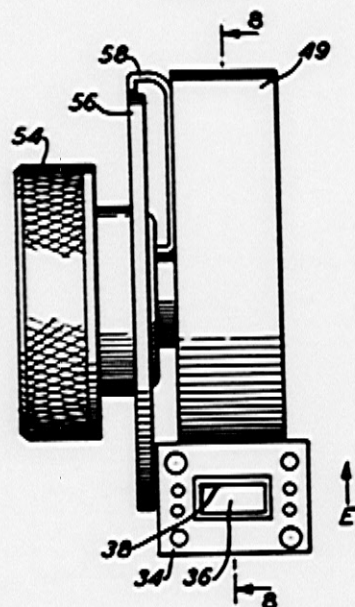


FIG. 7

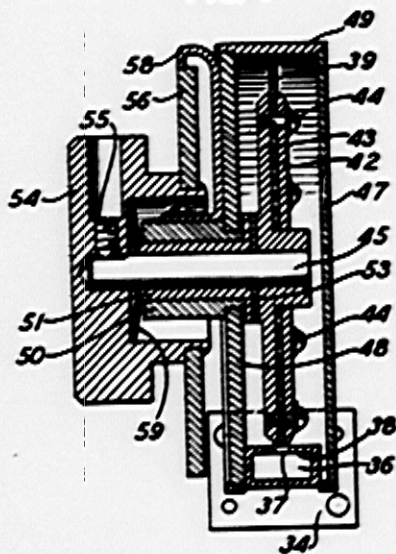
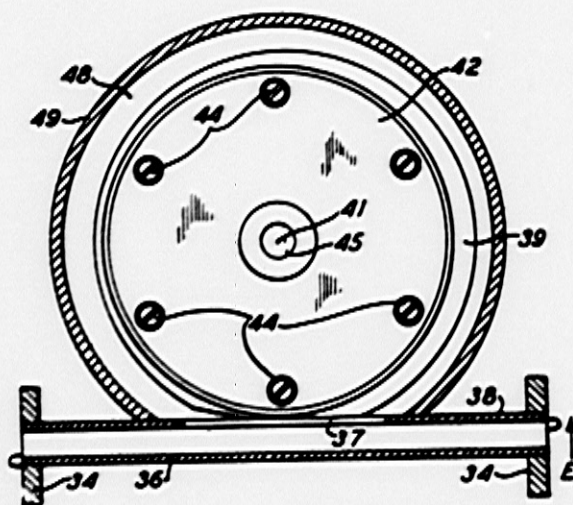


FIG. 8



INVENTOR
C. P. CARLSON
BY

Ralph T. Holcomb
ATTORNEY

Dec. 20, 1949

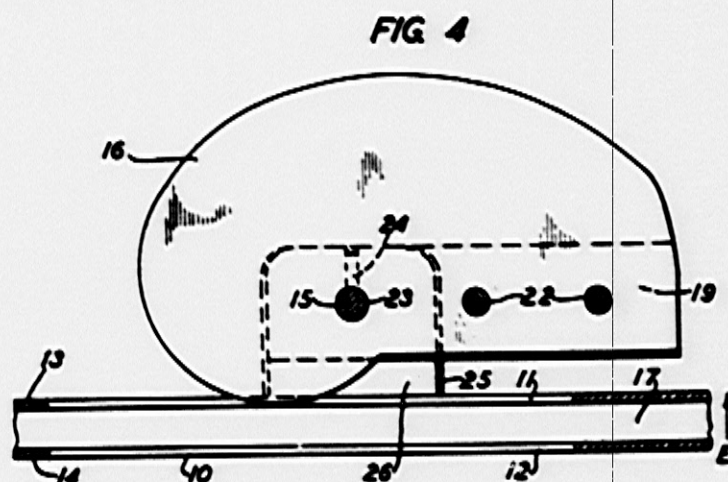
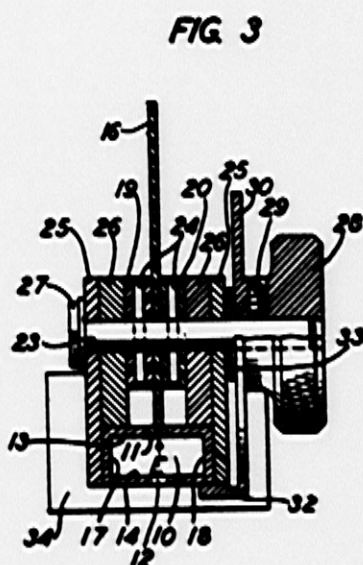
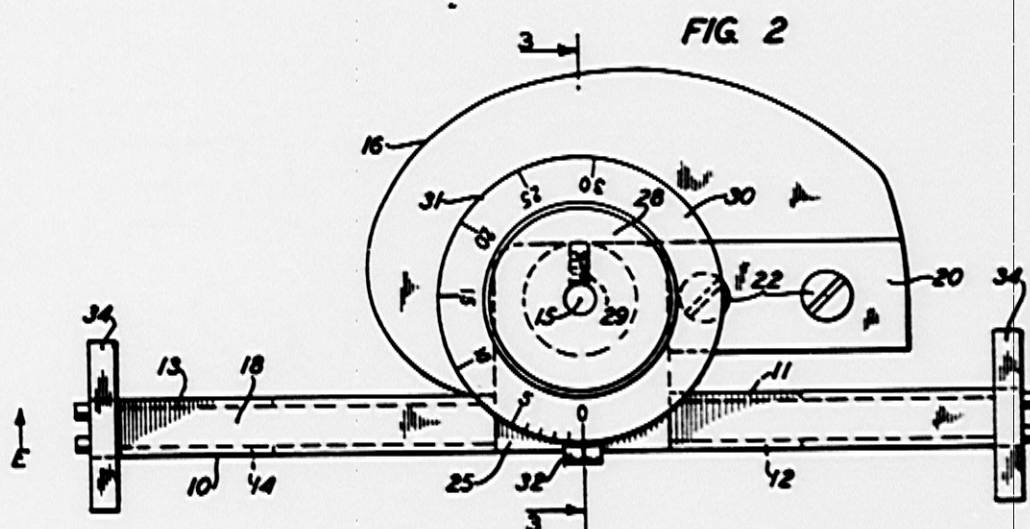
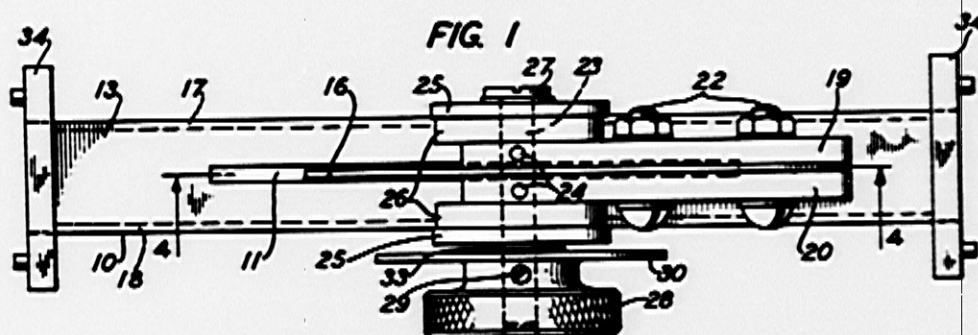
C. P. CARLSON

2,491,644

ATTENUATOR

Filed Aug. 24, 1945

2 Sheets-Sheet 1

INVENTOR
C. P. CARLSON

BY

Ralph F. Holcomb
ATTORNEY

Patented Dec. 20, 1949

2,491,644

UNITED STATES PATENT OFFICE

2,491,644

ATTENUATOR

Carl P. Carlson, Tenafly, N. J., assignor to Bell Telephone Laboratories, Incorporated, New York, N. Y., a corporation of New York

Application August 24, 1945, Serial No. 612,394

13 Claims. (Cl. 178-44)

1

This invention relates to attenuators and more particularly to variable attenuators for use with wave guides.

The principal object of the invention is to attenuate electromagnetic energy flowing in a hollow wave guide. Other objects are to make the attenuation in decibels of a variable wave guide attenuator substantially proportional to the angular rotation of a resistive element and to increase the maximum attenuation obtainable.

The variable wave guide attenuator in accordance with the present invention comprises a straight, hollow wave guide having a longitudinal slot in a wall thereof and a rotatable resistive vane mounted so that its edge projects through the slot into the guide. The contour of the vane deviates from the arc of a circle in such a way that the attenuation in decibels is substantially proportional to the angle through which the vane is rotated. In this way, congested regions in the attenuation scale are avoided, permitting a more accurate setting of the attenuator. To increase the maximum attenuation obtainable the vane may cut clear through the guide and emerge through a second slot in the wall.

The nature of the invention will be more fully understood from the following detailed description and by reference to the accompanying drawing, in which like reference characters refer to similar or corresponding parts and in which:

Fig. 1 is a top view of a two-slot wave guide attenuator in accordance with the invention;

Fig. 2 is a side view thereof;

Fig. 3 shows a transverse cross-section taken on the line 3-3 of Fig. 2;

Fig. 4 shows a partial longitudinal cross-section taken on the line 4-4 of Fig. 1;

Fig. 5 is a side view of another attenuator in accordance with the invention, employing only a single slot;

Fig. 6 is an end view of the attenuator of Fig. 5;

Fig. 7 shows a transverse cross-section taken on the line 7-7 of Fig. 5; and

Fig. 8 is a longitudinal cross-section taken on the line 8-8 of Fig. 6.

The variable wave guide attenuator shown in Figs. 1, 2, 3 and 4 comprises a hollow, straight wave guide 10 having two oppositely disposed slots 11 and 12 in the opposite sides 13 and 14, respectively, and a resistive vane 16 rotatably mounted about the pivot point 15 so that its edge will enter the guide 10 through the upper slot 11 and emerge through the lower slot 12. The vane 16 is preferably positioned parallel to the transverse electric

2

field of the electromagnetic waves to be attenuated. In the guide 10, which is of rectangular cross-section with unequal cross-sectional dimensions, this field is ordinarily parallel to the narrower sides 17 and 18, as indicated by the arrow E in Figs. 2, 3 and 4. The slots 11 and 12 are, therefore, in the wider sides 13 and 14 and are preferably centrally located so that the vane 16 will be in the most intense portion of the field.

The vane 16 is clamped between the two blocks 19 and 20 by the bolts 22 and secured to the shaft 23 by the pins 24. The shaft 23, which has a head 27, turns in bearings in the two upright supports 25, secured to the sides 17 and 18 of the guide 10. The edge of the vane 16 is centered in the slots 11 and 12 by means of the spacers 26. A knob 28 attached to the shaft 23 by a set screw 29 facilitates turning. A dial 30 attached to the knob 28 has a scale 31 calibrated in decibels upon which the attenuation introduced may be read at the index 32. A spring washer 33 between the dial 30 and the support 25 takes up end play in the shaft 23. The end flanges 34 are provided for connecting the guide 10 to other sections of wave guide.

As shown in the drawing, the vane 16 is entirely withdrawn from the interior of the guide 10 and the attenuation reading is zero. To introduce attenuation, the vane 16 is rotated in a counter-clockwise direction about the pivot point 15 by means of the knob 28. The edge of the vane 16 enters the guide 10 through the upper slot 11, passes all the way across the guide, and eventually comes out through the lower slot 12 on the other side. Permitting the vane 16 to extend clear through the guide increases the maximum attenuation obtainable with the attenuator. The contour of the vane 16 preferably so deviates from the arc of a circle that the attenuation in decibels introduced is substantially proportional to the angle through which the vane is rotated. Congested regions in the scale 31 are thus avoided and more accurate attenuation settings are possible.

Figs. 5, 6, 7 and 8 show a modified embodiment of a variable wave guide attenuator in accordance with the invention in which the guide has only a single slot. The attenuator comprises a straight, hollow, rectangular wave guide 36 having a slot 37 centrally located in one of the wider sides 38 and a resistive vane 39 mounted for rotation about the pivot point 41 so that its edge will project through the slot 37 into the interior of the guide 36.

The vane 39 is clamped between two circular

2,491,644

3

plates 42 and 43 by means of six screws 44 and the assembly is secured to the inner end of the shaft 45. This assembly is enclosed in a metallic shield formed of the two circular plates 47 and 48 and a short cylinder 49 securely attached at its base to the guide 36. The plate 48 carries a journal box 50 in which rotates the flanged cylindrical bearing 51 surrounding a portion of the shaft 45. The edge of the vane 39 is centered in the slot 37 by the washer 52. A knob 54 attached to the outer end of the shaft 45 by a set screw 55 carries a dial 56 with a scale 57, calibrated in decibels of attenuation, which may be read at the index 58. A spring washer 59 between the bearing 51 and the knob 54 prevents end play in the shaft 45.

As shown in Figs. 5, 6, 7 and 8 the attenuator is set at zero and therefore the vane 39 is entirely withdrawn from the guide 36. However, as the knob 54 is turned in a counter-clockwise direction the edge of the vane 39 gradually passes through the slot 37 into the interior of the guide 36 and the attenuation is increased correspondingly. In this attenuator, also, the contour of the vane 39 preferably so deviates from the arc of a circle that the attenuation in decibels is a substantially linear function of the angular rotation.

What is claimed is:

1. A variable attenuator for electromagnetic waves comprising a hollow wave guide having a longitudinal slot in a wall thereof, a rotatable resistive vane mounted so that its edge projects through said slot into said guide, and a metallic shield enclosing said vane, the contour of said vane so deviating from the arc of a circle that the attenuation in decibels is substantially proportional to the angular rotation of said vane.

2. An attenuator in accordance with claim 1 in which said guide has a substantially straight longitudinal axis.

3. An attenuator in accordance with claim 1 which includes a second slot in the wall of said guide, said slots being oppositely disposed and said vane being so shaped that, upon rotation, it cuts clear through said guide and emerges through said second slot.

4. An attenuator in accordance with claim 1 in which said vane is parallel to the transverse electric field of the electromagnetic waves to be attenuated.

4

5. An attenuator in accordance with claim 1 in which said guide is of rectangular cross-section and said slot is centrally located in one of the sides thereof.

6. An attenuator in accordance with claim 1 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slot is in one of the wider sides thereof.

7. An attenuator in accordance with claim 1 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slot is centrally located in one of the wider sides thereof.

8. A variable attenuator for electromagnetic waves comprising a hollow wave guide having two oppositely disposed longitudinal slots in the wall thereof and a rotatable resistive vane mounted so that, upon rotation, its edge enters said guide through one of said slots and emerges therefrom through the other of said slots.

9. An attenuator in accordance with claim 8 in which the contour of said vane is so shaped that the attenuation in decibels is substantially proportional to the angular rotation of said vane.

10. An attenuator in accordance with claim 8 in which said vane is parallel to the transverse electric field of the electromagnetic waves to be attenuated.

11. An attenuator in accordance with claim 8 in which said guide is of rectangular cross-section and said slots are centrally located in opposite sides thereof.

12. An attenuator in accordance with claim 8 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slots are in the wider sides thereof.

13. An attenuator in accordance with claim 8 in which said guide is of rectangular cross-section with unequal cross-sectional dimensions and said slots are centrally located in the wider sides thereof.

CARL P. CARLSON.

REFERENCES CITED

The following references are of record in the file of this patent:

UNITED STATES PATENTS

Number	Name	Date
2,151,157	Schelkunoff	Mar. 21, 1939

54 A

Defendant's Exhibit 1B

Feb. 4, 1958

B. E. WALLACE ET AL

2,822,526

WAVEGUIDE SHUTTER

Filed March 24, 1954

2 Sheets-Sheet 1

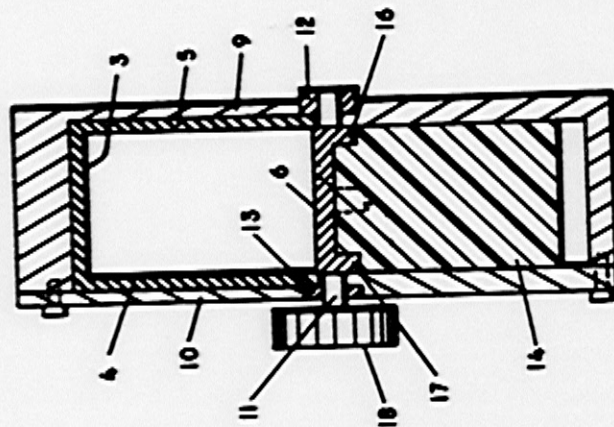


FIG. 2

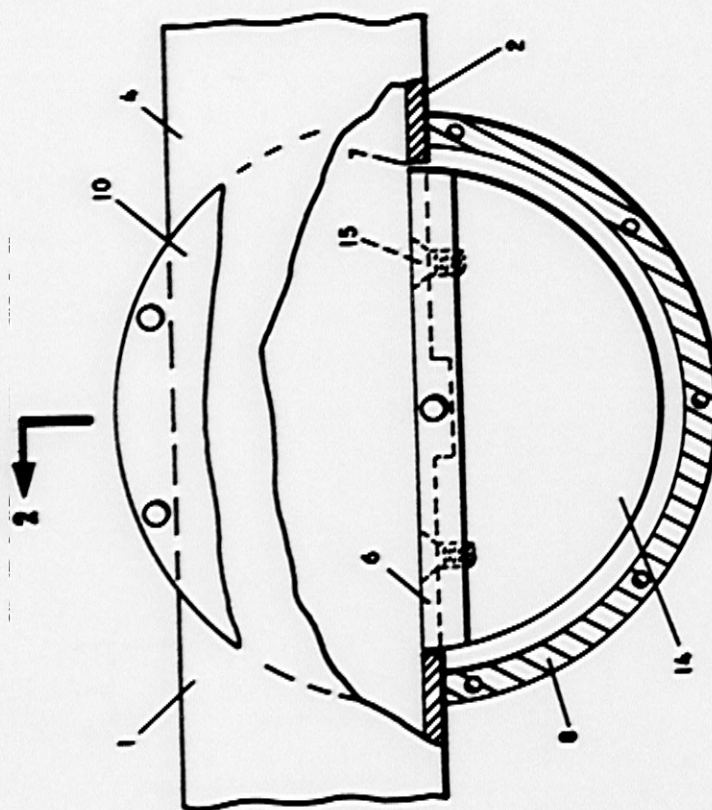


FIG. 1

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Feb. 4, 1958

B. E. WALLACE ET AL
WAVEGUIDE SHUTTER

2,822,526

Filed March 24, 1954

2 Sheets-Sheet 2

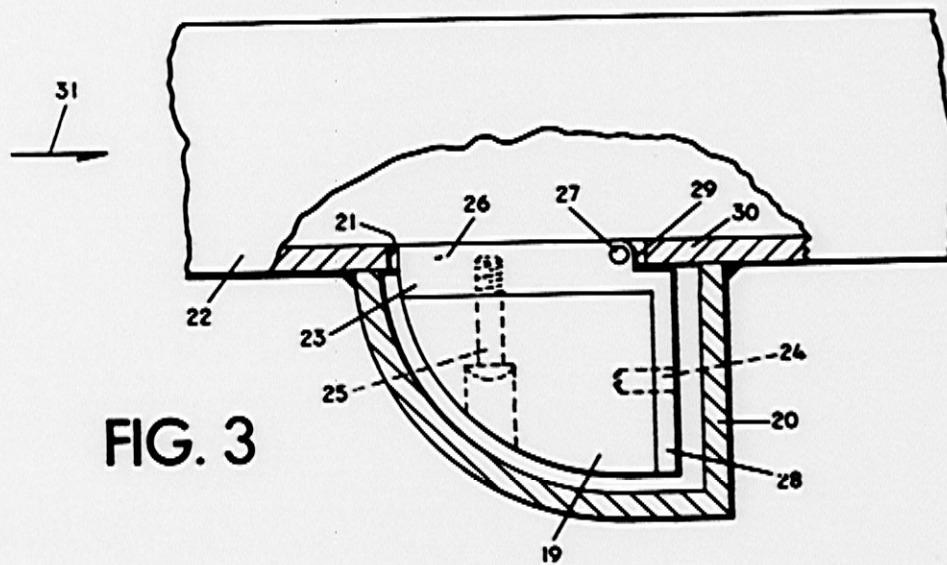


FIG. 3

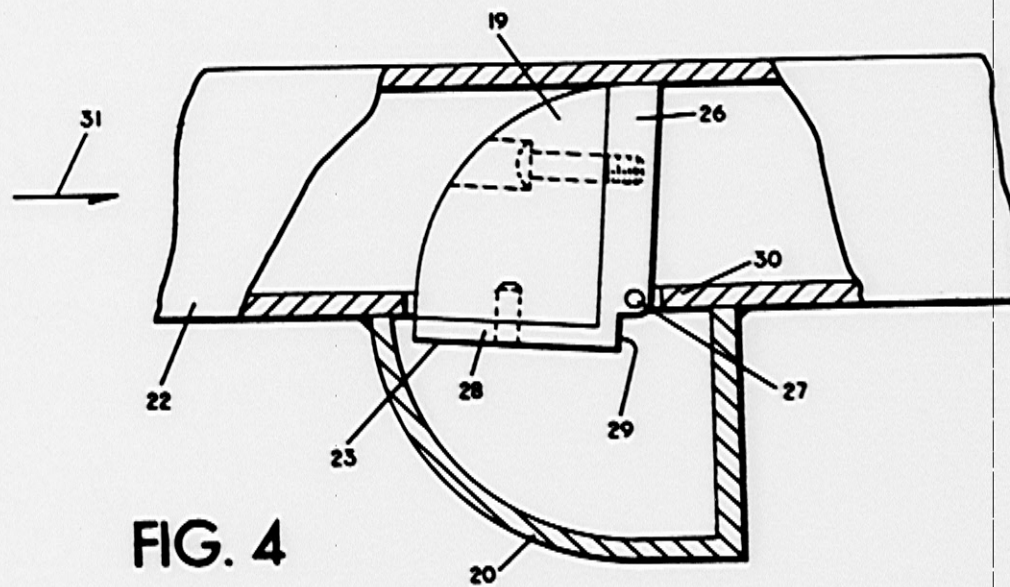


FIG. 4

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Billy E. Carter

BY

United States Patent Office

2,822,526

Patented Feb. 4, 1958

1

2,822,526

WAVEGUIDE SHUTTER

Bert E. Wallace, Towson, and William A. Scanga, Baltimore, Md., assignors to Aircraft Armaments, Inc., Baltimore, Md., a corporation of Maryland

Application March 24, 1954, Serial No. 418,334

11 Claims. (Cl. 333-98)

This invention relates in general to power attenuators and more particularly to a waveguide shutter for producing a step change of attenuation of microwave energy flowing in a waveguide.

Conventional devices for attenuating the energy in a waveguide are of two basic types. One employs a reflective metal plate serving as a gate which is inserted into the waveguide transversely thereof to either partially or completely close the passage. The other employs a glass or phenolic plate having a resistive coating thereon which is inserted into the waveguide parallel to the passage. The maximum attenuation attainable with either of these types is approximately 50 decibels and the mechanical means for actuating the attenuating elements are relatively complex and bulky. Furthermore, conventional waveguide attenuators unavoidably decrease the efficiency of a waveguide by introducing abrupt impedance changes within the section.

An object of the instant invention is to provide a waveguide shutter which will give a step change of attenuation of well over 80 decibels and which in the open position has an insertion loss less than 0.3 decibel.

Another object of this invention is to provide a waveguide shutter employing a flange on a movable wall portion of a waveguide in combination with a block of electrical energy absorbing material for effecting high attenuation of the energy in the waveguide while maintaining the standing wave ratio in the guide at a value less than 1.1 over a 10 percent frequency band when the shutter is in the open position.

Another object of this invention is to provide a fast acting waveguide shutter which is mechanically simple to actuate, which is rugged and which occupies a relatively small space.

Still another object of this invention is to provide a waveguide shutter which is economical to manufacture.

Further and other objects will become apparent from a reading of the following detail description, especially when considered in combination with the accompanying drawing, wherein like numerals refer to like parts.

In the drawing:

Fig. 1 is a fragmentary top elevation view of the waveguide shutter.

Fig. 2 is a sectional view taken on line 2-2 of Fig. 1.

Fig. 3 is a fragmentary top elevation view of a modified form of the shutter shown in the open position.

Fig. 4 is a fragmentary top elevation view of the modified shutter shown in the closed position.

Referring to Figs. 1 and 2, a section of rectangular waveguide 1 is shown having a pair of narrow walls 2 and 3, and a pair of wide walls 4 and 5 wherein micro-

2

wave energy applied to the waveguide will flow through the passage defined by the four walls. A segment 6 of narrow wall 2 is cut from the waveguide to provide a generally rectangular opening 7, the length of which is equal to substantially twice the wide dimension of the waveguide and the width of which is equal to the narrow dimension of the waveguide.

A tubular metal housing 8 slightly larger in diameter than the length of opening 7 and having a transverse slot formed therein for receiving the waveguide is arranged relative to opening 7 such that the centerline of housing 8 is located medially of the opening and coincident with the plane of wall 2. A pair of generally circular metal end plates 9 and 10 are secured to housing 8 for rigidly connecting the latter to the waveguide and for forming a closed semicircular cavity in communication with opening 7. End plates 9 and 10 are contiguous with wide walls 4 and 5 and have a step increase in thickness beyond narrow wall 2 as best shown in Fig. 2 so that the height of the cavity will be substantially the same as the narrow inside dimension of the guide.

Segment 6 is carried by housing 8 to serve as a revolving door for closing opening 7. Specifically, this is accomplished by a shaft 11 secured to segment 6 medially thereof and extending transversely of the waveguide and parallel with the plane of the segment. Shaft 11 is mounted in suitable bearings 12 and 13 carried by end plates 9 and 10 respectively.

A block 14 of suitable microwave energy absorbing material such as "polyiron," having a semicircular planform shape and a thickness substantially equal to the narrow dimension of the waveguide is secured at its base to the outside surface of segment 6 by means such as screws 15. As shown in the drawing, by rotating segment 6 from the open position shown in Fig. 1 to a new position 180° disposed therefrom, block 14 will be inserted into waveguide 1, completely blocking the passage. Continued rotation of segment 6 throughout a second 180° segment will return block 14 to the original position within the cavity formed by housing 8 and open the waveguide passage to allow the free flow of energy there-through. With the shutter in this latter open position segment 6 closes opening 7 in the side of waveguide 1 except for the small gap required to permit unobstructed rotational movement of the segment and its associated block 14. Due to the manner in which energy flows through the waveguide, the gaps extending in a direction parallel to the guide will normally tend to produce a power loss and set up an undesirable standing wave in the area of the shutter as a result of energy leakage there-through into housing 8. This undesirable effect is obviated through the use of transverse flanges 16 and 17 formed on the outer edges of segment 6. These flanges 16 and 17 extend outwardly and generally parallel with end plates 9 and 10 to produce a very low impedance path for the waveguide energy such that the effect of the gap is substantially eliminated. That is, energy in the waveguide will flow as though no gap were present. For most satisfactory results the width of the flanges 16 and 17 should be at least $\frac{1}{4}$ of the wave length of the energy flowing in the waveguide and preferably their width should be in the neighborhood of $\frac{1}{4}$ of a wave length.

The amount of attenuation of microwave energy in a waveguide through the use of an absorbing material such as "polyiron" is directly proportional to the quantity of

3

absorption material inserted in the guide. For this reason, block 14 is made semicircular with a diameter at its base substantially equal to the length of segment 6 to provide the maximum quantity of absorption material for insertion in the guide while allowing unobstructed rotation of segment 6.

A modification of the waveguide shutter shown in Figs. 1 and 2 is shown in Figs. 3 and 4 wherein the block of energy absorbing material 19 has a planform shape which is approximately a 90° segment of a circle. This configuration, while not providing as large a quantity of absorbing material for attenuating the energy in the waveguide, operates very efficiently, particularly at the lower microwave frequencies, because energy leakage into shutter housing 20, when the shutter is in the closed position as shown in Fig. 4, can be more effectively eliminated. In the modified shutter, the length of opening 21 in the narrow side of waveguide 22 is substantially equal to the wide dimension of the waveguide. The block of energy absorbing material 19 is secured to an L-shaped metal base 23 by means of a positioning dowel 24 and a bolt 25 which threadedly engages leg 26 of base 23. The base is swingably carried by a shaft 27 for free movement between the open and closed positions shown in Figs. 3 and 4, respectively, for selectively attenuating the energy traveling in the waveguide in the direction indicated by arrow 31. Shaft 27 is secured to leg 26 and spaced from the point of intersection of leg 26 with the other leg 28 of base 23 so that when the shutter is rotated approximately 90°, to the closed position, leg 28 is spaced from the waveguide as shown in Fig. 4. This avoids the possibility of leg 28 contacting waveguide 22 even with large dimensional tolerances and fills opening 21 with absorbing material to effectively prevent energy leakage around the shutter through housing 20.

Leg 26 of base 23 serves to close opening 21 in the narrow wall of the waveguide when the shutter is in the open position in the same manner that segment 6 closes opening 7 in the configuration shown by Figs. 1 and 2. Instead of using flanges as segment 6 does to negative the effects of the gaps by producing a low impedance path, base 23 is made sufficiently thick to serve the same function without the use of flanges.

A rectangular notch 29 is formed in base 23 at the point of intersection of the legs 26 and 28 which allows waveguide wall 30 to serve as a stop to limit the movement of the shutter and also to reduce the air gap between the waveguide and the shutter when the latter is in the open position.

The operation of the waveguide shutter shown in Figs. 1 and 2 is believed obvious from a reading of the foregoing description. When the shutter is in the open position shown in the drawing, energy will flow through the waveguide with substantially the same efficiency as with a continuous guide having no discontinuities. When it is desired to stop the flow of energy through the waveguide, actuation of a pinion drive means 18 is effected to cause rotation of segment 6 through shaft 11 for a full 180° causing the block of energy absorption material 14 to be inserted in the waveguide passage. The energy flowing in the guide thus contacts the absorption material which causes a very high dissipation of such energy to produce an attenuation in the power level of well over 80 decibels. To again allow the transmission of energy through the waveguide it is only necessary to rotate segment 6 through a second 180° segment to position the absorbing material outside the waveguide and close opening 7.

The operation of the shutter shown in Figs. 3 and 4 is similar to that previously described for the configuration shown by Figs. 1 and 2, except that maximum attenuation is obtained with only 90° of shutter rotation.

It is to be understood that certain alterations, modifications and substitutions may be made to the instant dis-

4

closure without departing from the spirit and scope of this invention as defined by the appended claims.

We claim:

1. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a rectangular waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having a pair of narrow and a pair of wide walls, one of said narrow walls having a segment thereof rotatable relative to the waveguide about an axis located medially of the segment and arranged generally parallel with said narrow wall and transversely of said waveguide, said segment having an inner and outer surface and a length no greater than substantially twice the wide dimension of said waveguide whereby rotation of the segment is unobstructed by said waveguide, a semicircular block of microwave absorbing material secured at its base to the outer surface of the waveguide segment, the thickness of said semicircular block being substantially equal to the width of said narrow walls, and means connecting with said waveguide segment for rotating the latter to insert said absorbing material into said waveguide for attenuating the microwave energy flowing therein.

2. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a section of rectangular waveguide, said waveguide having a generally rectangular opening formed in one wall thereof, the length of said opening being substantially twice the width of the walls adjoining said one wall, the width of said opening being substantially equal to the width of said one wall, a generally rectangular metallic plate substantially the size of said opening carried by said waveguide for closing said opening, said metallic plate being rotatable about an axis located medially of said plate and arranged generally parallel with said one wall and normal to said waveguide, a semicircular block of microwave absorbing material secured to one side of said plate, and means for rotating said plate whereby said absorbing material is removably inserted into said waveguide for closing the same and attenuating the energy flowing therein.

3. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a rectangular waveguide defining a hollow passage for the transmission of microwave energy, a semicircular block of microwave absorbing material secured to one wall of said waveguide on the exterior thereof, the radius of said block being substantially equal to the width of the adjoining walls, the thickness of said block being substantially equal to the width of said one wall, the portion of said one wall contiguous with said semicircular block being rotatable relative to said waveguide about an axis located medially of said portion and arranged parallel with said one wall and normal to said waveguide for selectively inserting said absorbing material into said waveguide to attenuate the energy flowing therein, and means connecting with said portion of the waveguide for rotating the same.

4. A waveguide shutter for attenuating microwave energy flowing in a waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having an opening formed in one wall thereof, a metallic plate swingably carried by said waveguide for closing said opening and effectively forming an uninterrupted path for the flow of electrical energy within the waveguide, a block of microwave absorbing material secured to said plate on the exterior surface thereof, and means for swinging said plate whereby said absorbing material is inserted within said waveguide for attenuating the flow of energy therethrough.

5. A waveguide shutter for attenuating microwave energy flowing in a waveguide comprising, a generally rectangular waveguide having a pair of narrow and a pair of wide walls, a segment of one of the narrow walls being rotatable relative to said waveguide about an axis located medially of said segment and arranged generally

5

parallel to said narrow walls and transversely of said waveguide, said segment being substantially rectangular in shape wherein the length thereof is twice the width of said wide walls and the width thereof is substantially equal to the width of said narrow walls, laterally extending flanges formed on said segment at the longitudinal edges thereof for substantially eliminating the electrical discontinuity in the waveguide caused by the gaps between said segment and the adjacent waveguide walls, and a block of microwave energy absorbing material secured to said segment on one side thereof contiguous with said flanges for movement into and out of said waveguide in response to rotation of said segment for selectively attenuating the microwave energy flowing in the waveguide.

6. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow waveguide for conducting microwave energy, said waveguide having an opening formed therein, a door swingably carried by said waveguide for closing said opening, a housing secured to said waveguide and forming an enclosed cavity contiguous with said door, a block of microwave energy absorbing material secured to the outer surfaces of said door within said cavity, means for selectively swinging said door from a position allowing transmission of energy through said waveguide to an attenuating position inserting said block of absorbing material into said waveguide, and flanges projecting laterally from said door and cooperating with said housing for minimizing the electrical discontinuity between said door and said waveguide.

7. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a generally rectangular waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having a pair of narrow and a pair of wide walls, one of said narrow walls having a segment rotatable relative to the waveguide about an axis located medially of the segment and arranged generally parallel with said narrow wall and transversely of said waveguide, said segment having inner and outer surfaces and a length substantially equal to twice the wide dimension of said waveguide, a semicircular block of microwave energy absorbing material secured at its base to the outer surface of said segment, the thickness of said block being substantially equal to the narrow dimension of said waveguide and the radius thereof being substantially equal to the wide dimension of said waveguide whereby rotation of said segment a half revolution will position said block within said waveguide and close said passage to attenuate the flow of energy therethrough, wall projections carried by said waveguide and projecting outwardly adjacent said segment in a direction generally parallel with said wide walls, and laterally extending flanges carried by said segment on the outer surface thereof and cooperating with said wall projections to minimize the electrical discontinuity between said segment and the adjacent waveguide walls, the width of said projections and flanges being at least $\frac{1}{2}$ of the wave length of the energy in the waveguide.

8. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a generally rectangular waveguide defining a hollow passage for the transmission of microwave energy, said waveguide having a pair of narrow and a pair of wide walls, one of said narrow walls having a segment rotatable relative to the waveguide about an axis located medially of the segment and arranged generally parallel with said narrow wall and transversely of said waveguide, said segment having inner and outer surfaces and a length no greater than twice the wide dimension of said waveguide, a semicircular block of microwave energy absorbing material secured at its base to the outer surface of said segment, the thickness of said block being substantially equal to the narrow dimension of said waveguide and the radius thereof being no greater than the wide dimension of said waveguide whereby said segment may be freely rotated to position said block within said waveguide to close said passage

6

and attenuate the flow of energy therethrough, a housing carried by said waveguide and forming a closed cavity adjacent said segment for receiving said block of energy absorbing material, and laterally extending flanges carried by said segment on the outer surface thereof for cooperating with said housing to minimize the electrical discontinuity caused by the gap between said segment and said waveguide.

9. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow rectangular waveguide for conducting microwave energy having a pair of narrow and a pair of wide walls, one of said narrow walls having an opening formed therein, the width of which is substantially equal to the narrow dimension of said waveguide and the length of which is at least equal to the wide dimension of said waveguide, a door swingably carried by said waveguide for closing said opening, a housing secured to said waveguide and forming an enclosed cavity contiguous with said door, a block of microwave energy absorbing material secured to the outer surface of said door within said cavity, and means for selectively swinging said door from a position closing said opening and allowing transmission of energy through said waveguide to an attenuating position closing said opening and inserting said block of absorbing material into said waveguide.

10. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow rectangular waveguide for conducting microwave energy having a pair of narrow and a pair of wide walls, one of said narrow walls having an opening formed therein, the width of which is substantially equal to the narrow dimension of said waveguide and the length of which is at least equal to the wide dimension of said waveguide, a door swingably carried adjacent one end thereof by said waveguide for closing said opening, a housing secured to said waveguide and forming an enclosed cavity contiguous with said door, the thickness of said door adjacent the longitudinal edges thereof being at least $\frac{1}{2}$ of the wave length of the energy flowing in the waveguide to effectively close the air gap of the opening between said door and said waveguide, a block of microwave absorbing material secured to the outer surface of said door within said cavity, the width of said block of absorbing material as measured perpendicular to the plane of said door tapering from a maximum adjacent one end of said door to a minimum adjacent the opposite end thereof whereby inward swinging movement of said door will freely admit said block of absorbing material into the waveguide passage through said opening, the thickness of said block of absorbing material being substantially equal to the narrow dimension of said waveguide whereby movement thereof into the waveguide passage by rotating said door will substantially completely close both the waveguide passage and the opening for attenuating microwave energy, said actuating means connecting with said door for selectively swinging the same from a position closing said opening and allowing transmission of energy through said waveguide to an attenuating position closing said opening and inserting said block of absorbing material into said waveguide.

11. A waveguide shutter for attenuating microwave energy in a waveguide comprising, a hollow rectangular waveguide for conducting microwave energy having a pair of narrow and a pair of wide walls, one of said narrow walls having an opening formed therein, the width of which is substantially equal to the narrow dimension of said waveguide and the length of which is at least equal to the wide dimension of said waveguide, a door for closing said opening, a hinge carried by said door and spaced from either end thereof a distance no greater than the wide dimension of said waveguide and connecting with said waveguide for allowing swinging movement of the door into the waveguide passage, a housing secured to said waveguide and forming an enclosed cavity con-

2,822,526

7

tiguous with said door, a block of microwave absorbing material secured to the outer surface of said door within said cavity, the maximum radial length of said block as measured from the axis of said hinge being no greater than the wide dimension of said waveguide whereby inward swinging movement of said door will freely admit said block of absorbing material into the waveguide passage through said opening, the thickness of said block of absorbing material being substantially equal to the narrow dimension of said waveguide whereby movement thereof into the waveguide passage by rotating said door will substantially completely close both the waveguide passage and the opening for attenuating microwave en-

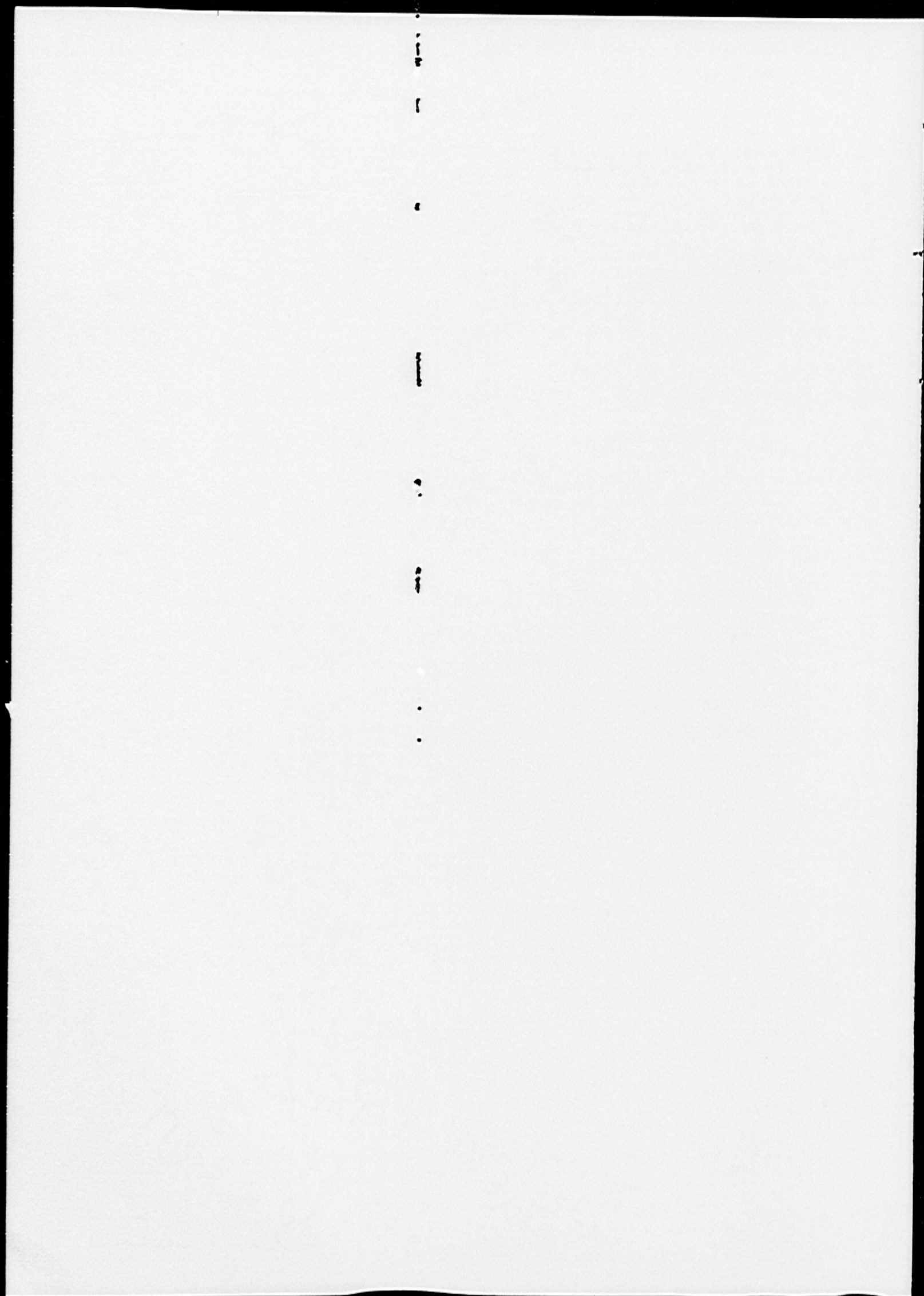
8

ergy, and actuating means connecting with said door for selectively swinging the same from a position closing said opening and allowing transmission of energy through said waveguide to an attenuating position closing said opening and inserting said block of absorbing material into said waveguide.

References Cited in the file of this patent

UNITED STATES PATENTS

2,588,934	Miller	Mar. 11, 1952
2,629,048	Dyke et al.	Feb. 17, 1953
2,646,551	Roberts	July 21, 1953



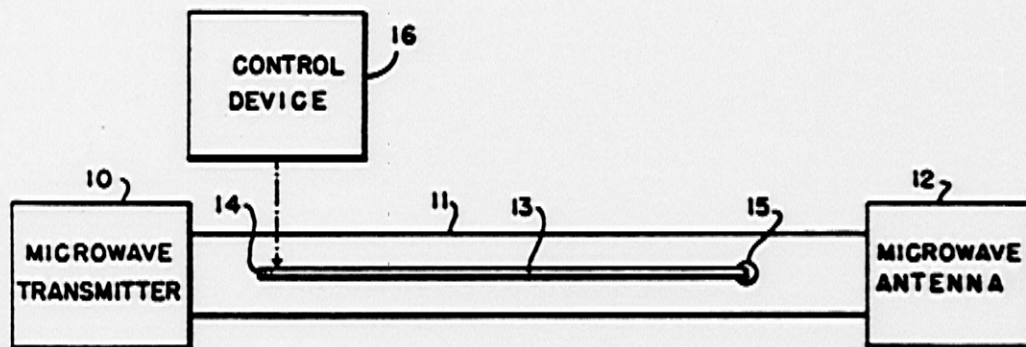


FIG. 1

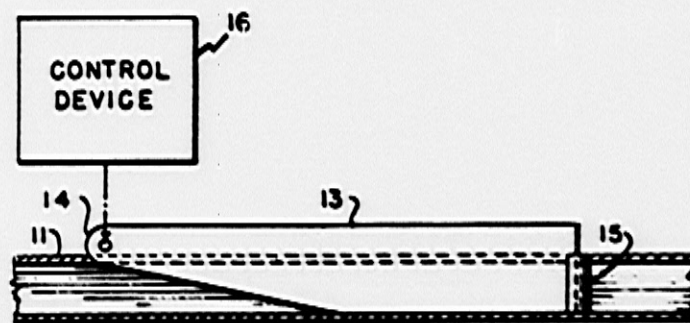


FIG. 2



61 A

Defendant's Exhibit 1D

**U. S. DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
Washington**

Appeal No. 29098

Before the Board of Appeals

Paper No. 11
In re application of
Robert Regis
Ser. No. 704,770
Filed December 23, 1957
For MICROWAVE SWITCH
Mailed Nov. 10, 1959—Pat. Div. 65

Mr. Laurence B. Dodds for Appellant

Examiner's Answer

This is an appeal from the final rejection of claims 1-3. No claims are allowed.

A correct copy of the appealed claims appears on page 1a of the applicant's brief.

The references of record relied on are:

Carlson 2,491,644 Dec. 20, 1949
Wallace et al. 2,822,526 Feb. 4, 1958
 (Filed Mar. 24, 1954)

A description of the claimed switch, of the devices shown in the references and the application of the references to the claims are not believed to be necessary for the following reason. The instant appeal raises only a question of law, namely whether or not the two references, one of which was copending with the instant application, may be combined in the holding that claims

1-3 are unpatentable. The rejection was on one patent issued on an application filed prior to the filing date of the instant application, but issued subsequent to such date, in view of a second patent issued prior to the filing date of the instant application. Appellant concedes that if these two patents are available for use as references that can be combined, their combination negatives patentability on the claim. This concession is expressed in the brief in the sentences on page 2, lines 14-19, as follows:

"There is no need to discuss the actual disclosures of Wallace et al. and Carlson in view of the arguments which follows. Suffice it to say that Examiner asserts that it is possible to combine them as an engineering matter to arrive at applicant's invention. We shall accept the assertion as valid for purposes of argument".

The facts to this issue are as follows:

(1) The Carlson patent was issued prior to the filing date (December 23, 1957) of the present application, while the Wallace et al. patent issued after the filing date of the present application, but was filed (March 24, 1954) earlier than the present application.

(2) The two patents are to inventors different from the one in the present application and no common assignment is apparent.

(3) Applicant has not sworn back of either reference under the provision of Rule 131.

(4) In utilizing the Carlson and Wallace et al. patents as references the Examiner followed the instruction set forth in the third paragraph of Section 706.02 of the Manual of Patent Examining Procedure, as supported by the decisions cited therein and also the decision of *In re Gregg*, 1957 C.D. 284.

Applicant's arguments have been considered, but are not seen as being persuasive as to the alleged intent of

the Patent Act of 1952. It appears to have been well settled law prior to the 1952 Patent Act that co-pending patents having valid effective dates taken singly or in combination, were available as references and that nothing in the Patent Act of 1952 effected a change in this procedure. For authority as to this conclusion, the Examiner cites the following Board of Appeals decisions:

Ex parte Teague and De Padova 108 U.S.P.Q. 380,
Ex parte Machlarski (sic) 111 U.S.P.Q. 459,
Ex parte Kuzmitz 113 U.S.P.Q. 255.

In each of the above cases, substantially the same arguments as advanced in applicant's brief were raised, and in each case, it was held that the Patent Act of 1952 did not change the established policy of utilizing co-pending patents having valid effective dates as references.

In addition the following statement by the Court of Customs and Patent Appeals (In re Gregg 1957 C.D. 284) appears to be directly in point and is quoted in its entirety.

"We are unable to agree with appellant that the prior art referred to in section 103 of the 1952 Act is limited to art which was available to the public prior to the date of the applicant's invention. The section clearly does not make any express statement to that effect, and no reason appears for reading such a limitation into it. It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. In re Seid, 34 C.C.P.A. (Patents) 1039, 161 F. 2d 229, 73 USPQ 431, and cases there cited. There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952."

64 A

For the above reasons, the Carlson and Wallace et al. patents are believed to be properly combined. Therefore, since applicant does not otherwise contend that these references are not applicable to claims 1-3, the rejection of these claims is considered proper and should be affirmed.

Respectfully submitted,

/s/ J. E. Sax
Examiner, Div. 65

HSH

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65 A

Defendant's Exhibit 1E

Paper No. 16

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

BEFORE THE BOARD OF APPEALS

Mailed Mar. 28, 1962

U. S. Patent Office, Board of Appeals

Ex parte Robert Regis

Application for Patent filed December 23, 1957, Serial No. 704,770. Microwave Switch.

Messrs. Laurence B. Dodds, Edward A. Ruestow, and Andrew L. Ney for appellant.

Before McCann, Kreek and Keely, Examiners-in-Chief.
Keely, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1, 2 and 3, all the claims now in the case.

Claim 1 is representative and reads as follows:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

The references relied upon are:

Carlson 2,491,644 Dec. 20, 1949

Wallace et al. 2,822,526 Feb. 4, 1958

The rejected claims relate to a microwave switch which

is adequately described in appellant's brief to which reference is made.

The claims stand rejected as being unpatentable over Wallace et al. in view of Carlson.

It is asserted by the Examiner that appellant has conceded that if the patent to Wallace et al. is available as a reference then it may be combined with Carlson and that the combination negatives invention in the instant case.

It is the position of the Examiner that prior to the 1953 (sic) Patent Act copending patents either singularly or in combination were valid references. He contends that said Act has not changed this situation and he cites our decisions *Ex parte* Teague et al., 108 USPQ 380; *Ex parte* Machlanski, 111 USPQ 459; and *Ex parte* Kuzmitz, 113 USPQ 255 as well as the Court of Customs and Patent Appeals decision in *In re* Gregg, 44 CCPA 904, 1957 C.D. 284, 720 O.G. 227, 244 F.(2d) 316, 113 USPQ 526 as supporting his position.

Appellant challenged the rejection contending that Wallace et al. is not prior art and for this reason cannot be combined with Carlson.

It is urged by appellant that 35 U.S.C. 102 requires that an appellant must be granted a patent unless one of the prohibitions of the seven sub-paragraphs of this section applies. He considers sub-paragraphs (a), (e) as being the only ones applicable. Pointing to the term "the invention" of these paragraphs he argues that the quoted term requires that his complete device must be found in a single reference before Section 102 is applicable.

He submits that his arguments are fortified by the terms of 35 U.S.C. 103, which uses the following language in referring to 35 U.S.C. 102,

"... not identically disclosed or described as set forth in section 102. . . ."

He concludes that Section 102 restricts the prior art to a single reference, and that Section 103 was intended to supply the only exception.

Turning next to Section 103, he urges that if this Section relates to copending patents then it would be in conflict with Section 102(e) and the latter would be unnecessary. He contends that such an interpretation of the statutes is improper and that Section 102(e) is to stand alone in relation to copending patents.

He considers that his reasoning that Section 103 is inapplicable to copending patents is reinforced by Section 122 which requires that patent applications be kept in secrecy, as well as by numerous decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available until the patent issues.

We have reviewed the pertinent sections of the statutes and case law in the light of the Examiner's and appellant's remarks and as a result of our review are in full accord with the position of the Examiner.

It appears to us that the issues raised by appellant have been decided by the Court of Customs and Patent Appeals in *In re Gregg* as well as by us in our previous decisions cited above.

The arguments in appellant's brief appear to be pointless. On page 6, appellant admits that 35 U.S.C. 102(e) enacts the rule of *Milburn Co. v. Davis Bournonville Co.*, 1926 C.D. 303, 344 O.G. 817, 270 U.S. 390, which held that a patent was a reference for what it disclosed as of its filing date.

It is obvious that Wallace et al., as of his filing date, had the structure necessary for modification in the light of Carlson to achieve the disputed claimed structure. Appellant has admitted that the modification is obvious.

Under these circumstances the claimed structure was obviously within the grasp of Wallace et al. about three years and nine months prior to appellant's entry into the field.

Section 103, as we view it, concerns itself only with the circumstances under which a reference that is not anticipatory of the claimed device or method may be used. This section complements sub-paragraphs (a), (b), (e) and (g) of 102 without indicating the type of evidence which will be used to establish obviousness, the qualification of the evidence being found in other sections of the statute and pertinent case law, as for example the cases cited above.

Accordingly, we will sustain the rejection of the claims.

We have carefully considered the contentions and arguments presented in appellant's brief but we are of the opinion that the Examiner's rejection was proper and it will be sustained.

The decision of the Examiner is affirmed.

AFFIRMED

/s/ L. P. McCann
Examiner-in-Chief

† /s/ Louis F. Kreek
Examiner-in-Chief

/s/ J. E. Keely
Examiner-in-Chief
Board of Appeals

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69 A

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION

No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,
Plaintiffs,

vs.

DAVID L. LADD, Commissioner of Patents,
Defendant.

(Filed Feb. 14, 1964)

OPINION

This civil action was brought pursuant to 35 U.S.C. 145 to obtain judgment authorizing the defendant, Commissioner of Patents, to issue a patent containing claims 1 to 3 of an application Serial No. 704,770 filed December 23, 1957, by the co-plaintiff, Robert Regis. The invention relates to microwave switches.

The tribunals of the Patent Office rejected the claims as unpatentable over the Wallace et al patent No. 2,822,526, in view of the Carlson patent No. 2,491,644. Counsel for plaintiffs concedes that if Wallace et al is available as "prior art" under 35 U.S.C. 103, the combination of Wallace et al with Carlson negates the patentability of the claims. Thus, the sole issue before this Court is whether the Wallace et al patent is "prior art" within the meaning of that term as used in 35 U.S.C. 103.

Counsel for plaintiffs strongly contend that since Wallace et al was a "copending patent",¹ it is "prior art" only with regard to 35 U.S.C. 102(e),² and not with regard to 35 U.S.C. 103.³ If that contention is correct, the judgment here must be in favor of the plaintiffs since neither the Wallace et al patent, nor the Carlson patent alone anticipates the invention described in the claims in suit.

Before specifically considering plaintiffs' contention, it may be noted that prior to the 1952 Patent Act, the Supreme Court in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, recognized that "copending patents" could be used to invalidate the claims involved in the infringement suit even though none of those patents anticipated the claims.

¹ Although this term is indefinite, it will be used hereinafter to designate patents issued on applications filed *before*, but issuing *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable. For instance, in this case the Wallace, et al application was filed on March 24, 1954, the Regis application was filed on December 23, 1957, and the Wallace, et al application matured into a patent on February 4, 1958.

² This paragraph is a codification of the rule of the first important case in this area, *Alexander Milburn v. Davis-Bournonville*, 270 U.S. 390. Revisor's Note—35 U.S.C.A. 102.

The paragraph reads as follows:

"A person shall be entitled to a patent unless—

* * * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the application (sic) for patent, ..."

³ The pertinent portion of this section reads as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention having ordinary skill in the art" (sic)

Moreover, in this Circuit, it was well settled that "copending patents", either singly or in combination with other "copending patents", or other patents, or both, are available as references to show that the claimed advance over the prior art required only the exercise of the skill of the art. *Sherwin-Williams Co. v. Marzall*, 190 F.2d 606, 89 U.S.P.Q. 208 (D.C. Cir. 1951); *Dyer v. Coe*, 125 F.2d 192, 52 U.S.P.Q. 52 (D.C. Cir. 1941), and *Minnesota Mining & Manufacturing Co. v. Coe*, 100 F.2d 429, 38 U.S.P.Q. 513 (D.C. Cir. 1938). But see *Hazeltine Corp. v. Coe*, 87 F.2d 558, 31 U.S.P.Q. 405 (D.C. Cir. 1936).⁴

The Court of Customs and Patent Appeals had also consistently held that "copending patents" were available as references. *In re Downs*, 45 F.2d 251, 7 U.S.P.Q. 316 (C.C.P.A. 1930); *In re Seid*, 161 F.2d 229, 73 U.S.P.Q. 431 (C.C.P.A. 1947), and *In re Youker*, 77 F.2d 624, 25 U.S.P.Q. 421 (C.C.P.A. 1935).

Thus, prior to the Patent Act of 1952, it is clear that as far as the Patent Office and this Court were concerned, a "copending patent" could be used as evidence to show that claims are unpatentable because the differences between the claims' subject matter and the disclosure of the "copending patent" were within the ingenuity and skill possessed by an ordinary mechanic acquainted with the art.

Counsel for plaintiffs contends that the Patent Act of 1952 changed this area of the law. More specifically,

⁴ It should be noted that *Minnesota Mining & Manufacturing Co.*, supra, and *Dyer*, supra, both distinguish the *Hazeltine* case by stating that it "merely held that . . . (since) all of the copending references relied upon therein failed, either singly or in combination to disclose the claims of the later applicant, they did not prevent the issuance of a patent to him as the first inventor. (Furthermore) . . . the Court held, on the merits, that the facts of that case clearly revealed invention." At 100 F.2d 429, 432.

counsel states that since 35 U.S.C. 103 sets forth that "a patent may not be obtained . . . if the difference between the (claimed) subject matter . . . and the prior art . . . would have been obvious *at the time the invention was made . . .*", (Emphasis added), a "copending patent" may not be considered a part of the prior art under Section 103 because "at the time the invention was made" the disclosure therein was not publicly available knowledge due to requirements of 35 U.S.C. 122.

However, counsel for plaintiffs overlooks the fact that "Section 103 . . . is not concerned with the psychological aspects of inventing, but rather with the legal concepts involving hypothetical situations in which the prior art is assumed to include those things dealt with in Section 102". *In re Kander*, 312 F.2d 834, 136 U.S.P.Q. 477 (C.C.P.A. 1963). In other words, that section contemplates an objective standard of patentability, and "the inventor may indeed have made an invention in the psychological sense, but it would nevertheless not be patentable if the quantum of novelty over the prior art material of which he may have been in total ignorance was not sufficient". Federico, *Commentaries On The New Patent Act*, 35 U.S.C.A., at p. 21. Thus, where the technology in a particular art has developed to such a state that "a person having ordinary skill in the art" would find that a certain invention was obvious in view of this state of the art, the invention is not patentable regardless of whether or not it would have been possible for that particular inventor to know the entire state of the art.

Therefore, in view of the fact that the "prior art" under 35 U.S.C. 103 is not limited to materials which an inventor knows or could reasonably be expected to know, the question of whether a copending patent is to be considered a part of the "prior art" under 35 U.S.C. 103 is a matter of policy. Because of the fact that the policy,

What about
which he
could know?

the case law, prior to the 1952 Act was to include "copending patents" in the prior art in situations analogous to those now covered by Section 103, it is the opinion of the Court that there would have to be clear, unmistakable language in the Patent Act of 1952, or in its legislative history⁵ before a Court would be warranted in holding that "copending patents" are not "prior art" under 35 U.S.C. 103.

The Court has not found, nor has Counsel for plaintiffs directed its attention to any such language. The Patent Act is unclear on this point; however, the legislative history noted by the Court indicates that the draftsmen of the 1952 Act intended to have "copending patents" be considered as part of the prior art under Section 103. See *Legislative History—Title 35, United States Code* in 2 U. S. Code Cong. & Ad. News, at p. 2399. Moreover, one of the draftsmen⁶ of the 1952 Act, states that "the antecedent of the words 'the prior art' (in 35 U.S.C. 103), . . . lies in the phrase 'disclosed or described as set forth in Section 102', and hence these words refer to material specified in Section 102 as the basis for comparison." Federico, *Commentary On The New Patent Act*, 35 U.S.C.A., p. 20.

While neither the Supreme Court nor the Court of Appeals in this Circuit have ruled on this specific point, the Court of Customs and Patent Appeals has held that the term "prior art" in 35 U.S.C. 103 is assumed to include "copending patents". *In re Gregg*, 244 F.2d 316, 113 U.S.P.Q. 526 (C.C.P.A. 1957), and *In re Kander*, supra. That Court in *In re Gregg*, supra, stated:

"It was well settled prior to the 1952 Act that a patent issued on an application which was copending

⁵ See generally, Rich, *Congressional Intent, or, Who Wrote The Patent Act of 1952?*, in PATENT PROCUREMENT AND EXPLOITATION 61 (BNA 1963).

⁶ Ibid.

with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. (Citation omitted.) There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952." At p. 318.

In view of the above, the Court holds that the Patent Act of 1952 did not change the prior law and that "copending patents" are included in the "prior art", as that term is used in 35 U.S.C. 103.

Counsel for plaintiffs has also contended that if this Court holds, as it has above, that copending patents are prior art under Section 103, Section 102(e) will be rendered meaningless because there would be no need for it. That contention is not sound. If it were, the same rationale would apply, for example, to the publications and patents specified in 35 U.S.C. 102(a) and (b). However, it is beyond question that such publications and patents are a part of the prior art under 35 U.S.C. 103.

Therefore, for the reasons set forth above, the Court finds for the defendant and against the plaintiff, and hereby dismisses the Complaint in this case.

The foregoing Opinion includes Findings of Fact and Conclusions of Law.

Dated: February 14, 1964.

JOSEPH R. JACKSON
United States District Judge

75 A

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION
No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,
Plaintiffs,

vs.

DAVID L. LADD, Commissioner of Patents,
Defendant.

(Filed Feb. 14, 1964)

ORDER

This cause came on for trial on October 30, 1963. Upon consideration of the record herein, as well as the oral arguments and briefs which the Court accorded counsel for plaintiffs and defendant an opportunity to file, it is this 14th day of February, 1964,

ORDERED, that judgment be, and the same is hereby entered in favor of defendant, and that the Complaint be, and it is hereby dismissed, with costs to be assessed against plaintiffs.

JOSEPH R. JACKSON
United States District Judge

76 A

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,
Plaintiffs,

vs.

DAVID L. LADD, Commissioner of Patents,
Defendant.

NOTICE OF APPEAL

Notice is hereby given that Hazeltine Research, Inc. and Robert Regis, plaintiffs in the above-entitled action, hereby appeal to the United States Court of Appeals for the District of Columbia from the judgment entered in this action on February 14, 1964.

HAZELTINE RESEARCH, INC.
and ROBERT REGIS

By Edward A. Ruestow
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77 A

CERTIFICATE OF SERVICE

I, George R. Jones, counsel for Hazeltine Research, Inc. and Robert Regis, hereby certify that, on the 12th day of March, 1964, I served the foregoing "Notice of Appeal" upon the Commissioner of Patents, United States Patent Office, Washington 25, D. C., by leaving a copy thereof with the clerk or person in charge at the office of the Solicitor of the United States Patent Office, Commerce Building, Washington 25, D. C.

/s/ George R. Jones
GEORGE R. JONES

Service acknowledged
March 12, 1964

/s/ C. W. Moore
C. W. MOORE, Solicitor
United States Patent Office
Attorney for Defendant

* . . .
STATEMENT OF POINTS UNDER RULE 15

Under the provisions of Rule 15 of this Court, Appellants state the following as the points on which they intend to rely on appeal:

1. That the District Court erred in not ruling as a matter of law that a "copending patent"* is not prior art within the meaning of 35 USC 103; and that a "copending patent" is available as a bar to an application only if it describes the invention of that application as provided in 35 USC 102(e).

2. That consequently the District Court erred in not ruling that the Wallace, et al patent No. 2,822,526, as a "copending patent", is not evidence of the prior art under 35 U.S.C. 103 and therefore may not be combined with

* Using the District Court's definition as follows found in footnote 1 of its opinion:

"Although this term is indefinite, it will be used hereinafter to designate patents issued on applications filed *before*, but issuing *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable. For instance, in this case the Wallace, et al application was filed on March 24, 1954, the Regis application was filed on December 23, 1957, and the Wallace, et al. application matured into a patent on February 4, 1958."

* * * *

79 A

Carlson patent No. 2,491,644 to bar appellants' application Serial No. 704,770 here in issue.

Respectfully submitted,

April 23, 1964

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Of Counsel:

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* * * *

STIPULATION AS TO CONTENTS OF JOINT APPENDIX

It is hereby stipulated by and between counsel for the parties to the above-entitled action that the following parts of the record in this action be printed in the joint appendix in accordance with provisions of Rule 16(c) of the Rules of the United States Court of Appeals for the District of Columbia Circuit:

1. The complaint of the plaintiffs filed May 25, 1962.
2. The answer of the defendant to the complaint filed June 15, 1962.

3. Plaintiffs' exhibits offered and introduced in evidence at the trial of this action on October 30, 1963, as follows:

- (a) Plaintiffs' exhibit 1—Certified copy of the pending application for Letters Patent of Robert Regis, Serial No. 704,770, filed December 23, 1957.
- (b) Plaintiffs' exhibit 2—Copy of the unrecorded assignment of the invention of Robert Regis relating to improvements in MICRO SWITCH and the application for United States patent therefor Serial No. 704,770.
- (c) Plaintiffs' exhibit 3—Certification of the Secretary of State of the Senate of Illinois of the good standing of Hazeltine Research, Inc. as a domestic corporation of the State of Illinois.

4. Defendant's exhibit offered and introduced in evidence at the trial of this action on October 30, 1963, as follows:

- (a) Defendant's exhibit 1—
 - (A) U.S. Patent No. 2,491,644, granted December 20, 1949, to C. P. Carlson.
 - (B) U.S. Patent No. 2,822,526, granted February 4, 1958, to B. E. Wallace et al. on application Serial No. 418,334, filed March 24, 1954.
 - (C) Print of sheet of drawings (Fig. 1 and Fig. 2) from application of Robert Regis Serial No. 704,770.
 - (D) Examiner's Answer of November 10, 1959, Paper No. 11, of application of Robert Regis, Serial No. 704,770.
 - (E) Decision of Patent Office Board of Appeals of March 28, 1962, Paper No. 16, in application of Robert Regis, Serial No. 704,770.

5. Opinion of the United States District Judge in this action filed February 14, 1964.

6. Judgment of the United States District Judge in this action filed February 14, 1964.

7. The notice of appeal in this action filed March 12, 1964.

8. The statement by the appellants under Rule 15 of the Rules of the United States Court of Appeals for the District of Columbia of the points on which they intend to rely on appeal.

March 12, 1964

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Attorney for Plaintiffs

March 12, 1964

/s/ C. W. Moore
C. W. MOORE, Solicitor
United States Patent Office
Attorney for Defendant

No. 18563

BRIEF FOR APPELLANTS

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Case No. 18563

HAZELTINE RESEARCH, INC. and ROBERT REGIS,
Appellants,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS,
Appellee.

Appeal from A Judgment and Order of the
United States District Court for the
District of Columbia

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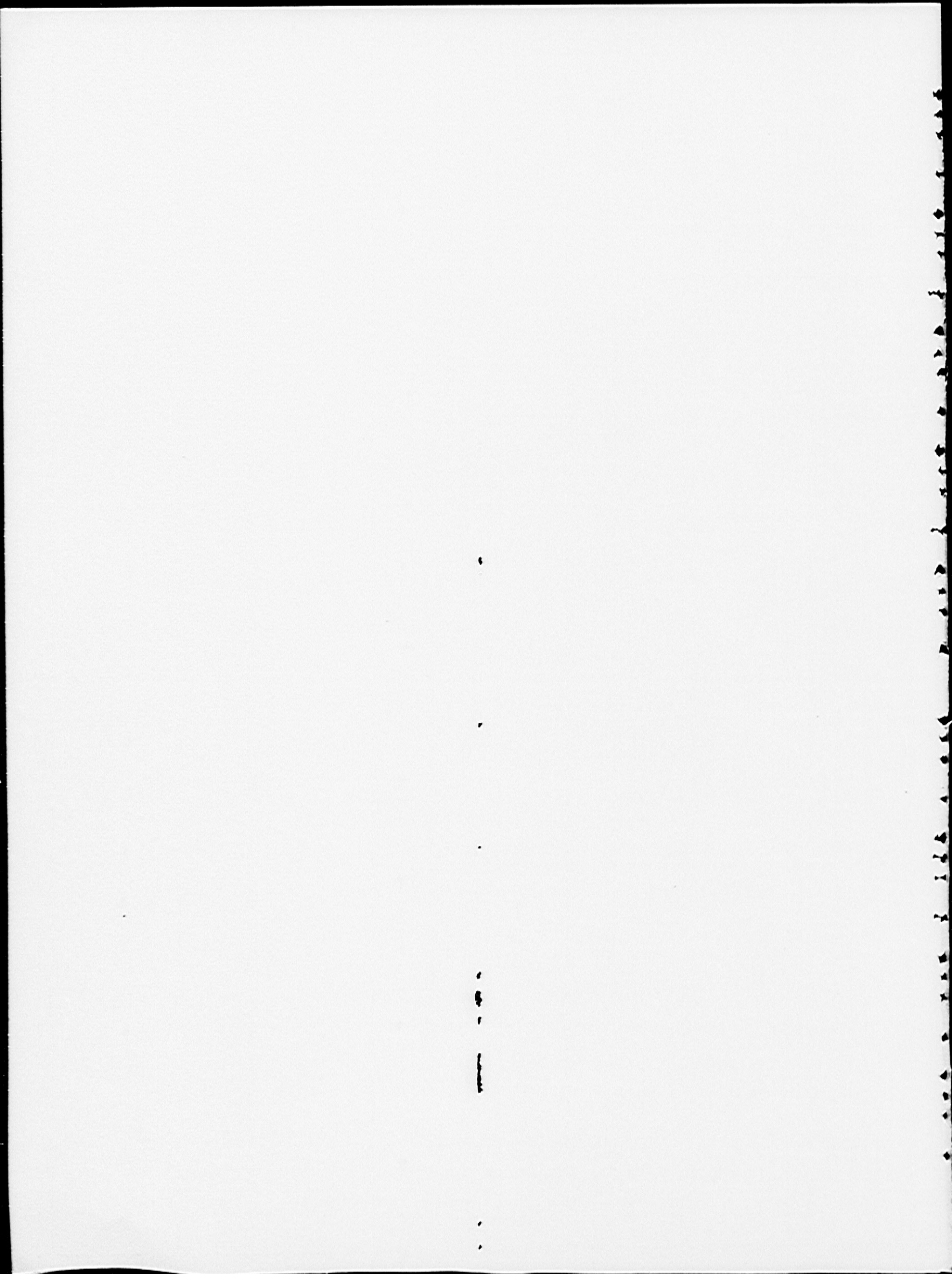
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Of Counsel

United States Court of Appeals
for the District of Columbia Circuit

FILED MAY 25 1964

Nathan J. Paulson
CLERK



STATEMENT OF QUESTIONS PRESENTED

The questions are whether a "copending patent"* is prior art within the meaning of 35 USC 103; and whether a "copending patent" is available as a bar to a patent application only if it describes the invention of that application as provided in 35 USC 102(e).

* A patent issued on an application filed *before*, but issued *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable.



INDEX

	Page
JURISDICTIONAL STATEMENT.....	1
STATEMENT OF THE CASE.....	2
STATUTES.....	3
STATEMENT OF POINTS.....	3
SUMMARY OF ARGUMENT.....	3
ARGUMENT.....	4
THE REGIS INVENTION; WALLACE AND CARLSON.....	4
COPENDING REFERENCES:.....	5
35 USC 102(e)—Alone is Applicable to a Co- pending Reference.....	6
35 USC 103 —Is Not Applicable to Copend- ing Reference.....	8
THE TERM "PRIOR ART" MEANS PUBLICLY ACCESSIBLE KNOWLEDGE.....	8
ERRORS OF THE DISTRICT COURT'S OPIN- ION.....	24
SUMMARY.....	28
CONCLUSION.....	32
STATUTES REPRODUCED	
35 USC 102.....	33
35 USC 103.....	34
TABLE OF CASES	
<i>Allied Metal Stamping Co. Inc. v. Standard Electric Equipment Corp.</i> (D.C.E.D.N.Y. 1932) 57 F. (2d) 296; 13 USPQ 50.....	20

	Page
<i>American Tri-Ergon Corp. v. T. E. Robertson</i> (Sup. CT.D.C. 1931) 11 USPQ 168.....	22
<i>Automatic Weighing Machine Co. v. Pneumatic Scale Corp.</i> (C.C.A.1,1909) 166 Fed. 288,298.....	17
* <i>Baltimore Paper Co. v. Oles Envelope Co.</i> (D.C.D. Md. 1936) 13 F.Supp.951, 29 USPQ 11.....	19
<i>John Blue Co. Inc. v. Dempster Mill Mfg. Co.</i> (C.C.A. 8, 1960). 124 USPQ 485,488.....	22
<i>Corn-Planter Patent</i> , 23 Wall 181, 90 US 181,211.....	18
* <i>Helene Curtis Industries Inc. v. Sales Affiliates, Inc.</i> (C.C.A.2,1956), 233 F.(2d) 148,156; 109 USPQ 159.....	21
<i>Detrola Corp. v. Hazeltine Corp.</i> 313 US 259.....	25
<i>East Rutherford Syringes v. Omega Precision Medical Instrument Co. Inc.</i> (D.C.N.J. 1957), 152 F.Supp.497; 114 USPQ 147,150.....	22
* <i>Gayler et al v. Wilder</i> (1850) 51 US 477,496-497.....	13, 14
<i>Gillman v. Stern</i> (C.C.A.2 1940) 114 F(2d) 28; 46 USPQ 430.....	18
<i>Gray Telephone Pay Station Co. v. Baird Mfg. Co.</i> (C.C.A.7,1909) 174 Fed. 417,421.....	22
<i>Hazeltine Corp. v. Coe</i> (Ct.App.D.C.1936) 66 App. D.C. 341, 87 F(2d)558; 31 USPQ 405.....	22
<i>Hazeltine Corp. v. Electric Services Engineering Corp.</i> (D.C.S.D.N.Y. 1926) 18 F.(2d) 662.....	22
<i>Interurban Ry. & Terminal Co. v. Westinghouse Electric & Mfg. Co.</i> (C.C.A.6,1911) 186 Fed. 166.....	18
<i>McCreery Engineering Co. v. Massachusetts Fan Co.</i> (C.C.A. 1,1912) 195 Fed. 498.....	17
<i>Milburn v. Davis-Bournonville</i> , 270 US 390.....	7, 24
<i>Minneapolis v. Barnett</i> (C.C.A. 8, 1919) 257 Fed. 302, 312.....	17
* <i>Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc.</i> (D.C.E.D.Ill. E.Div. 1960), 188 F.Supp.248; 127 USPQ 149, 151 (C.C.A. 7, 1961) 298 F.(2d) 36; 131 USPQ 402,404.....	13, 15, 17
<i>Monarch Marking System Co. v. Dennison Mfg. Co.</i> , 92 F.(2d) 90, 34 USPQ 85.....	18

INDEX (Continued)

iii

	Page
<i>Old Town Ribbon & Carbon Co. Inc. v. Columbia Ribbon and Mfg. Co. Inc.</i> , (C.C.A. 2,1947) 159 F(2d) 379; 72 USPQ 57.....	22
<i>Palmquist, In re</i> , 319 F.(2d) 547; 138 USPQ 234.....	28
* <i>Pennock & Sellers v. Dialogue</i> 28 US 1.....	13, 14
<i>Pyrene Mfg. Co. v. Boyce, et al</i> (C.A. 3,1923) 292 Fed. 480.....	13, 15
<i>Rem-Cru Titanium, Inc. v. Watson</i> (D.D.C.1957) 152 F.Supp. 282; 114 USPQ 529,531.....	13, 17
<i>Schlittler and Uffer, In Re</i> (Ct. of Customs & Patent Appeals, 1956) 234 F(2d) 882; 110 USPQ 304, 307.....	14, 18
<i>Simmons v. Hansen</i> (C.C.A. 8, 1941) 117 F.(2d) 49; 48 USPQ 345,348.....	13, 14
<i>Stelos Company Inc. v. Hosiery Motor-Mend Corp.</i> (C.C.A. 2,1934), 72 F(2d) 405; 23 USPQ 35.....	23
* <i>Thomas, Ex Parte</i> (Comm. of Patents) 1918 C.D. 11	29, 30, 31, 32
<i>Utah Radio Products Co. v. Delco Appliance Corp.</i> (W.D.N.Y. 1938), 24 F.Supp.328; 38 USPQ 400..	22
<i>Vacuum Engineering Co. v. Dunn</i> (C.C.A.2, 1913) 209 Fed. 219.....	22
* <i>Weatherhead Co. v. Drillmaster Supply</i> (C.C.A.7, 1955) 227 F.(2d) 98; 107 USPQ 184.....	20, 24
* <i>Western States Machine Co. v. S.S. Hepworth Co.</i> (E.D.N.Y. 1943) 51 F.Supp.859; 58 USPQ 102, 114.....	22, 25
<i>Youker, In Re</i> (C.C.P.A.1935) 77 F.(2d) 624; 25 USPQ 421.....	27

OTHER AUTHORITIES

Title 35 U.S.Code, Section 145.....	2
Title 5 U.S.Code, Section 1009.....	2
Title 28 U.S.Code 1291.....	2
*Title 35 U.S.Code, Section 102(e).....	5, 6, 7, 8, 32
*Title 35 U.S.Code, Section 103.....	5, 6, 7, 8, 32
*Title 35 U.S.Code, Section 122.....	8, 9
82nd Congress, House Report, No.1923, May 12, 1952..	13
Reviser's Notes, Title 35 U.S.Code, Section 102(a)....	13

	Page
Robinson on Patents (1890) Sections 226,227.....	16
*Robinson—The Law of Patents (1890) pp.57,58, Chapter II.....	9, 10, 11, 12
Walker on Patents—Deller's Edition (1937) p.281, Vol. I.....	16
*Walker on Patents—Deller's Edition (1937) pp.136, 137—Vol. I.....	23

* Cases or authorities chiefly relied upon are marked with asterisks

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Case No. 18563

HAZELTINE RESEARCH, INC. and ROBERT REGIS,
Appellants,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS,
Appellee.

BRIEF FOR APPELLANTS

Appeal from A Judgement and Order of the
United States District Court for the
District of Columbia

JURISDICTIONAL STATEMENT

The complaint (JA1A) was filed in the United States District Court for the District of Columbia by the plaintiffs-appellants Hazeltine Research, Inc. and Robert Regis against the defendant-appellee David L. Ladd in his official capacity as Commissioner of Patents of the United States, for a judgment authorizing the Commissioner to issue a patent on the application of the plaintiffs-appellants Serial No. 704,770, filed December 23, 1957. The jurisdiction of the United States District Court for the

District of Columbia is set forth in the Complaint (JA1A).

This action was brought under the provisions of the Patent Act of July 19, 1952 (Public Law 593, 82nd Congress, 2d sess., ch. 950; 66 Stat. 792); and, more particularly, Section 145 of said Act (Title 35 U.S. Code, Section 145), and under the Provisions of the Administrative Procedure Act as enacted June 11, 1949, as amended, and more particularly Section 9 of said Act (Title 5 U.S. Code, Section 1009). This Court has jurisdiction on appeal to review the judgment under the provisions of Title 28 U.S. Code Section 1291 (Act of June 25, 1948, c. 646, § 1, 62 Stat. 869).

STATEMENT OF THE CASE

Appellants sought (JA1A) the judgment of the Court below that Robert Regis is entitled to receive a patent for his invention pointed out in the claims of his patent application (JA7A) Serial No. 704,770, filed December 23, 1957 for Microwave Switch. The application was rejected by the Board of Appeals of the United States Patent Office in a decision (JA65A) dated March 28, 1962. The basis of the decision was that the invention was not patentable over the United States patent No. 2,822,526 to Wallace, et al (JA54A) in view of the United States patent No. 2,491,644 to Carlson (JA50A). In other words, the Patent Office contended that as an engineering matter it was obvious to combine the teachings of Wallace and Carlson to produce the results sought by Regis. Whether or not this is true is not at issue here. The Patent Office does *not* contend that either Wallace or Carlson individually anticipates the Regis invention or precludes the grant of a patent including the claims on Appeal.

STATUTES

Only 35 U.S.C.102 and 35 U.S.C.103 are involved and these are reproduced on pages 33, 34 & 35 of this brief.

STATEMENT OF POINTS

The sole issues here are Appellants' contentions:

1. That Wallace cannot legally be combined with Carlson or with any other prior art under 35 U.S.C.103 as a basis of rejection of the Regis invention because Wallace as a copending patent is not part of the prior art, having issued February 4, 1958 after the filing date December 23, 1957 of the Regis application.

2. That Wallace, as a copending patent, is available as a bar to Regis only under 35 U.S.C.102(e), and only if it alone describes the Regis invention, which it does not.

SUMMARY OF ARGUMENT

In essence the argument is as follows:

1. Wallace is not prior art in this case because prior art is *publicly available* knowledge existing prior to the application it purports to bar. A copending patent such as Wallace is not such prior art for the reason that it is confidential information until it issues as a patent. It issued after Regis filed his application.

2. Wallace is therefore not within the meaning of 35 U.S.C.103 which is directed solely to bars on the basis of "prior art".

3. 35 U.S.C.102(e) is directed solely to bars on the basis of copending patents and requires that to be a bar the copending patent must *by itself* describe the invention it purports to bar.

4. Wallace by itself admittedly does not describe the Regis invention and therefore is not available under 35 U.S.C.102(e).

5. No other grounds of bar to an application provided in the Statutes are pertinent in the present case.

ARGUMENT

The Regis Invention, Wallace and Carlson

In view of the issues here there is no point in going into the highly technical nature of the inventions of Regis, Wallace and Carlson other than, briefly, to give the Court some general background.

The Regis invention relates to microwave switches and, more particularly, to the type which selectively isolate a microwave source from its load. Microwaves are very short radio waves.

Referring to Fig. 1 of the copy of the application drawing (Plaintiffs' Exhibit 1, JA15A), a microwave source such as the microwave transmitter 10 is coupled to a microwave antenna 12 through a wave guide 11. An attenuator vane 13 of resistive material is disposed in a slot in the guide. As shown in Fig. 2, the vane has a tapered end extending toward the transmitter and has a highly conductive or shorting strip 15 of suitable material at the other end thereof. While the vane is in the slot an effective short circuit exists across the guide. When the vane is removed from the slot the transmitter is coupled to the antenna in a conventional manner.

When the vane is in the guide the resistive material absorbs the energy from the transmitter. Because of the configuration of the vane the signal reaching the shorting strip is attenuated. After reflection at the shorting strip the signal is further attenuated, thereby causing no disruption of the operation of the transmitter.

The Carlson reference (Defendant's Exhibit 1, JA50A) discloses an attenuator vane. Basically, the Carlson disclosure is not a switch but rather an attenuator. Since the attenuator lacks a shorting strip, a portion of the signal will still pass the attenuator.

Wallace, et al (Defendant's Exhibit 1, JA54A) disclose two embodiments of a wave guide shutter. The first embodiment is subject to the same shortcoming as is the Carlson disclosure. More particularly, when the semi-cylindrical member 14 of Fig. 1 is inserted into the guide, a portion of the wave will still pass the shutter. In the second embodiment, the operation of which is similar to the first, there is shown in Figs. 3 and 4 the energy-absorbing material 19 as that member which functions to attenuate the signal.

Copending* References—35 USC 102(e) Alone is Applicable to a Copending Reference; 35 USC 103 is Not Applicable because "prior art" must be publicly accessible knowledge.

Appellants contend that under the Patent Act of 1952 (35 USC) the Wallace reference cannot be combined with any other reference because it was copending with the Regis application. The Wallace issue date of February 4, 1958, is after the Regis filing date of December 23, 1957. Appellants insist that any copending reference, such as Wallace, is not part of the prior art under 35 U.S.C.103 and must stand alone against the Regis application under 35 U.S.C.102(e) on the limited question of whether it actually describes the Regis invention, which it does not, nor does the Patent Office contend that it does.

* See Judge Jackson's definition, footnote 1, page 2 of his Opinion, JA70A.

35 U.S.C.102(e) Alone is Applicable to a Copending Reference

The status of all patents relied on by the Patent Office against an application is determined solely by 35 U.S.C. 102 and 35 U.S.C.103, which are reproduced hereinafter on pages 33, 34 & 35 of the annex hereto.

Section 102 begins with the statement:

"A person shall be entitled to a patent unless" clearly indicating that the immediately following list (a), (b), (c), (d), (e), (f) and (g) of grounds for rejection is exclusive of all others not stated there or in Section 103. Ground (e) is the only one applicable to the present issue and reads as follows:

"(e) *the invention** was described in a patent granted on *an* application for patent *by another* filed in the United States before the invention thereof by the applicant for patent, or "

The wording of 102(e), particularly in view of the underscored portions, clearly indicates that for 102(e) to be applicable as a ground of rejection *the entire invention* must be found in one patent as an integrated whole—all in one place, so to speak—not synthesized from separate patents. Similar remarks may be made of all other grounds of rejection (a), (b), (c), (d), (f) and (g) since all speak of "the invention" or, in one case (f), of the "subject matter sought to be patented". If emphasis of this point were needed, it would be found in the first three lines of Section 103 which states in pertinent part:

"A patent may not be obtained though the invention is not *identically disclosed or described as set forth* in section 102 of this title, if the differences between the subject matter sought to be patented

* Emphasis added throughout this brief unless otherwise indicated.

and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
* * *

and also in the following reference to Section 103 in the Report of the Committee on the Judiciary:

"* * * An invention which has been made, and which is new in the sense that the *same thing* has not been made before, may still not be patentable * * * ." (82nd Congress, House Report, No. 1923, May 12, 1952).

This can only mean that Section 102 was intended to refer exclusively to *a disclosure of the complete invention in one reference* and that Section 103 was intended to supply the only exception, namely, where "prior art"—that is, a multiplicity of references—is involved.

By its very terms Section 102(e) is specific to the situation of a copending patent. Moreover, it is specific for the further reason of its very history. This paragraph (e), as the Reviser's notes (House Report 1923; 35 U.S.C.A. 102) state, enacts the rule of *Alexander Milburn v. Davis-Bournonville*, 270 U.S. 390. In that case the Court ruled that a copending United States patent, which gives "*a complete and adequate description of the thing*" (p.399, again on p.400), claimed in a later filed patent, dates from the date of filing of the copending application for the purpose of showing that the later applicant could not be the first inventor even though the copending patent issued after the later inventor filed.

It will be clear from what is said of Section 103 and the term "prior art" hereinafter that Section 102(e) is to stand alone. And if it is to stand alone, we ought to examine its precise words. It says: "the invention was described in a patent granted on an application for patent

by another filed". This language stands out. It has a peremptory command in it; *the invention* i.e., the entire invention must be pointed out in a patent of another. That is the ordinary meaning of the word "describe". The language does not say that it will suffice if one can look at the copending patent and synthesize the missing parts from other patents or from true prior art.

The Patent Office did not contend that Wallace described the invention and tacitly admits that Wallace does not do so. Therefore Wallace does not meet the conditions of Section 102(e).

35 U.S.C.103 is Not Applicable to a Copending Reference

Next, the conclusion that Section 103 is inapplicable to copending patents is reinforced by 35 U.S.C. Section 122 and by numerous decisions holding that copending patents are not part of the prior art for the simple reason that a patent application is not publicly available knowledge until a patent issues, if indeed one does issue. Copending patent applications have always been kept in confidential status in the Patent Office and Section 122 now specifically so provides. Section 122 reads:

"Section 122. Confidential status of applications.

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." 35 USC 122.

The Term "Prior Art" Means Publicly Accessible Knowledge

The key to the issue of this case is the definition of prior art as used in Section 103. As we shall show, all logic demands that it be defined as publicly accessible knowledge which a copending patent, being in the status

of a confidential application at the time the invention in question was made, is *not* (35 USC 122). To state otherwise is to contradict the very purpose of the patent law which is "to promote the progress of science and useful arts" (Constitution, Article I, Sec. 8) by inducing the inventor to publicize his new knowledge so that the nation may benefit from it. The reward of the patent monopoly is the inducement to discourage secrecy which would defeat this purpose. This is the contract between the state and the inventor—limited monopoly in return for public disclosure.

Professor Robinson in his classic work "The Law of Patents" (Boston: Little, Brown And Company 1890) sums up his fine analysis of history to the latter conclusion at pages 57, 58, his Chapter II as follows:

"§ 38. Patent Privilege a Justifiable Monopoly: Public Interest promoted by Disclosure of Inventions.

The duty which the state owes to the people to obtain for them, at the earliest moment, the practical use of every valuable invention in the industrial arts is, however, a higher and more imperative duty than any which it owes to the inventor. Upon the amelioration of their physical condition depends, to a great extent, the mental and moral progress of its citizens, and the influence of inventions in effecting this amelioration cannot well be overestimated. Such a delay in bringing a single invention into use as might result from an attempt by the inventor to conceal it may deprive an entire generation of advantages which would redound to its incalculable benefit. To secure *the publication* of the invention as soon as it is brought to such perfection as to be capable of practical employment, and to remove, as early as the accomplishment of this first object will permit, all restrictions to its free use by the people

is, therefore, the main purpose of every concession made to the inventor by the state. (Citing cases)"

"§ 39. Patent Privilege a Justifiable Monopoly: *Secures the early Disclosure of Inventions to the Public.*

The patent privilege, if wisely guarded, effects this purpose. It removes from the inventor all inducement to conceal his discovery, by affording him the same protection that could be obtained by the most rigid secrecy. It encourages him to make known his results, as the method of securing for himself the largest recompense. It compels him to *acquaint the public*, thoroughly and at the outset, with all the details of his invention and with the various modes of benefiting by its use. It appropriates to the whole people, after a short period of exclusive ownership by the inventor, the entire invention as a portion of that common property in which all men may exercise an equal right. Wherein any grant of the patent privilege fails to accomplish this object it is the fault, not of the inherent nature of the privilege itself, but of the legislature which devised it or the courts by whom it is construed. (Citing cases)"

"§ 40. Patent Privilege a Monopoly: its Threefold Aspect, as a Reward, a Stimulus, and a Contract for the Disclosure of the Invention.

Regarded as a method of attaining these three objects, the concession of the patent privilege by the state is an act having a threefold character. As a reward bestowed on the inventor for his past inventions, it is an act of justice. As an inducement to future efforts, it is an act of sound public policy. As a grant of temporary protection in the exclusive use of a particular invention, *on condition of its immediate publication* and eventual surrender to the people, it is an act of compromise between the inventor and the public, wherein each concedes something to the other in return for that which is conceded to itself.
* * *

"§ 41. Patent Privilege a Monopoly: its Contract Aspect alone Involved in the Construction and Administration of Patent Law: Two Fundamental Principles.

The acts of legislatures which prescribe the limits and conditions of the patent privilege, and the decisions of the courts in interpreting and applying such legislative acts, relate to its contract character alone. Considerations of public policy and of justice to inventors are proper for the constitutional convention, when determining whether or not these privileges shall be granted, and for the legislature when about to define the scope of the inventor's rights and the service which he must render to the public in return. But the legislature having acted in the premises, the language of the statute, regarded, as all statutes must be, as intended to promote the common good, becomes the measure of the rights and duties of the inventor and the public, and fixes the relations which they are to occupy toward each other. It is the office of the courts to interpret the language of the statute, and apply it to particular cases, in such a manner as to effect the intention of the legislature, by preserving these rights and enforcing these duties, as they are prescribed by the statute and specified in the patent actually granted. Patent Law as such, consisting of these statutes and decisions, therefore relates only to the contract character of the patent privilege and forms one branch of the Law of Contracts. It deals with a single form of obligation, and with but two classes of parties whose relations to each other are always substantially the same. The principles on which it rests are simple, though often difficult of application on account of the abstruse or intricate character of the invention concerning which the controverted questions rise. These principles may be finally reduced to two, as fundamental grounds on which all others rest:—

I. That the inventor, having made such an invention as is entitled to the patent privilege, must com-

municate it to the public *by publishing* an accurate description of its character and uses:

II. That the public, having received from the inventor this communication, must thenceforth, during the period for which his privilege is granted, protect him in the exclusive use of the invention so described."

"§ 42. Patent Privilege a Monopoly: its Contract Aspect: Obligations assumed by the Inventor.

According to the first of these principles the obligation of the inventor to the public is twofold: (1) The result of his inventive skill must be of such a nature that a patent may lawfully be granted to protect it; (2) The invention itself must be *fully communicated to the public*. Of these two obligations the latter is practically the most important. Invention *without publication* is of comparatively little value to the state, and to reward the inventor, at the public loss, for a discovery which he endeavors for his own advantage to conceal, would be contrary to the entire purpose of the patent privilege. *It is the publication, rather than the invention, which promotes the interests of the people; and although invention by some one must necessarily precede publication by any, it has always been the policy of the law to treat the publication as the meritorious act which entitles the inventor to his patent. * * **

Until the inventor publishes an issued patent he has not performed his part of the bargain. Until he publishes he may abandon his application and so retreat from the offered contract into secrecy which defeats the patent system. Until he so publishes he has *not* established prior art.

Consonant with the foregoing, there are many areas of the law wherein prior art is held to require the element of public accessibility. To hold otherwise in the case

of copending patents means a conflict of logic. Examples of such areas follow:

As one area of the law substantiating this position the phrase "known or used by others" found in Section 102 (a) has always been taken to mean *public knowlege* or *public use*.

Indeed, the Reviser's notes accompanying 35 U.S.C. Section 102(a) had the following to say:

"* * * The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, 'known' has been held to mean 'publicly known') is recognized but no change in the language is made at this time. * * * " (35 U.S.C.A., pg.446)

(Quoted with approval by the District Court below in *Rem-Cru Titanium v. Watson* (D.D.C.1957) 152 F.Supp.282; 114 USPQ 529,531)

And the accompanying Report of the Committee on the Judiciary had the following to say:

"Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public, * * * " (82nd Congress, House Report No. 1923, May 12, 1952).

Good examples of the holdings referred to follow:

Pennock and Sellers v. Dialogue 27 U.S. 1;
Gayler, et al v. Wilder (1850) 51 U.S. 477, 496;
Pyrene Mfg. v. Boyce, (C.A.3, 1923), 292 Fed. 480;
Simmons v. Hansen, (C.A.8,1941) 117 F.(2d) 49; 48 USPQ 345,348;
Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc., D.C.E.D.Ill. E. Div.1960, 188 F.Supp.248; 127 USPQ 149, 151, (7 C.A.1961), 298 F.(2d) 36; 131 USPQ 402,404;

In re Schlittler and Uffer (Court of Customs and Patent Appeals, 1956), 234 F.(2d) 882; 110 USPQ 304,307.

In *Pennock and Sellers v. Dialogue*, 27 U.S. 1, 18, 19, 20, the Supreme Court said:

"By the very terms of the first section of our statute, the secretary of state is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c. &c. 'not known or used before the application?' * * *"

"We think, then, the true meaning must be, not known or used by the public, before the application * * *"

and referring to an earlier English Statute:

"The use here referred to has always been understood to be a public use, * * *"

As was said by the United States Supreme Court in *Gayler et al v. Wilder* (1850), 51 U.S. 477, in considering a case based upon the Patent Act of 1836, containing the same limitation upon the grant of a patent, that is, that the invention shall be "not known or used by others":

"The act of 1836, ch. 357, Sec. 6, authorizes a patent where the party has discovered or invented a new and useful improvement, 'not known or used by others before his discovery or invention'. * * * The clause in question qualifies the words before used and shows that *by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public.*" 51 U.S. 477, 496-497.

In *Simmons v. Hansen*, 48 USPQ 345, 348, the Court said:

"A valid patent cannot issue to an applicant for his alleged invention if it was known or used by others in this country before his invention or dis-

covery thereof. *Corona Cord Tire Company v. Dovan Chemical Corporation*, 276 U.S. 358. * * *

"* * * The invention, however, must have been known to the public, or there must have been an opportunity to acquire such knowledge as would enable one skilled in the art to reproduce it without exercising further invention of his own. * * *

In *Pyrene Mfg. Co. v. Boyce*, 292 Fed. 480, 485, the Court said:

"* * * In considering the several alleged prior uses set up by the respondent, we do not find that, within the authority of *Gayler v. Wilder*, 10 How. 477, 13 L. Ed. 504, they were 'so far understood and practiced or persisted in as to become an established fact, accessible to the public and contributing definitely to the sum of human knowledge'. * * *

In *Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc.*, 127 USPQ 149, 151, the District Court said:

"* * * The invention must cover something new (35 U.S.C. § 101) which is not in prior (35 U.S.C. § 102) public (*Rem-Cru Titanium, Inc. v. Robert C. Watson*, Commissioner of Patents, 152 F.Supp.282, 114 USPQ 529, (D.C. 1957); *Block v. Nathan Anklet Support Co., Inc.* 9 F.2d 311 (2nd Cir. 1925); *Gayler et al v. Wilder*, 10 How. (51 U.S.) 476 (1850) knowledge."

In affirming, the Court of Appeals said:

"The statute uses the words 'known or used.' This implies that the knowledge and use must be accessible to the public. *Block v. Nathan Anklet Support Co.*, 2 Cir., 9 F.2d 311; *Gillman v. Stern*, 2 Cir., 114 F.2d 28, 46 USPQ 430, cert. den. 311 U.S. 718, 48 USPQ 713. In the latter case, Judge Learned Hand for the Court, explained the distinction be-

tween secret knowledge or use and public knowledge or use." (131 USPQ 404)

The same principle is enunciated by the recognized classic text Robinson on Patents (1890), Sections 226,227, in which it is stated, in part:

"In our own statutes the phrase 'known or used' has always been adopted, * * *.

"It is to be remembered, however, that 'knowledge', in this sense, means such an acquaintance with the invention, *on the part of the public, as renders it available to them as practically operative means.*"

The leading authority Walker on Patents—Deller's Edition (1937) has the following to say at page 281, Vol. I:

"53. UNPUBLISHED PRIOR WRITING, DRAWING OR MODEL

Novelty of a machine or manufacture is not negatived by any prior *unpublished* drawings, no matter how completely they may exhibit the patented invention. (citing cases) The reason of this rule is not stated with fullness in either of the cases which support it, but that reason is deducible from the statute, and from the nature of drawings and of models. The statute provides, relevant to the newness of patentable machines and manufactures, that they shall not have been previously known or used by others in the country. (Revised Statutes, Section 4886, U.S.Code, Title 35, § 31.) Now, it is clear that to use a model or a drawing is not to use the machine or manufacture which it represents; and it is equally obvious that to know a drawing or a model is not the same thing as knowing the article which that drawing or model more or less imperfectly pictures to the eye. It follows that neither of those things can negative the newness required by the statute. Nor is the statutory provision on this point lacking in good reasons to support it.

Private drawings may be mislaid or hidden, so as to preclude all probability of the public ever deriving any benefit therefrom; and even if they are seen by several or by many, they are apt to be understood by few or by none. * * *

See also:

Minneapolis v. Barnett (C.A.8, 1919), 257 Fed. 302,312.

McCreery Engineering Co. v. Massachusetts Fan Co. (C.A.1, 1912), 195 Fed.498.

Automatic Weighing Machine Co. v. Pneumatic Scale Corp. (C.A.1,1909), 166 Fed. 288,298.

The District Court below held in *Rem-Cru Titanium v. Watson*, supra, that a report to the Wright-Patterson Air Force Base September 23, 1949 was not prior art as of that date because it "was not made available to the public until several years after December 10, 1949." Certainly this logic should also apply to a copending patent which is not available to the public as of its filing date and is not available to the public until it issues as a patent.

In *Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc.*, supra, the District Court held that government classified work was not part of the prior art. It said:

"Much reliance is also placed by the defendant upon the work carried on for the United States Government by the Department of Terrestrial Magnetism (abbreviated DTM) of the Carnegie Institution, in connection with work on a Magnetograph, in 1943. This work was classified as restricted for security purposes and was stipulated by counsel not to have been declassified until December 15, 1953, which date is subsequent to Heiland's date of conception and reduction to practice. It is, therefore, not to be deemed part of the prior art. * * *

Again, the logic should apply to a copending application.

Of course, any secret use, as contrasted to a public use, is not prior art. *Gillman v. Stern*, (C.A. 2, 1940) 114 F.(2d) 28; 46 USPQ 430.

Similarly, the Court of Customs and Patent Appeals in *In re Schlittler and Uffer*, supra, held that a manuscript submitted to the Journal of the American Chemical Society April 30, 1948 was not prior art as of that date because not published until November, 1948. Again, the logic should apply to copending patents.

As another instance that prior art must be publicly accessible, it is well settled that an abandoned application for a patent does not constitute evidence of prior art. *The Corn-planter Patent*, 23 Wall 181, 90 U.S. 181, 211; *Monarch Marking System Co. v. Dennison Mfg. Co.*, 92 F.2d 90, 34 USPQ 85; *Interurban Ry. & Terminal Co. v. Westinghouse Electric & Mfg. Co.*, 186 Fed. 166. In the last case cited, the Court quoted with approval the following from Walker on Patents, Fourth Edition:

"Novelty is not negated by any prior abandoned application for a patent. Abandoned applications for patents are not, by the statutes, made bars to patents to later applicants. They furnish no evidence that the processes or things they describe were ever made or used anywhere. Being only pen and ink representations of what may have existed only as mental conceptions of the men who put them upon paper, they do not prove that the processes or things which they depict were ever known in any country. Nor can they be classed among printed publications, for they are usually in writing, and are not published by the Patent Office."

The logic should apply to copending applications until the date of their issuance as patents. In fact, this situation is an excellent illustration of the reason why a co-

pending application should not be prior art—it may well be abandoned and thus lost forever to the public.

There are any number of decisions on the specific point that the filing of a patent application in the Patent Office does not make the contents of that application part of the prior art.

Outstanding rulings are:

“* * * Defendant claims that, therefore, the Pflanze patent may be cited in the present suit as prior art; whereas plaintiffs contend that although it may be used to show priority of invention, since prior invention is not here claimed by defendant, but merely that the object sought to be attained by the patent in suit can be obtained by a combination of inventions old in the art, it may not be used to show the state of the prior art embracing those separate inventions. With plaintiffs' contention we agree. *The defense of prior art rests on disclosure. There could be no disclosure to the plaintiff of defendant's application while pending in the Patent Office.* But the defense of prior invention rests on actual first conception of the idea. In other words, *in order for the prior applicant to be the first inventor, his patent application must actually disclose the thing patented to a later applicant.* Such was the holding in *Stelos Co. v. Hosiery Motor-Mend Corporation*, 72 F.(2d) 405, based upon what we understand to be a proper interpretation of the rule laid down by the Supreme Court in *Milburn Co. v. Davis, etc., Co.*, 270 U.S. 390.”

Baltimore v. Oles (D.C., D. Md. 1936) 13 F. Supp.951; 29 USPQ 11. (Affirmed on other grounds 89 F. (2d) 279; 33 USPQ 267)

“Strictly speaking, *this patent cannot be used for the purpose of anticipation, but only to show that the patentees of the patent in suit were not the first and*

original inventors of the subject matter disclosed, because although this patent was applied for before the application was filed for the patent in suit, and the date of invention of the patent in suit was not carried back of that, this patent was not issued until about four years after the issuance of the patent in suit. *Milburn Co. v. Davis, etc., Co.*, 270 U.S. 390."

Allied Metal Stamping v. Standard (D.C., E.D.N.Y. 1932), 57 F.(2d) 296; 13 USPQ 50.

"In *Old Town Ribbon & Carbon Co., v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379, 72 USPQ 57, the same court, in an opinion by the same judge, held that the first of copending patents was *not* prior art as to the others, and that it could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention. *This is the position taken in most modern cases in the Courts of Appeals.* *B.F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 1 Cir., 122 F.2d 900, 913, 51 USPQ 198,211; *Sherwin-Williams Co. v. Marzall*, D.C.Cir., 190 F.2d 606, 89 USPQ 208."

(Emphasis Court's)

Weatherhead Co. v. Drillmaster Supply (C.A.7, 1955), 227 F.2d 98; 107 USPQ 184.

"We think the defendant is right in its insistence that the second Speakman patent, which did not issue until after McDonough's filing date, should not be treated as part of the prior art for purposes of determining the issue of patentable invention in McDonough's claims. *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379, 72 USPQ 57; *Comolite Corp. v. Davidovitz*, 2 Cir., 111 F.2d 121, 45 USPQ 241; *Stelos Co. v. Hosiery Motor-Mend Corp.*, 2 Cir., 72 F.2d 405, 23 USPQ 35.
• • •

"Both Speakman's second U.S. Patent and the Evans and McDonough Patent did not go to issue

until after the filing date of the patent in suit. On that account they could not be held to constitute part of the prior art or as anticipating patents under 35 U.S.C.A. § 102(a). Nevertheless, they were anticipatory under the doctrine of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S.390, now codified in 35 U.S.C.A. § 102(e). *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, supra; *Stelos Co. v. Hosiery-Mend Corp.*, supra. * * *

Helene Curtis v. Sales Affiliates (C.A.2, 1956), 233 F.(2d) 148, 156; 109 USPQ 159,166,167.

"Andrews and Neuman, Spencer and Metcalfe, and Herr did not constitute prior art in the strict sense, as against Roberts, since their several applications had not ripened into patents at the time that Roberts filed; hence neither he nor the public was apprised of them. See: *Comolite Corporation v. Davidovitz et al.*, 111 F.2d 121, at 123 [45 USPQ 241, at 243]; *Stelos Co. v. Hosiery Motor-Mend Corporation et al.*, 72 F.2d 405, at 406 [23 USPQ 35, at 36]; *Utah Radio Products Co. v. Delco Appliance Corporation*, 24 F.Supp. 328, at 340 [38 USPQ 400, at 413].

"Sight has not been lost of defendant's quotation from the opinion in *Detrola Radio & Television Corporation v. Hazeltine Corporation*, 313 U.S. 259, at 265 [49 USPQ 337, at 339], which is to the effect that applications pending but unknown to the public, at the time of filing the patent in suit, constitute prior art. Authority for that statement is the *Milburn case*, supra, in which the decision is squarely to the effect that such application may be consulted on the issue of priority of invention.

"In order to portray that which is known at a given time on a given subject, i.e., the state of the art, recourse may be had to printed publications, but that means printed matter to which the public mind is exposed. It is difficult to see how applications pending in the Patent Office can be so described,

prior to the grant of the patents upon which they are based.

"As long ago as in 1874 it was decided by the Supreme Court in *Brown v. Guild*, 90 U.S. 160 at 211, that 'a mere application for a patent is not mentioned as such a bar (a "patent" or a "description in a printed publication"). It can only have a bearing on the question of prior invention or discovery.' That was written concerning a patent which had been filed prior to the one in suit, and later withdrawn; it was deemed to be but an abandoned experiment and not to anticipate plaintiff. Surely that result could not have been reached if the filing, standing by itself, had been deemed to define one constituent of the art as it existed when the patent in suit was filed."

Western States Machine Co. v. S.S. Hepworth Co. (E.D.N.Y. 1943) 51 F.Supp. 859, 58 USPQ 102,114.

For other supporting cases see:

Old Town v. Columbia Ribbon (C.A. 2, 1947) 159 F.(2d) 379; 72 USPQ 57;
Gray Telephone Pay Station Co. v. Baird Mfg. Co., (C.A.7, 1909), 174 Fed.417,421;
Vacuum Engineering Co., v. Dunn (C.A.2, 1913), 209 Fed. 219;
Hazeltine Corp. v. Electric Service Engineering Corp., (D.C., S.D.N.Y. 1926), 18 F.(2d) 662;
American Tri-Ergon Corp. v. T.E. Robertson (Sup.Ct. D.C. 1931), 11 USPQ 168;
Hazeltine Corp. v. Coe (Ct. App. D.C., 1936), 66 App. D.C. 341; 87 F.(2d) 558; 31 USPQ 405;
Utah Radio v. Delco (W.D.N.Y., 1938), 24 F. Supp.328; 38 USPQ 400;
East Rutherford Syringes v. Omega (D.C.N.J. 1957) 152 F.Supp. 497; 114 USPQ 147,150;
John Blue Co. Inc. v. Dempster Mill Mfg. Co. (C.A. 8, 1960) 124 USPQ 485, 488;

Stelos Company, Inc. v. Hosiery Motor-Mend Corp. (C.A. 2, 1934), 72 F.(2d) 405; 23 USPQ 35.

The leading authority Walker on Patents—Deller's Edition (1937) states the rule as follows at pages 136 and 137:

“§ 26. Prior Art.

In determining whether patentable invention is involved, the entire prior art must be taken into consideration. [*Eibel Process Co. v. Minnesota, etc., Paper Co.*, 261 U.S. 45, 67 L. Ed. 523 (1923); *N.Y. Scaffolding Co. v. Liebel-Binney Constr. Co.*, 254 U.S. 24, 31, 65 L. Ed. 112 (1920).] The prior art includes disclosures of anticipatory patents, publications and uses. [*National Electric Ticket Register Co. v. Automatic Ticket Register Corp.*, 15 F.(2d) 257, 258, C.C.A. 2 (1926); *Panay Horizontal Show Jar Co. v. Aridor Co.*, 292 Fed. 858, 859, C.C.A. 7 (1923); *Thomson Spot Welder Co. v. Ford Motor Co.*, 268 Fed. 836, *aff'd* 281 Fed. 680, C.C.A. 6 (1922).]

“A mere application for a patent is not a part of the prior art, since an application is confidential and the public cannot be informed of its contents until a patent issues upon it. [*Sundh Electric Co. v. Interborough Rapid Transit Co.*, 198 Fed. 94 (1912); *Vacuum Engineering Co. v. Dunn*, 209 Fed. 219 (1913); *Patents Selling & Exporting Co. v. Dunn*, 213 Fed. 40 (1914); *Mergenthaler Linotype Co. v. International Typesetting Machine Co.*, 229 Fed. 168 (1914).] But an application which eventuates into a patent, while such patent may not be part of the prior art, as it may have issued after the patent in suit, can nevertheless be used to prove that the patentee of the patent in suit ‘was not the original and first inventor or discoverer’ of any material and substantial part of thing patented. [*Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 70 L. Ed. 651,

653 (1926); *Osteen v. Ansco Photoproducts*, 27 F. (2d) 688,689, C.C.A. 2 (1928); *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.(2d) 823,830, C.C.A. 2 (1928); *Electrol, Inc. v. Merrell & Co.*, 39 F.(2d) 873,877, C.C.A. 8 (1930); *Fessenden v. Wilson*, 48 F.(2d) 422,423,424, Cust. & Pat. App. (1931); cert. den. 284 U.S. 640 (1931); *Benedict v. Menninger*, 64 F.(2d) 1001, 1003, Cust. & Pat. App. (1933); *In re Alexanderson*, 69 F.(2d) 541, 542, Cust. & Pat. App. (1934); *Stelos Co. v. Hosier Motor-Mend Corp.*, 72 F.(2d) 405, C.C.A. 2 (1935).]

Errors of the District Court's Opinion

The District Court below has held that the Patent Act of 1952 did not change the law at issue in this case. This depends upon "which law" one is referring to as there has been a direct conflict in the law on this point. We contend that the Act codified the rulings of the Court of Appeals in "most modern cases" (*Weatherhead v. Drillmaster*, *supra.*).

In the first place, as the last word on the issue from Congress in 1952, Section 102(e) supersedes all prior judicial pronouncements. It states the congressional intent as to just how much of *Alexander Milburn v. Davis-Bournonville* is to be the law. Any speculation as to what the Supreme Court may have meant in that case, or whether it meant to extend it in later cases, is now irrelevant. Section 102(e) is clear and unambiguous. It does *not* say that copending patents are part of the prior art. We are therefore free to draw conclusions anew on that question and such conclusions ought to be consonant with the logic heretofore discussed. The most logical conclusion is that the failure of Congress to broaden the principle of *Alexander Milburn* to encompass copending patents disclosing less than "a complete and adequate description" (*Milburn*) of "the invention" (Sec.102[e]) means that copending patents are intended *not* to be prior art.

Much the same may be said of *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259,—and more. The District Court in the present case was strongly influenced by *Detrola* as a supposed extension of *Alexander Milburn*. But in *Detrola*, the present issue was not clearly before the court. Insofar as we have been able to determine it was not even presented in the briefs. Therefore, the single remark "All constituted prior art" and the footnote reference to *Alexander Milburn* (313 U.S.259, 265), which appears to be all that was said on the issue, are apparently *obiter dictum*. Nowhere is it clear whether the Supreme Court in *Detrola* was thinking of the patents there involved only as individually anticipatory, as in the *Milburn* case requires, or something more. We submit, therefore, that the *Detrola* case is of no help to the present issue. In fact, since much of the subsequent case law in this brief is to the opposite effect, it may be presumed that many courts have not recognized *Detrola* as authoritative on the present issue. What is more, it was specifically considered in *Western States Machine Company v. S.S. Hepworth Co.*, quoted, *supra*, and given the limited interpretation conforming to appellants' argument in this case.

Next, the District Court contends (page 2 of Opinion) that the issue is well settled in this Circuit but in citing authority lists three cases (*Sherwin-Williams Co. v. Marzall*, *Dyer v. Coe* and *Minnesota Mining & Manufacturing v. Coe*) against and one (*Hazeltine Corp. v. Coe*) for Appellants' position—all before the Patent Act of 1952. The issue is therefore *not* well settled.

Of course, the District Court in the footnote 4 of page 3 of its Opinion notes that *Minnesota Mining & Manufacturing v. Coe*, as well as *Dyer v. Coe*, distinguished the *Hazeltine v. Coe* case on the ground that it did not decide the present issue of law but rather on technical issues. This is not so. The facts in the *Hazeltine v. Coe*, the *Minnesota Mining v. Coe* and *Dyer v. Coe* cases were

substantially identical. In the *Hazeltine v. Coe* case it was also sought to combine a plurality of copending patents with a patent admittedly in the prior art to negative invention just as in the present case. The court discussed the *Alexander Milburn* case, *supra*, in view of which it refused to consider the disclosures of the copending patents, holding that they were not competent evidence of prior art with respect to the invention in issue since they constituted secret applications at the time the invention was made, and reversed the decision of the District Court and held the claims patentable.

That the decision of the court was founded on the question of law involved and not on technical issues is clearly shown by the Petition for Rehearing filed by the Solicitor for the Commissioner of Patents and the Answer to the Petition. The first two reasons given for the request for rehearing read as follows:

"1. The court in its Opinion rendered December 7, 1936, did not specifically pass upon the question raised by the appeal of whether invention would be involved in applying to an automatic amplification control circuit, as shown in the Friis patent, or in the Affel patent, a visual indicator to indicate resonance as shown in the Perry patent.

"2. The conclusion stated on page 3 of the Opinion of this Court as to what is disclosed in the Perry patent and the conclusion that the patents to Friis, Heising and Affel do not prevent an award to Wheeler as the first inventor, are not determinative of the question whether the claims in suit define invention over any one of these last three patents in view of the disclosure of the Perry patent."

Appellant in opposition to the Petition for Rehearing stated:

"1. The question which the court is asked to decide is a moot question. Appellee has asked the court

to rule specifically on the question as to whether invention would be involved in combining the resonance indicator of Perry patent 1,536,130 with the radio receiving systems disclosed in Affel patent 1,574,780, Friis patent 1,675,848, or Heising patent 1,823,360 in order to anticipate Wheeler's invention. However, there is no occasion for a decision on this question for the court has correctly ruled that, irrespective of whether or not invention would be involved in such a combination, as a matter of law the combination is prohibited, since the Affel, Friis, and Heising patents are not a part of the prior art as to Wheeler, in that when Wheeler made his invention the disclosures of these patents were secret disclosures contained in applications pending in the United States Patent Office."

The Court of Appeals in that case denied the Petition for Rehearing without Opinion, this impliedly approving appellant's position.

Further, as appears from the record of *Hazeltine v. Coe* supra, the Solicitor for the Patent Office moved for and obtained a stay of mandate for petitioning the Supreme Court for a Writ of Certiorari. The Solicitor for the Patent Office sought permission from the Department of Justice to file such a Petition but was refused on the ground that the *decision of the Court of Appeals in that case was not in conflict* with the then prevailing weight of authority.

Nor was the District Court correct in intimating (page 3 of Opinion) that The Court of Customs and Patent Appeals had consistently held against appellants' position. One of the three cases cited as authority, *In Re Youker*, 77 F.(2d) 624, 25 USPQ 421 (C.C.P.A. 1935), is confusing as to the factual basis of decision, but its opinion does include a clear statement:

"It appears that the patents to Seguy, Howard et al and Dickson were not issued until after appellant had filed his application. Therefore, they are not technically a part of the prior art, * * *" (25 USPQ 421,422)

This, of course, is the position of appellants here.

What is more, The Court of Customs and Patent Appeals has been inconsistent in logic if it views copending patents as part of the prior art on the ground that anything falling within the categories of 35 USC 102 is prior art. In a recent case *In re Palmquist*, 319 F.(2d) 547, 138 USPQ 234, it held that a certain Boskirk publication did not fall within Section 102(b) saying, " * * * since it does not 'describe' the claimed invention, it is *not* a statutory bar under 35 USC 102(b)." By the same logic, a copending patent, such as Wallace here, should not fall within Section 102(e) since it does not describe the claimed invention.

Summary

In short, prior knowledge accessible to the public, together with printed publications and issued patents is what is commonly termed collectively as the "prior art", that body of publicly available information against which each advance over the art is tested to determine whether such advance involves invention. Obviously, a copending patent is not a patent or a printed publication until its issue; factually, until then, it is not publicly available information.

Therefore, under the statutes, a copending patent cannot be considered as part of the prior art to negative invention by another during its pendency.

Such a copending patent may be asserted only on the ground that it deprives a later inventor of the status of *first* inventor by showing that *the same invention* in its entirety had been made before.

We can do no better than to adopt the words of Commissioner of Patents Newton who was faced with precisely the same problem as in this case in *Ex Parte Thomas* (1918 Decisions of the Commissioner of Patents 11), namely, the status of a copending patent to Barr in relation to the application of Thomas. He wrote at page 13:

"Definitions

For the purposes of this decision *the distinction is constantly maintained between 'anticipation' and 'priority,'* the former term meaning the existence in the prior art of something which precludes the novelty of the invention in controversy, the latter term meaning the earlier date of invention of the invention in controversy by one or two or more rival inventors. The term 'prior art' is herein used as meaning that material of invention which may, if of anticipatory character, defeat the right of an inventor to patent protection solely because of its existence prior to the date of his invention. For the sake of brevity I have adopted the intrinsically inaccurate term 'copending patent' to denote a patent granted after the filing of the application for the invention in controversy or other reduction to practice of that invention on an application earlier filed.

The Requisites of Anticipation

An invention is not anticipated unless the prior art contains some invention so nearly like it that in view of all pertinent facts, the difference did not require invention, which was completed or perfected *and knowledge of which was accessible to the public* prior to the date of its completion. Completion of an invention requires reduction to practice, actual or constructive. Constructive reduction to practice is accomplished when an allowable application has been filed complete in the Patent Office. It has reference to questions pertaining to proceedings necessary to ob-

tain a patent and to the trial of an issue of priority between applications while they remain within the jurisdiction of the Patent Office, which may be here neglected, and to the question concerning completion of the invention to which it relates. Proof of completion of the invention is *prima facie* when the application is found allowable. It is subject to review as evidence of a fact. *Knowledge of an anticipating invention must be accessible to the public. It anticipates only inventions which were completed after such accessibility accrued.*" (Second emphasis Commissioner's)

And at page 31 he wrote:

"Summary

An invention is not patentable if it has been anticipated. Anticipation involves as essential elements completion of a like invention and *accessibility of knowledge of the anticipating invention to the public* before the completion of the invention in controversy. Anticipation occurs when an invention of anticipatory character has been patented or described in a printed publication or has been otherwise known or used in such a way that *knowledge of it is accessible to the public* before the completion of the invention in controversy; *but the statute provides another bar to the right to patent protection, known as 'prior invention.'* This rests upon a different foundation of fact, which is the previous invention of the invention in controversy by some one other than the claimant whose right to patent protection is in question, who, if any one, is entitled to patent protection on that invention. The defense founded upon this bar raises an issue of priority. * * *

"An issue of priority is presented when two or more patentees have conflicting claims. The same question of fact, having the same bearing upon the

right to patent protection in question, may arise under the terms of the statute when there are no conflicting claims. The issue is still an issue of priority.

"The reason for the rule last stated is found in the succession of the public to the right of the inventor who neglected to claim the invention, which succession is supported by the authorities above cited to that effect; but the direct basis of the rule as applied by most of the decisions which deal with prior invention is the *statute itself, which provides for an issue of priority as distinguished from an issue of anticipation*, without limiting the defense authorized to cases which involve conflicting claims. According to what I consider the better-authorized opinion one practical effect of the distinction is that, *when the issue is that of priority, in order to sustain the defense the inventions compared must be 'the same' according to criteria more or less different from those applied when the issue is that of anticipation. Priority concerns identity of invention, while anticipation concerns the presence of patentable difference.* Two practical effects of the distinction are, first, anticipation is not subject to abandonment; second, *knowledge of the prior invention need not be accessible to the public at the date of completion of the invention in controversy. The defense of prior invention proceeds upon the supposition that a legal right has been established and not abandoned which is antagonistic to the right of the inventor of the invention in controversy. If the prior inventor does not claim the invention, the public succeeds to his right at the date of patent, but not until then. At this point the patent becomes one of anticipation as distinguished from priority.* The application not claiming the invention in controversy is thoroughly similar to the application claiming it so far as proof of the pertinent facts is concerned. The claiming application involves a conflict of rights of inventors to which accessibility of knowledge of the invention in controversy to the

public is not pertinent. One not claiming it shows identically the same state of facts so far as the requirements of the defense of prior invention stated in the statute are concerned and should have the same effect when a patent is granted."

This, then, is the difference between Section 103 and Section 102(e) of the Patent Act of 1952.

Commissioner Newton then went on to hold for Thomas that his invention was not the same as that disclosed in the copending application of Barr.

CONCLUSION

In view of the foregoing, it is submitted that:

1. Wallace is not part of the prior art and is therefore not legally competent evidence under 35 USC 103.
2. Wallace, if available at all, is only available under 35 USC 102(e) and that is precluded by the fact that it does not describe the entire invention as the Patent Office admits.

Therefore, Appellants are entitled to the relief prayed for.

Respectfully,

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STATUTES REPRODUCED

35 U.S.C. SECTION 102

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to prac-

tice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. July 19, 1952, c. 950, § 1, 66 Stat. 797.

Historical and Revision Notes

Reviser's Note. Paragraphs (a), (b), and (c) are based on 35 U.S.C., 1946 ed., § 31 (R.S. 4886 [derived from Act July 8, 1870, c. 230, § 24, 16 Stat. 201], amended (1) Mar. 3, 1897, c. 391, § 1, 29 Stat. 692, (2) May 23, 1930, c. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212).

No change is made in these paragraphs other than that due to division into lettered paragraphs. The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, "known" has been held to mean "publicly known") is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of title 35 U.S.C., 1946 ed., § 72 (R.S. 4923 [derived from Act July 8, 1870, c. 230, § 62, 16 Stat. 208]).

* * * *

Paragraph (e) is new and enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor.

* * * *

35 U.S.C. SECTION 103

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in sec-

tion 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798.

Historical and Revision Notes

Reviser's Note. There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

* * * *

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BRIEF FOR APPELLEE

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 18,563

HAZELTINE RESEARCH, INC. and ROBERT REGIS,
APPELLANTS

v.

DAVID L. LADD, COMMISSIONER OF PATENTS, APPELLEE

Appeal from the Judgment of the United States
District Court for the District of Columbia

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United States Court of Appeals
for the District of Columbia Circuit

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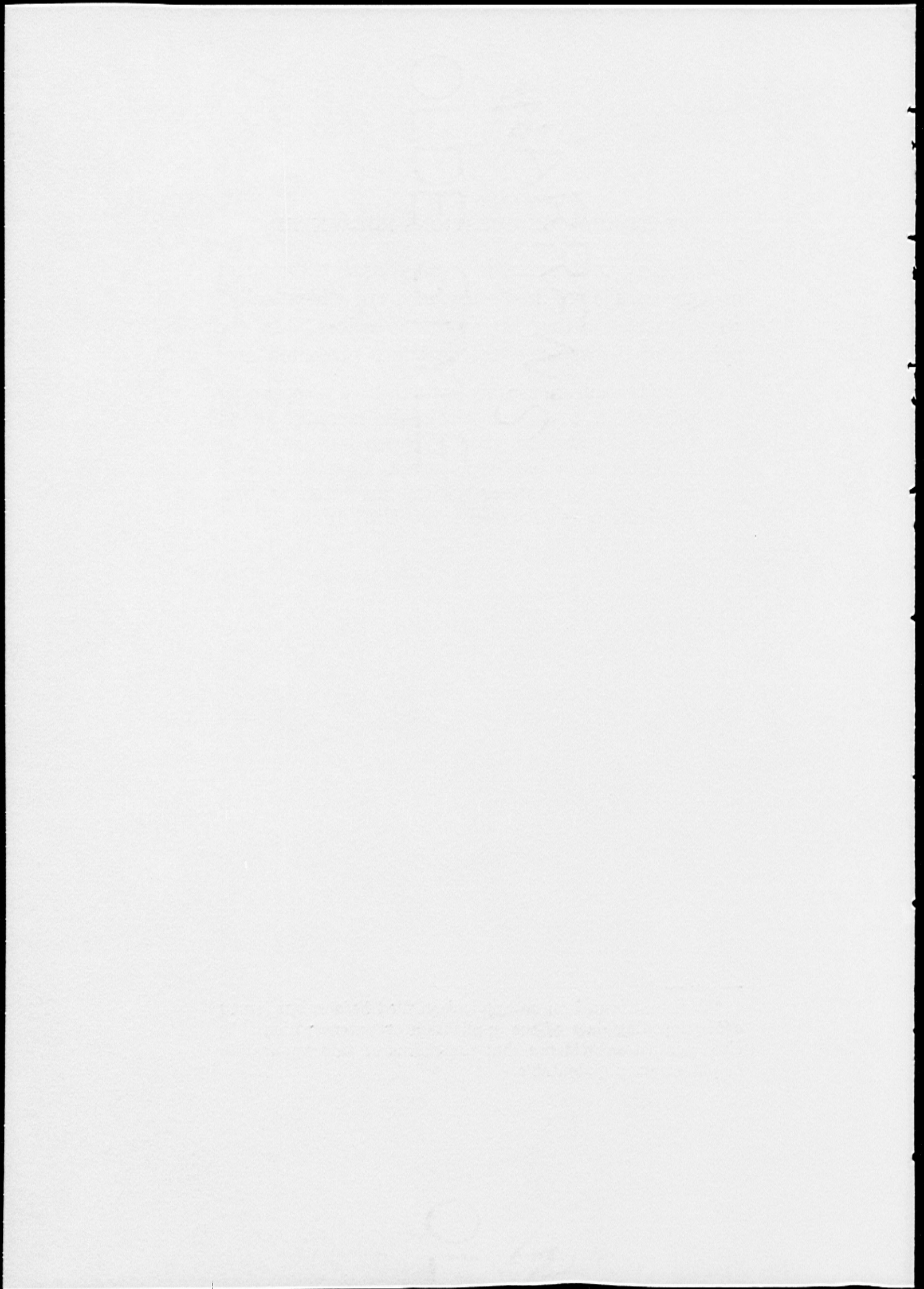


STATEMENT OF QUESTIONS PRESENTED

Appellee would agree with appellants' "Statement of Questions Presented" if the word "identically" were inserted before the word "describes." In the opinion of the appellee, the questions presented are:

"The questions are whether a 'copending patent'* is prior art within the meaning of 35 USC 103; and whether a 'copending patent' is available as a bar to a patent application only if it identically describes the invention of that application as provided in 35 USC 102(e)."

* A patent issued on an application filed *before*, but issued *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable.



INDEX

	Page
Counterstatement of the case.....	1
Summary of argument.....	3
Argument.....	4
The District Court properly based its decision on an interpretation of the term "Prior Art" in 35 U.S.C. 103.....	4
Prior to the Patent Act of 1952 the prevailing view was that claims could properly be held un- patentable over copending patents which did not completely anticipate.....	4
Nothing in the language or legislative history of the Patent Act of 1952 points to an intent to change the law as to copending patents. The act affirmatively indicates that copending pat- ents are "prior art" under Section 103.....	12
The decisions cited by appellants as to what is "prior art" are not controlling.....	15
The District Court decision is in accord with deci- sions in the U. S. Court of Customs and Patent Appeals.....	19
Appellants' view appears to lack rational basis.....	22
Conclusion.....	23
Decisions cited:	
Allied Metal Stamping v. Standard, 57 F. 2d 296..	17
American Tri-Ergon Corp. v. Robertson, 11 USPQ 168.....	17
Baltimore v. Oles, 13 F. Supp. 951.....	17
John Blue Co. Inc. v. Dempster Mill Mfg. Co. 275 F.2d 668.....	15
Helene Curtis v. Sales Affiliates, 233 F.2d 148.....	17
Detrola Corp. v. Hazeltine Corp., 313 U.S. 259.....	5
Dyer v. Coe, 75 U.S. App. D.C. 125, 125 F.2d 192..	9

II

Decisions cited—Continued	Page
East Rutherford Syringes v. Omega, 152 F.Supp. 497.....	17
Gray Telephone Pay Station Co. v. Baird Mfg. Co., 174 Fed. 417.....	17
In re Gregg, 44 CCPA 904, 244 F.2d 316.....	19
Hazeltine Corp. v. Coe, 66 App. D.C. 341, 87 F.2d 558.....	11
Hazeltine Corp. v. Electric Services Engineering Corp., 18 F.2d 662.....	17
In re Kander, 50 CCPA 928, 312 F.2d 834.....	20
Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390.....	7
Minnesota Mining & Mfg. Co. v. Coe, 69 App. D.C. 256, 100 F.2d 429.....	9
Old Town Ribbon & Carbon Co. v. Columbia Ribbon & Carbon Mfg. Co., 159 F.2d 379.....	15
Ex Parte Thomas, 1918 C.D. 11.....	18
In re Palmquist, 319 F.2d 547.....	20
In re Schlittler et al., 43 CCPA 886, 234 F.2d 882.....	22
Stelos Co. Inc. v. Hosiery Motermend Corp. et al., 72 F.2d 405, affirmed 295 U.S. 237.....	17
Utah Radio v. Delco, 24 F.Supp. 328.....	17
Vacuum Engineering Co. v. Dunn, 209 Fed. 219.....	17
Weatherhead Company v. Drillmaster Supply Company, 227 F.2d 98.....	16
Western States Mach. Co. v. S. S. Hepworth Co., 51 F.Supp. 859.....	6
Western States Mach. Co. v. S. S. Hepworth Co., 147 F.2d 345, cert. denied, 325 U.S. 873.....	7
Sherwin Williams Co. v. Marzall, 88 U.S. App. D.C. 374, 190 F.2d 606.....	9
 Statutes and regulations:	
35 U.S.C. 102(a).....	13
35 U.S.C. 102(b).....	13
35 U.S.C. 102(e).....	8
35 U.S.C. 103.....	5

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BRIEF FOR APPELLEE

COUNTERSTATEMENT OF THE CASE

Appellants' "Statement of the Case" on page 2 of Brief for Appellants * is accurate as far as it goes. The rejection of the application in suit was based on a patent to Wallace et al., No. 2,822,526 (JA-54A), issued February 4, 1958, on an application filed

* Hereinafter referred to as "Brief".

March 24, 1954, ** and a patent to Carlson, No. 2,491,644 (JA-50A), issued December 20, 1949. As appellants point out (Brief, page 2), the Patent Office held that "it was obvious to combine the teachings of Wallace and Carlson to produce the results sought by Regis." Appellants then state, "Whether or not this is true is not at issue here." That statement amounts to an admission that the subject matter sought to be patented would be obvious in view of the teachings of the two references. The only alleged defect found by appellants in the rejection of the claims is the fact that Wallace et al. is a copending patent and has been combined with another patent. It is unnecessary, therefore, as appellants suggest (Brief, page 4), to go into the technical features of the claims and references. It is deemed sufficient to point out that appellants' description of their application device and of the references is accurate, with the exception that they have omitted to point out that member 26 in Figures 3 and 4 of Wallace et al. (JA-55A) was held by the examiner to create a short circuit across wave guide 22 (JA-23A), and that they (the appellants) admitted that such may be the case (JA-22A).

The single issue is, then, whether the claims in a patent application may, under prevailing law, properly be held unpatentable over a copending patent having a disclosure which does not fully anticipate the claimed subject matter, but which differs therefrom in some respect which would have been obvious to

** Wallace is, therefore, a "copending patent" as defined in footnote 1 in the Opinion of the District Court (JA-70A).

one skilled in the art at the time the invention was made.

SUMMARY OF ARGUMENT

The parties are in agreement that 35 U.S.C. 102(e) deals only with copending patents which fully disclose the subject matter sought to be patented.

Decisions of the Supreme Court, of this Court, and of other Courts of Appeals establish that it was settled law prior to the Patent Act of 1952 that a patent claim could properly be held unpatentable over a copending patent which did not disclose all of the claimed subject matter. It was settled that copending patents could be combined with other disclosures in holding a claim unpatentable or invalid.

Neither the language nor the legislative history of the Patent Act of 1952 exhibits any intent to change the law as to copending patents. Rather, the Act and its history clearly indicate that the "prior art" referred to in Section 103 of the Act is that which is disclosed or described as set forth in the applicable parts of Section 102. Certain of the decisions cited by appellants in support of a more limited definition appear to support the District Court opinion, and the remainder are not controlling. The U. S. Court of Customs and Patent Appeals has expressly held that copending patents are "prior art" under Section 103.

As a matter of common sense, appellants' views are believed to be without substance.

ARGUMENT**The District Court Properly Based Its Decision on an Interpretation of the Term "Prior Art" in 35 U.S.C. 103**

The District Court properly held (JA-70A), all parties agree, that resolution of the issue in this case hangs on the interpretation to be given the term "prior art" as it is used in Section 103 of Title 35 of the United States Code. That section and no other authorizes rejection of claims by the Patent Office on the ground that the claimed subject matter is obvious in view of cited prior art. It follows that appellants are correct in saying (Brief, page 6) that 102(e) deals only with copending patents which fully disclose the claimed subject matter. In contending that Section 103 does not apply when the copending patent discloses less, they are, however, believed clearly to be in error in view of the authoritative case law prior to the Patent Act of 1952, the language of the Act itself, its legislative history, and judicial interpretation of the Act.

Prior to the Patent Act of 1952 the Prevailing View was That Claims Could Properly be Held Unpatentable Over Copending Patents Which did not Completely Anticipate

The District Court was manifestly correct in holding (JA-71A) that prior to the Patent Act of 1952, the controlling court decisions were to the effect that claims could properly be held unpatentable because the differences between the claimed subject matter and a copending patent disclosure were within the ingenuity of those of ordinary skill in the art. As the

District Court pointed out (JA-70A), the Supreme Court effectively so held in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259. That case involved a reissue of a patent to Wheeler, No. 1,879,863, issued on an application originally filed July 7, 1927. The claims were directed to a radio circuit designed to control automatically the amplitude of amplified signal voltage by developing negative potential upon the anode of the detector proportionally to the signal strength. Among the patents relied on by the defendant were copending patents to Heising, No. 1,687,245, issued October 9, 1928, Bjornson, No. 1,666,676, issued April 17, 1928, Schelleng, No. 1,836,556, issued December 15, 1931, Friis, No. 1,675,848, issued July 3, 1928, and Evans, No. 1,736,852, issued November 26, 1929. The Court stated, as to these patents and others issued prior to Wheeler's filing date, "All constituted prior art," (page 265 in 313 U.S.).

The attempt by appellants (Brief, page 25) to discount the pertinency of the *Detrola* case to the present issue should fail, it is submitted. The Court's reference to copending patents as prior art was not limited, as appellants would have it, to "the single remark 'All constituted prior art' and the footnote reference to Alexander Milburn (313 U.S. 259,265)" (Brief, page 25). Page 267 of 313 U.S. includes the following:

"There can be no question that the patents cited as *prior art* disclose the accomplishment of linear response. The curve exhibited in Wheeler's drawings to illustrate the result of the use of

his system is duplicated in similar curves by Affel and Friis" (emphasis added).

As noted, Friis was a copending patent. Further, the Court stated (at page 268 of 313 U.S.), "* * * it remains that practically all of the patents cited from *the prior art* employ a resistance to impress the required potential on the amplifier grid for controlling amplification and that two of them, those of Heising and Slepian, disclose the use of a resistance in connection with a diode" (emphasis supplied).

Appellants are also believed to be incorrect in saying (Brief, page 25) "Nowhere is it clear whether the Supreme Court in *Detrola* was thinking of the patents there involved only as individually anticipatory, as the *Milburn* case requires, or something more." The Supreme Court had clearly in mind that the Heising patent (a copendent patent, as already pointed out) was not individually anticipatory. So much is shown by the following passage at page 268 of 313 U.S.:

"The court below distinguishes Heising on the ground that his purpose was not to control the volume of audio waves but rather to use less current in the radio frequencies of a transmitter. We hold, as did the Circuit Court of Appeals of the Second Circuit, that these distinctions do not negative anticipation by Heising."

The Court, thus, recognized a distinction between the Heising disclosure and the claims in issue but held the claims unpatentable.

Appellants' reliance (Brief, page 25) on the limited interpretation of the *Detrola* decision in *Western*

States Mach. Co. v. S. S. Hepworth Co., 51 F.Supp. 859, reacts to their disadvantage rather than otherwise. On appeal, there was a modification of that decision, and the lower court's holding on the import of the *Detrola* case was expressly reversed. In the appeal decision, *Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F.2d 345, cert. denied, 325 U.S. 873, the Court stated, through Judge Learned Hand:

"The judge suggested, as we understand it, that Carlson's patent was not relevant, because it was not part of the prior art when Roberts conceived his invention. In this it seems to us that he did not give proper weight to the revolutionary decision of the Supreme Court in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 46 S.Ct. 324, 70 L.Ed. 651. Nor can we agree that, except in mere form, it is incorrect to call an application, still in the Patent Office, "prior art," as the court did in *Detrola Corporation v. Hazeltine Corporation*, 313 U.S. 259, 265, 61 S.Ct. 948, 85 L.Ed. 1319; because in effect that is just what it is * * *."

"That decision (*Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390) as we understand it—meant to disregard the fact that an earlier application did not at the moment enrich the art; it proceeded upon the assumption—perhaps not fully expressed, but implied—that since its disclosure would eventually fall into the public demesne quite as much as though it were presently published, the interval during which it remained secret should be disregarded. True, that was not necessary for the protection of the first inventor, who needed only that his own

claims should be valid; but, once the first application is treated as prior art when it fully anticipates, there seems to be no reason to deny it whatever effect it would have as prior art, if it were literally such."

Judge Hand's decision, therefore, not only asserts that the *Detrola* case is authority for calling copending patents "prior art" but it also asserts that such would necessarily follow from the rationale of the Supreme Court decision (*Alexander Milburn Co. v. Davis-Bournonville Co.*) on which 35 U.S.C. 102(e) is based (see page 2410, United States Code, Congressional and Administrative News, 82nd Congress, Second Session, 1952, Volume 2, reproducing the Report No. 1979 of the Committee on the Judiciary of the United States Senate on the bill enacted as the Patent Act of 1952). Judge Hand's decision goes on to say:

"It follows from what we have said that Carlson's patent left nothing on which Roberts could rely, except the fact that Roberts carried automaticity beyond the "purging" and spraying periods, and included the drying period. Particularly, when we consider that Roberts took this step only a year after Carlson filed his application, there would be no warrant for allowing it to be the basis of a patent."

It is clear from that statement that Carlson's copending patent did not anticipate Robert's claims as to automaticity in some parts of the operation. Nevertheless, the Court held that such a difference could not be the basis of a patent. The *Western*

States Mach. Co. decision, expressly approves, therefore, the rejection of claims on copending patents which fall short of complete anticipation.

Prior to the 1952 Act, it was well settled in this jurisdiction, as the District Court noted (JA-71A), that copending patents were available as references to show that the claimed subject matter represented only the exercise of the skill of the art. The question was squarely raised and so decided in *Minnesota Mining & Mfg. Co. v. Coe*, 69 App. D.C. 256, 100 F.2d 429; *Dyer v. Coe*, 75 U.S.App. D.C. 125, 125 F.2d 192; and *Sherwin Williams Co. v. Marzall*, 88 U.S. App. D.C. 374, 190 F.2d 606. No more recent decision by this Court holding otherwise is cited by appellants, and none is known. In the *Minnesota Mining & Mfg. Co.* decision, the Court referred to the *Alexander Milburn Co.* opinion and stated:

"It is disclosure of knowledge inconsistent with a later claim of first invention which is important in determining the effect of co-pending applications. Although the issuance of a patent or other proof of prior invention will constitute a disclosure, prior invention is not alone controlling; for disclosure may also occur in other ways, as by publication in a periodical, by a disclaimer of invention of a described process, or by an abandonment thereof. Consequently, it is immaterial—if a disclosure actually occurs—whether it results from a description in a single co-pending application, from descriptions in several such applications, or from descriptions in co-pending applications together with descriptions in previously issued patents. Prior knowledge,

clearly revealed is repugnant to the claim of first invention. This is the meaning of the decision in the Milburn Co. Case. There is nothing in the opinion to indicate that the Court intended to state a formal, arbitrary rule concerning a complete and adequate description, in a single application, by or on behalf of a prior inventor. What it had in mind was a disclosure in any form of knowledge inconsistent with a claim of first invention.

* * * *

"Whether or not the co-pending applications could properly be considered, therefore, to show the prior art in the technical sense, they were properly considered to determine whether they disclosed knowledge upon the part of the prior applicants inconsistent with appellant's claim of first invention. *Stelos Co., Inc., v. Hosiery Motor-Mend Corp.*, 2 Cir., 72 F.2d 405, affirmed, 295 U.S. 237, 55 S.Ct. 746, 79 L.Ed. 1414; *In re Youker, Cust. & Pat. App.*, 77 F.2d 624.

* * * *

"The question has been considered and decided adversely to appellant's contention, also, by the United States Court of Customs and Patent Appeals in *Re Youker*, supra; by the Circuit Court of Appeals for the Sixth Circuit in *Ottinger v. Ferro Stamping & Mfg. Co.*, 59 F.2d 640, 643; by the Circuit Court of Appeals for the Second Circuit in *Hazeltine Corp. v. Abrams*, 79 F. 2d 329; and by the Circuit Court of Appeals for the Fourth Circuit in *Denaro v. Maryland Baking Co.*, 50 F.2d 1074, which adopted the opinion of the lower court reported in, D.C., 40 F.2d 513, 515, 516."

The decision in the *Sherwin Williams Co.* case stated:

"We have been shown nothing which would warrant our rejecting the findings of the trial court. There is no longer any question that the Lacey patent was available as a reference even though it was actually issued after appellant had filed his application. 'Co-pending applications which, either singly, or in combination with previous patents or other co-pending applications, or both, disclose knowledge inconsistent with a claim of first invention, are available as references.' In view of that patent and of the others described in the findings of the trial court, it would seem that appellant's 'advance over the prior art * * * required only the exercise of the skill of the art.'"

On page 25 of their brief, appellants would appear to say that the District Court erred in this case in saying that the *Hazeltine Corp. v. Coe* case (66 App. D.C. 341, 87 F.2d 558) was distinguished by this Court in the *Minnesota* and *Dyer* decisions on the ground that it did not decide the present issue of law but rather on technical issues. That contention of appellants is refuted by the following passage in the *Dyer* decision:

"*Dyer* relies upon *Hazeltine Corp. v. Coe*, 1936, 66 App.D.C. 341, 87 F.2d 558, as supporting the contention that the Collins patent is not available as a reference. But, as we said in *Minnesota Mining & Manufacturing Co. v. Coe*, supra,³ *Hazeltine Corp. v. Coe* merely decided that since "all of the co-pending references relied upon therein failed, either singly or in combination, to

disclose the claims of the later applicant, they did not prevent the issuance of a patent to him as the first inventor." We think it can be regarded as settled law that co-pending applications which, either singly, or in combination with previous patents or other co-pending applications, or both, disclose knowledge inconsistent with a claim of first invention, are available as references. Cf. *Alexander Milburn Co. v. Davis-Bournonville Co.*, 1926, 270 U.S. 390, 46 S.Ct. 324, 70 L.Ed. 651."

The District Court decision in this case, therefore, accords with what was regarded as "settled law" (*Dyer v. Coe*) prior to the Patent Act of 1952.

Nothing in the Language or Legislative History of the Patent Act of 1952 Points to an Intent to Change the Law as to Copending Patents. The Act Affirmatively Indicates That Copending Patents are "Prior Art" Under Section 103

The District Court was obviously correct in pointing out (JA-73A) that, in view of the settled state of the law as to copending patents prior to the Act of 1952, there would have to be clear and unmistakable language in the Act or a clear expression of legislative intent in the Act's history if a Court were to conclude that any change was intended. No such language or expression of intent was found by the District Court, and appellants would seem to refer to none. On the contrary, the language of the act and its history are believed affirmatively to suggest that no change was intended.

As pointed out hereinbefore, Section 102(e) of Title 35 refers only to copending patents which fully

disclose the claimed subject matter. Sections 102(a) and 102(b) likewise refer to knowledge, uses, and disclosures which are identical to the subject matter sought to be patented. So much is made clear by Section 103, which provides, in pertinent part, that "A patent may not be obtained *though the invention is not identically disclosed or described as set forth in Section 102 of this title*, if the differences between the subject matter sought to be patented and *the prior art* are such that the subject matter as a whole would have been obvious * * *" (emphasis supplied). That language, obviously, extends the grounds for refusing patents set forth in section 102 to include not only disclosures which are full anticipations but also disclosures which are obvious variants of full anticipations. The "prior art" referred to in section 103 means the public knowledge, public use, patents, and publications which are described in the several sections of section 102. The Committee on the Judiciary of the Senate stated as much in its Report No. 1979 on the Patent Act of 1952 as follows:

"[Section 103] refers to the difference between the subject matter sought to be patented and the prior art, *meaning what was known before as described in Section 102*" (emphasis supplied).

P. J. Federico's "Commentary on the New Patent Act," 35 USCA Sections 1 to 110, pertinently states (page 20):

"In form this section is *a limitation on section 102* and it should more logically have been made part of section 102, but it was made a separate

section to prevent 102 from becoming too long and involved and because of its importance. *The antecedent of the words 'the prior art,' which here appear in a statute for the first time, lies in the phrase 'disclosed or described as set forth in section 102' and hence these words refer to material specified in section 102 as the basis for comparison.*" (emphasis supplied).

Section 103 is not, thus, a general ground of rejection to be considered apart from section 102. Rather, it refers back to 102 for a definition of "prior art," and extends the effect of that section from rejections on full anticipations to rejections on obvious variants of full anticipations. Section 102 supplies in specific terms a definition of what is to be considered anticipatory prior art. Section 103 provides a standard for deciding when prior art disclosing less than all of the subject matter of a claim shall be treated on the same basis as if it did fully anticipate. Considering specifically section 102(e), the term "prior art" in section 103 embraces copending patents which are "disclosed or described as set forth in" section 102(e).

Since sections 102(e) and 103 furnish a statutory definition of "prior art," it is futile for appellants to attempt, as they do (Brief, pages 8 to 24), to establish that the term has been given a more limited meaning in other connections. Appellee has not and does not question that the "prior art" referred to in section 102(a) must be publicly accessible. Appellants make that point vigorously (Brief, pages 13 to 18) and cite many decisions which so hold. Those authorities, however, relate to a matter which is not in

issue. By the enactment of 102(e), Congress, as did the Supreme Court at an earlier date in the *Alexander Milburn* case, made patent applications prior art as to any later filed applications claiming the same subject matter. In enacting section 103, Congress referred to the provisions of 102 as defining "prior art" and extended the bars of that section to obvious variations of the prior art disclosure.

The Decisions Cited by Appellants as to What is "Prior Art" are Not Controlling

On pages 19 to 24 of their brief, appellants cite a number of decisions said to hold that the filing of a patent application does not make the disclosure therein part of the prior art. However, two of those decisions, *John Blue Co. Inc. v. Dempster Mill Mfg. Co.*, 275 F.2d 668, and *Old Town Ribbon & Carbon Co. v. Columbia Ribbon & Carbon Mfg. Co.*, 159 F.2d 379, would appear to support the District Court's decision in this case. In the *John Blue Co.* case the question was whether a patent to Blue and Johnson was valid in view of a copending patent to Blue disclosing a metering pump where Blue and Johnson had added an obvious feature to the Blue device. The Eighth Circuit Court of Appeals held:

"It is true that the application for the Blue patent cannot be considered as prior art in the technical sense, but it is a widely recognized rule that the application for such patent can nevertheless be used as defense material to prove that Blue and Johnson were not the original and first inventors or discoverers of the metering pump described in their patent."

The Court held that the Johnson and Blue patent had properly been held invalid in view of the Blue patent, which, as noted, did *not* anticipate. Any holding by the Court that the Blue patent was not technically part of the prior art by a limited definition of the term is beside the point, because it did combine that patent with other disclosures in the art to declare the Blue and Johnson patent invalid. Without so stating, the Court, accordingly, did apply the standard of Section 103 and regarded the Blue patent as "prior art" thereunder.

In *Old Town Ribbon & Carbon Co. Inc. v. Columbia Ribbon & Carbon Mfg. Co., Inc.*, 159 F.2d 379, Judge Hand adopted the same reasoning as in the *Western States Mach. Co.* case and held that, while a copending patent was not prior art in the sense of being publicly available, the Court was obliged to treat the copending patent disclosure "precisely as though it had appeared in a printed publication before [the applicants] had filed their application." Such is the present effect of Sections 102(e) and 103, as interpreted by the District Court in this case.

The decision in *Weatherhead Company v. Drillmaster Supply Company*, 227 F.2d 98, dealt specifically with the question of double patenting rather than patentability over a copending patent of another inventor. Insofar as it holds, as dictum, that copending patents cannot be used to determine whether a later filed case claims patentably different subject matter, it would seem to be at odds with the *Old Town* case it cites as authority. Basis is lacking, at

any rate, for any statement that "most modern cases in the Courts of Appeals" so hold. No Court of Appeals is known to have made any such ruling since the enactment of the Patent Act of 1952.

Certain of the cases relied on by appellants seem lacking in pertinency. The decision in *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, 174 Fed. 417, and *Vacuum Engineering Co. v. Dunn*, 209 Fed. 219, were both prior to the *Alexander Milburn* case and are not pertinent for that reason alone. The decisions in *Allied Metal Stamping v. Standard*, 57 F.2d 296, *Stelos Co. Inc. v. Hosiery Motormend Corp. et al.*, 72 F.2d 405, affirmed 295 U.S. 237, *Hazeltine Corp. v. Electric Services Engineering Corp.*, 18 F.2d 662, and *Utah Radio v. Delco*, 24 F.Supp. 328, followed the doctrine of the *Alexander Milburn* case and certainly made no holding as to the impropriety of the combination of a copending patent with other art.

In the cases of *Baltimore v. Oles*, 13 F.Supp. 951, *Helene Curtis v. Sales Affiliates*, 233 F.2d 148, and *American Tri-Ergon Corp. v. Robertson*, 11 USPQ 168, the copending patents were distinguished on their merits, and the statements apparently relied on by appellants would seem to constitute dictum. The latter decision, moreover, would not be controlling in view of the later decisions of this Court in the *Minnesota Mining & Mfg. Co.* and *Sherwin-Williams Co.* cases.

To the extent that the decision in *East Rutherford Syringes v. Omega*, 152 F. Supp. 497, supports the appellants' view, it is clearly contrary to the con-

sistent rulings in this jurisdiction and to the majority view in other jurisdictions.

On pages 29 to 32 of their brief, appellants quote at length from the decision by the Commissioner of Patents in *Ex Parte Thomas*, 1918 C.D. 11. That case, of course, could not prevail over the later decisions of this Court in *Minnesota Mining & Mfg. Co.* and *Sherwin-Williams Co.* It is interesting, however, that in a portion of that decision not quoted by appellants, Commissioner Newton did hold that a claim might properly be rejected on a copending patent that was not wholly anticipatory. He stated:

"If the claim in question states the revised concept of the invention claimed in the patent with additional limitations, the further question arises whether those limitations state a "material and substantial" part of the invention in controversy. If they do not, the showing of prior invention comes within the terms of the statute. If they do, prior invention of the invention stated in the claim is not shown. If a copending patent discloses an invention upon which claims therein are founded some revised concept of which is identical with subject-matter embraced in the invention in controversy, prior invention is shown to the extent of that revised concept, and if the claim to the invention in controversy contains no limitation distinguishing it from that concept which states a "material and substantial" part of the invention in controversy prior invention is shown. The question raised by distinguishing limitations is not identical with the question whether the difference required invention, in

however many instances the answers to the two questions would be found the same."

The District Court Decision Is In Accord With Decisions In The U.S. Court of Customs and Patent Appeals

The U. S. Court of Customs and Patent Appeals has expressly ruled that copending patents are to constitute "prior art" under 35 U.S.C. 103. That Court's decision in *In re Gregg*, 44 CCPA 904, 244 F.2d 316, includes the following:

"It seems proper to note in this connection, moreover, that Coakwell's application was filed prior to that of appellant and there is no evidence to show completion of the invention covered by the appealed claims by appellant at any time prior to Coakwell's filing date. As the record stands, therefore, the Coakwell patent is a reference under section 102 (e) as well as 102(g).

[3] We are unable to agree with appellant that the prior art referred to in section 103 of the 1952 Act is limited to art which was available to the public prior to the date of the applicant's invention. The section clearly does not make any express statement to that effect, and no reason appears for reading such a limitation into it. It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it was necessary to combine it with other references. *In re Seid*, 34 C.C.P.A. (Patents) 1039, 161 F. 2d 229, 73 USPQ 431, and cases there cited. There is nothing to indicate that any change in that

practice was contemplated by the Congress when it enacted the Patent Act of 1952.

In the case *In re Kander*, 50 CCPA 928, 312 F.2d 834, copending patents to Kessler and Feldmeier had been combined with each other and with other patents in rejecting the application claims. The Court stated:

"[1] Appellant also emphasizes that both the Kessler and Feldmeier patents issued after his filing date. This fact is, of course, irrelevant in view of 35 U.S.C. 102(e). The rejection here is necessarily predicated on that section plus section 103 which, in a situation such as this, is not concerned with the psychological aspects of inventing but rather with legal concepts involving hypothetical situations in which the prior art is assumed to include those things dealt with in section 102, including the disclosures of United States patents having filing dates earlier than the applicant's date of invention as provided in paragraph (e). No date earlier than his filing date is asserted by appellant and it is later by two or more years than the filing dates of Kessler and Feldmeier."

Contrary to appellants' assertion (Brief, page 28), the *Gregg* and *Kander* decisions are in no way inconsistent in logic with the decision by the same court in *In re Palmquist*, 319 F.2d 547. There the applicants were permitted to antedate a publication in spite of the fact that the reference was published more than one year prior to the application filing date. The Court held that since the publication was not fully anticipatory, there was no "statutory bar" to a patent under 35 U.S.C. 102(b). The Court pointed

out that section 103, under which the rejection was made, barred a patent only if the claimed subject matter would have been obvious "at the time the invention was made." That language required, the Court held, consideration of applicants' evidence of prior invention. The decision would seem to have no bearing on the facts here or on those in the *Gregg* and *Kander* cases. The decision would seem to say no more than that the language of section 103 ("at the time the invention was made") requires the consideration of evidence of prior invention. No such evidence has been offered here. It is true that the Court appears to have drawn a distinction between prior publications which fully anticipate claimed subject matter and those which only partially anticipate. That distinction was based, however, on the fact that section 102(b) applies a bar as to publications having a date "more than one year prior to *the date of the application for patent*" whereas 103 applies a bar as to obviousness "at the *time the invention was made.*" The Court apparently read into that difference in language a legislative intent to permit an applicant to antedate a disclosure published more than one year prior to the filing date, if it is not fully anticipatory.

No such distinction exists as between section 102(e) and section 103. In point of time, section 102(e) applies a bar as to an invention described in an application filed "before the invention thereof by the applicant for patent" and section 103, as noted, correspondingly refers to obviousness "at the time the invention was made."

Appellants' View Appears to Lack Rational Basis

Just as a matter of common sense, the position taken by appellants would seem untenable. If a copending patent which fully discloses a claimed subject matter is effective to bar a patent, is it logical to say that a copending patent is not effective if it differs from the claims merely in some obvious and immaterial detail? Appellants advance no reason to support any such view. They refer (Trial Brief, pages 8 to 13) to the fact that patent applications are not open to the public and urge, by reference to decisions under 35 U.S.C. 102(a), that bars to patents should be based on that which is publicly available. That reasoning, however, applies equally to copending patents which fully anticipate and those which do not. Section 102(e), it was pointed out in *In re Schlittler et al.*, 43 CCPA 886, 234 F.2d 882, had the effect of making the filing of a patent application on which a patent is later granted "public property as much as an actual publication in a periodical." In effect, appellants, in basing an argument on the secrecy of patent applications, have attacked section 102(e) itself and the reasoning of the Supreme Court in its decision in the *Alexander Milburn* case. It avails appellants nothing to quarrel with the concept of barring patents by reference to disclosures which were pending in the Patent Office and were not available to the public. Congress has expressly approved such rejections by section 102(e).

;

CONCLUSION

In the *Alexander Milburn* case, the Supreme Court described its reasons for its holding as follows:

"We understand the Circuit Court of Appeals to admit that if Whitford had not applied for his patent until after the issue to Clifford, the disclosure by the latter would have had the same effect as the publication of the same words in a periodical, although not made the basis of a claim. 1 Fed. (2d) 233. The invention is made public property as much in the one case as in the other. But if this be true, as we think that it is, it seems to us that a sound distinction cannot be taken between that case and a patent applied for before but not granted until after a second patent is sought. The delays of the patent office ought not to cut down the effect of what has been done. The description shows that Whitford was not the first inventor. Clifford had done all that he could do to make his description public. He had taken steps that would make it public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached. We see no reason in the words or policy of the law for allowing Whitford to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Clifford had shown knowledge inconsistent with the allowance of Whitford's claim. [*Webster*] *Loom Co. v. Higgins*, 105 U. S. 580, and when otherwise the publication of his patent would abandon the thing described to the public unless it already was old. *McClain v. Ortmyer*, 141 U. S. 419, 424. *Underwood v. Gerber*, 149 U. S. 224, 230.

The question is not whether Clifford showed himself by the description to be the first inventor. By putting it in that form it is comparatively easy to take the next step and say that he is not an inventor in the sense of the statute unless he makes a claim. The question is whether Clifford's disclosure made it impossible for Whitford to claim the invention at a later date."

That reasoning applies equally as well to copending patents which are immaterially different from the claimed subject matter as to those which fully anticipate. In this case, the Wallace et al. patent stands as evidence that the applicant Regis was not the first inventor because the patent discloses the claimed subject matter except for an obvious detail. Paraphrasing the Supreme Court's language, there is no reason in the words or policy of the law for allowing Regis to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Wallace et al. had shown knowledge inconsistent with the allowance of Regis' claim.

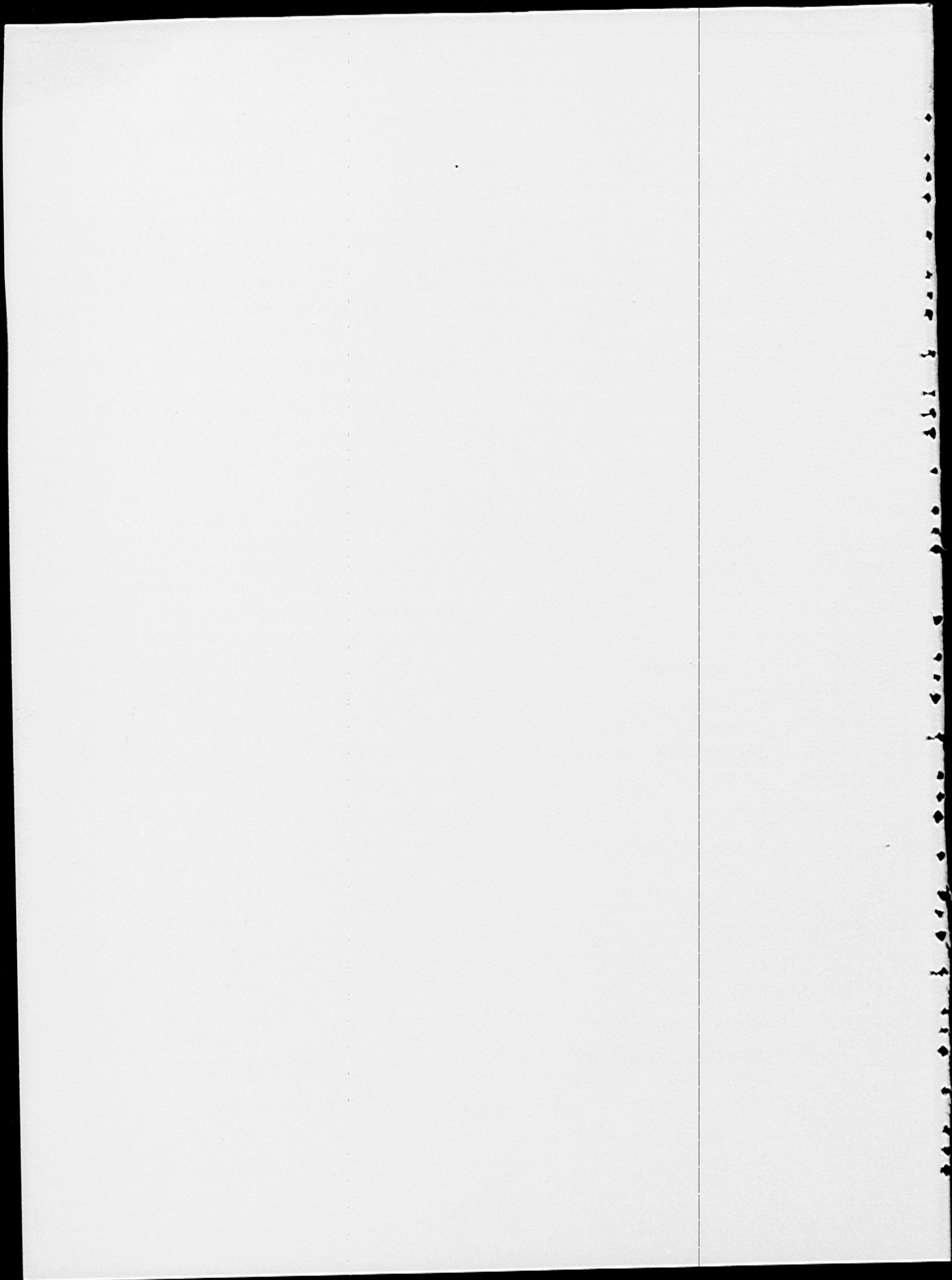
For the reasons stated, the decision of the District Court should be affirmed.

Respectfully submitted,

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June 1964



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 18,563

HAZELTINE RESEARCH, INC. and ROBERT REGIS,
Appellants,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS,
Appellee.

REPLY BRIEF FOR APPELLANTS

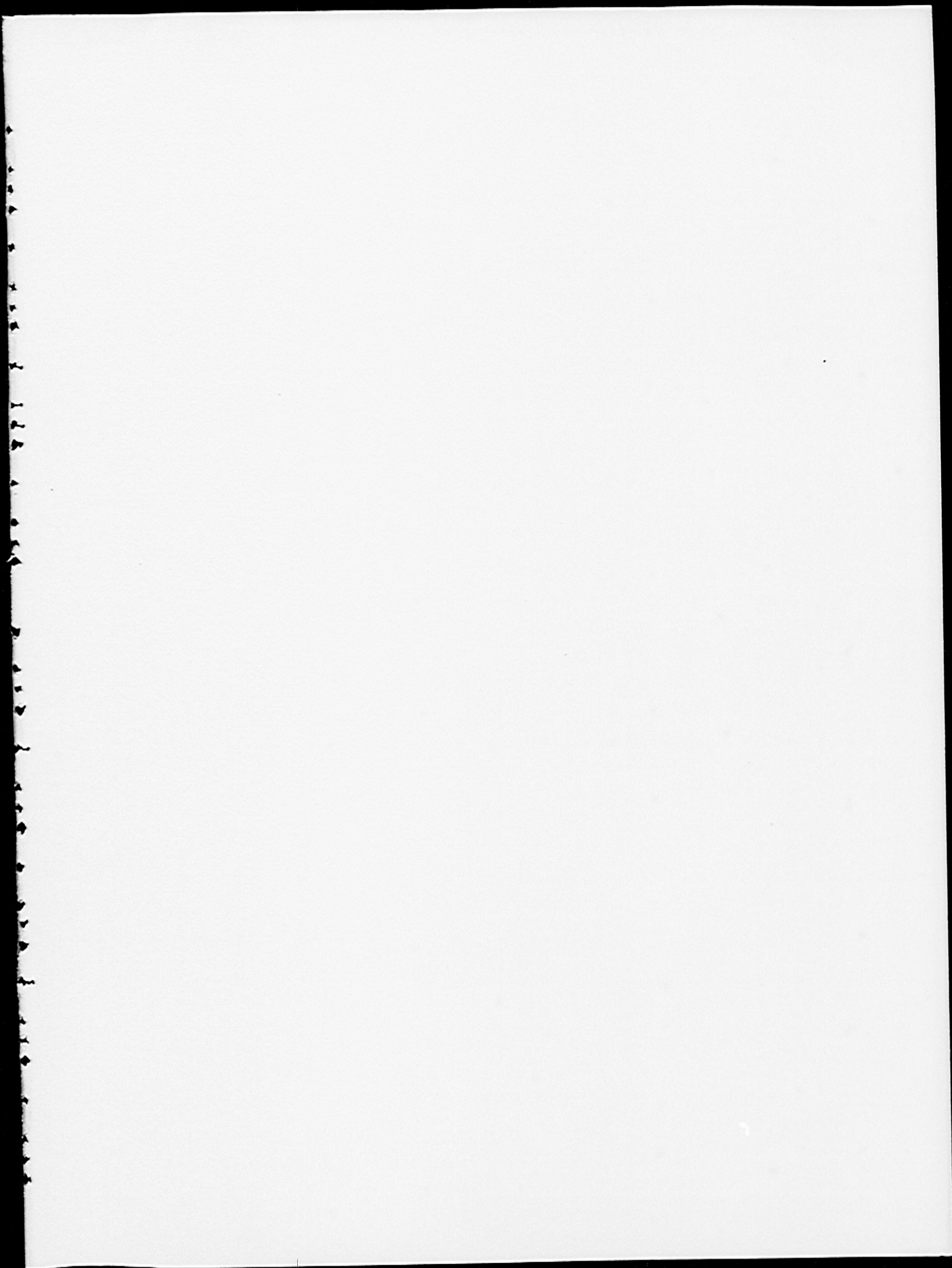
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REPLY BRIEF FOR APPELLANTS

Appellee Misrepresents The Facts

Appellee misrepresents the whole tenor of this case by intimating that all that is involved is an "immaterial detail" as the difference between Wallace and Regis. If nothing more were involved, this case would not have been brought before the Court by Appellants. What is more, if that were the case Appellee would have rejected Regis on Wallace alone, contending that Regis was essentially the same as Wallace, rather than trying to combine Wallace and Carlson.

Appellee admits (pg. 2 BRIEF FOR APPELLEE) that "the Patent Office held that 'it was obvious to combine the teachings of Wallace and Carlson to produce the results sought by Regis.'" The teachings of Wallace and Carlson are two independent inventions. Whether "it was

obvious to combine" them "to produce the results sought by Regis" is an issue quite apart from the issue of whether Regis and Wallace differ in "immaterial detail". There is nothing in the Record to show that the difference between Wallace and Regis is an immaterial detail; in fact, the difference is quite material. The Patent Office holding was thus not on the basis of immaterial details and clearly favorable to Regis according to the remarks of Commissioner Newton on page 18 of the BRIEF FOR APPELLEE.

Appellee is therefore attempting to reduce the rules of law argued by Appellants to an absurdity by leading the Court to believe that they cover "immaterial detail" situations not envisaged by them or by the facts in this case.

Nor is this a mere matter of "Tweedledum and Tweedledee". There is a real distinction between a rule based on "immaterial details" and a rule based on whether it would be obvious to combine two independent inventions into a new combination to produce a new result. The former involves a mere matter of *difference in form*, the latter a *substantive concept*. It is the former which is involved in Section 102(e), the latter in Section 103.

Section 102 Is Not The Antecedent of "Prior Art" in Section 103

An error of logic dispositive of the first half of the STATEMENT OF QUESTIONS PRESENTED occurs at pages 3, 13 and 14 of the BRIEF FOR APPELLEE. Appellee there contends that Section 102 is the antecedent for the term "the prior art" in Section 103. This is just not so. The true antecedent is the law discussed in the BRIEF FOR APPELLANTS and summarized at page 28 thereof. The term "prior art" may overlap a portion of Section 102, namely, Section 102(a), but it certainly does not include all of Section 102. For the best examples,

how could it possibly have anything to do with whether one has abandoned his brain child and thereby precluded his right to patent by virtue of Section 102(c), or with Section 102(f) on the requirement that the applicant must have actually conceived the idea personally, not plagiarized it? Our argument here is that the term "prior art" does not include Section 102(e) either.

Appellee's quotation from Report 1979 of the Committee on the Judiciary (pg. 13, BRIEF FOR APPELLEE) supports Appellants' point. It says:

"[Section 103] refers to the difference between the subject matter sought to be patented and the prior art, *meaning what was known before* as described in Section 102 (emphasis supplied)."

Note that this is logically limited to "meaning what was known before"; i.e., Section 102(a). And the word "known," as already pointed out, has been taken to mean "publicly known" (House Report No. 1923 and Reviser's Notes, page 13, BRIEF FOR APPELLANTS). Therefore, the Committee on the Judiciary of the Senate could only have been thinking of Section 102(a) as prior art and not Section 102(e) for Section 102(a) is the only part of Section 102 which uses the word "known".

What is more, Section 103 as it now stands (The Patent Act of 1952 was H.R. 7794) was specifically reworded to remove antecedence in Section 102 for the term "the prior art". This occurred in the following manner. As Report 1979 of the Committee on the Judiciary, referred to by Appellee, states at page 1:

"Hearings were held in the House on H.R. 3760, which dealt with the matter of the codification of title 35, and as a result of those hearings the bill was revised and introduced as H.R. 7794."

But Section 103 in H.R. 3760 read:

"A patent may not be obtained though the invention is not identically disclosed or described *in the*

prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior art [are] such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made." (Emphasis supplied) (From—HEARINGS BEFORE SUBCOMMITTEE NO. 3 OF THE COMMITTEE ON THE JUDICIARY HOUSE OF REPRESENTATIVES EIGHTY SECOND CONGRESS FIRST SESSION ON H.R. 3760 JUNE 13, 14 and 15, 1951).

In place of the emphasized words in H.R. 3760 there were thus substituted in Section 103 as it now stands, the words "as set forth in section 102" and "the prior art".

Appellee Misstates the Relationship Between The Action of Congress And the Earlier Action of the Supreme Court

The second half of the STATEMENT OF QUESTIONS PRESENTED is also disposed of by a logical error of Appellee for at the top of page 15 of his brief he misstates the relation between the action of Congress in enacting Section 102(e) and the earlier action of the Supreme Court in *Alexander Milburn Co. v. Davis-Bournonville Co.* Congress did not make patent applications prior art as Appellee states; it clearly rejected any such broad interpretation of *Alexander Milburn* and accepted the very limited meaning of that case which we have previously argued (pp. 7,8,24, BRIEF FOR APPELLANTS). The very specific and clear language of Section 102(e) admits no other interpretation. All agree that Congress in Section 102(e) enacted the doctrine of *Alexander Milburn v. Davis-Bournonville Co.* But in using the words "*the invention was described in an application for a patent by another filed*" Congress clearly decided to adopt only

the limited construction of *Alexander Milburn*; i.e., that a copending patent must stand alone, not as prior art, but on the special question of whether it deprives a later applicant of the status of first inventor. Even the Reviser's Note interprets *Alexander Milburn* in this limited manner in saying:

"Paragraph (e) is new and enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor." (p. 34, BRIEF FOR APPELLANTS) (Emphasis on singular case added)

So, too, states Federico, cited by Appellee (p. 13, BRIEF FOR APPELLEE). Federico says on page 19 of the cited "Commentary":

"Paragraph (e) is new in the statute and enacts the rule of the decision of the Supreme Court in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 46 S.Ct. 324, 270 U.S. 390, 70 L.Ed. 651, under which a United States patent disclosing an invention dates from the filing of the application for the purpose of anticipating a later inventor, whether or not the invention is claimed in the patent". (Emphasis on the singular case added)

It is not for us now to enlarge the clear words of Congress in Section 102(e) and broaden the *Alexander Milburn* doctrine when Congress declined to do so. In *Caminetti v. United States*, 242 US 470, the Supreme Court said:

"It is elementary that the meaning of a statute must, in the first instance, be sought in the language in which the act is framed, and if that is plain, and if the law is within the constitutional authority of the

law making body which passed it, *the sole function of the courts is to enforce it according to its terms.* * * *

* * *

"Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them. * * * " (pages 485 and 486) (Emphasis added).

* * *

"* * * Still, the name given to an act by way of designation or description, or the report which accompanies it, cannot change the plain import of its words. If the words are plain, they give meaning to the act, and it is *neither the duty nor the privilege of the courts to enter speculative fields in search of a different meaning.*" (pg. 490) (Emphasis added)

"To enforce" Section 102(e) "according to its terms" is to accord it the limited *Alexander Milburn* interpretation.

In *Yates v. United States*, 354 US 298, 1 L. Ed. 2d 1356, 77 S.Ct. 1064, the Supreme Court said:

"* * * The intention of the legislature is to be collected from the words they employ. Where there is no ambiguity in the words, there is no room for construction. The case must be a strong one indeed, which would justify a Court in departing from the plain meaning of words, especially in a penal act, in search of an intention which the words themselves did not suggest. *To determine that a case is within the intention of a statute, its language must authorize us to say so* * * * " (354 US at 305) (Emphasis ours)

* * *

"* * * We too think this statute should be read 'according to the natural and obvious import of the language, *without resorting to subtle and forced construction for the purpose of either limiting or ex-*

tending its operation. *United States v. Temple*, 105 US 97,99 29 L.Ed. 967,968." (354 US at 311) (Emphasis ours)

Section 102(e) does not "authorize us to say" that a copending patent is prior art; it authorizes us only to say that it "is available as a bar to a patent application only if it describes the invention of that application" (APPELLANT'S STATEMENT OF QUESTIONS PRESENTED).

Nevertheless, Appellee argues outdated cases based on the broadened interpretation of *Alexander Milburn* rejected by Congress. These, of course, include *Detrola Corp. v. Hazeltine Corp.*, 313 US 259, as well as the three cases in this Court—*Minnesota Mining & Mfg. Co. v. Coe*, 69 App. D.C. 256, 100 F.2d 429; *Dyer v. Coe*, 75 U.S.App. D.C. 125, 125 F.2d 192; *Sherwin Williams Co. v. Marzall*, 88 U.S.App. D.C. 374, 190 F.2d 606, all of which were prior to the Patent Act of 1952. Appellee is therefore clearly ignoring the fact that Congress has spoken a last word in Section 102(e) of the Patent Act of 1952 to place copending applications under the limited interpretation of *Alexander Milburn*, which we have previously argued. All of these decisions have been overruled or limited by Congress to make Appellants' point of view prevail.

Appellants' View Has A Rational Basis

Lastly, Appellee attacks Appellants' view as lacking rational basis (p.22, BRIEF FOR APPELLEE). To say that Appellants' view lacks rational basis is to say that the plain words of Congress lack rational basis. Obviously, we are here to argue what Congress wrote into law, not its wisdom. Nevertheless, Appellants still firmly believe it rational and wise for the reasons set forth in their main brief.

Appellee contends "In effect, appellants in basing an argument on the secrecy of patent applications, have attacked Section 102(e) itself and the reasoning of the Supreme Court in its decision in the *Alexander Milburn* case". This is just not so.

Let us get clear of the clouds of argument about admittedly conflicting case law and look at the simple logic as Congress saw it: There is a dilemma in that prior art must be publicly available, yet if an invention is placed in the public domain by the issuance of a patent, a later applicant ought not to be permitted to remove it from the public domain after the patent has been issued. As did Commissioner Newton, Congress solved the dilemma by meeting both of its horns separately; it preserved both principles. Prior art must still be publicly available (Section 103); yet a later applicant cannot take from the public domain an invention already placed in the public domain by a patent issued on an earlier filed application (Section 102[e]). Since the later applicant can take nothing from the public domain if the patent does not *describe* the invention, there is no problem with respect to copending patents not describing the invention. In this paragraph we have hit the "nub" of this case, a copending patent describing the invention presents a special problem requiring special treatment other than as prior art; one not describing the invention presents no problem and is not prior art.

Thus, Congress had two different problems in mind in Sections 102(e) and 103. Far from making the former antecedent of the latter, Congress made them exclusive of each other to solve the conflict between the two problems.

So we have shown that Appellee and the District Court were both wrong in saying there is no evidence that Congress intended to change the law—better say clarify it. Congress saw the dilemma and the conflicting court decisions and solved the problems by adopting a limited view of *Alexander Milburn* and leaving the concept of prior art as publicly available intact.

Respectfully submitted,

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